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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. 294.

JOSEPH T. DUNHAM, APPELLANT,

vs.

THE DENNISON MANUFACTURING COMPANY.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

FILED OCTOBER 18, 1890.

(14,335.)

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1 [L.S.] The President of the United States of America to the Dennison Manufacturing Company, Greeting:

You are hereby commanded that you personally appear before the judges of the circuit court of the United States of America for the southern district of New York, in the second circuit, in equity, on the first Monday of March, A. D. 1887, wherever the said court shall then be, to answer a bill of complaint exhibited against you in the said court by Joseph T. Dunham, and do further and receive what the said court shall have considered in that behalf; and this you are not to omit under the penalty on you of two hundred and fifty dollars.

Witness Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States, at the city of New York, on the 25th day of January, in the year one thousand eight hundred and eighty-seven, and of the Independence of the United States of America the one hundred and eleventh.

TIMOTHY GRIFFITH, *Clerk.*

SAM. TRO. SMITH, *Complainant's Sol'r.*

The defendant is required to enter appearance in the above cause, in the clerk's office of this court, on or before the first Monday of March, 1887, or the bill will be taken *pro confesso* against it.

T. G., *Clerk.*

2 (Subpœna endorsed:)

I hereby certify that on the 7th day of February, 1887, at the city of New York, in my district, I personally served the within subpœna upon the within-named Dennison Manufacturing Company by exhibiting to H. K. Dyer, treasurer of said company, the within original and at the same time leaving with him a copy thereof.

Dated February 7th, 1887.

(S'g'd) MARTIN T. McMAHON,
United States Marshal, Southern District of New York.
GEORGE JEFFREY,
Deputy U. S. Marshal.

(File-mark:) U. S. circuit court. Filed Feb. 8, 1887. Timothy Griffith, clerk.

3 To the judges of the circuit court of the United States for the second circuit and southern district of New York:

Joseph T. Dunham, residing and domiciled in the city of Brooklyn, State of New York, and being a citizen of the United States, brings this his bill of complaint against the Dennison Manufacturing Company, a corporation organized under the laws of the State of Massachusetts, and doing business in Boston, Massachusetts, in the city of New York in the State of New York, and elsewhere; and thereupon your orator complains and alleges that your orator

Joseph T. Dunham was and is the original and first inventor of new and useful improvements in envelopes, and in combined tag and envelopes fully described in letters patent hereinafter mentioned and which had not been known or used by others prior to his invention or discovery thereof, and which had not been at the time of his application for letters patent therefor, as hereinafter mentioned, in public use or on sale with his consent and allowance contrary to the provisions of the acts of Congress of the United States, in such case made and provided.

And your orator further shows unto your honors that being so as aforesaid, the first and original inventor or discoverer of said improvements in envelopes, and combined tag and envelopes,
4 and being a citizen of the United States, and being desirous of obtaining an exclusive property in said inventions or improvements, within and for the United States, your orator Joseph T. Dunham, did on the 8th day of May, 1883, upon application therefore and having in all things complied with the conditions and requirements of the acts of Congress in such case made and provided, obtain letters patent of the United States for said invention and improvements in due form of law, under the seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, bearing date the said 8th day of May, 1883, and being numbered 277,245, by which said letters patent there was granted and secured to the said Joseph T. Dunham, his heirs, administrators or assigns, for the term of seventeen years from the said 8th day of May, 1883, the full and exclusive right and liberty of making, using and vending to others to be used the said invention and improvement described and set forth in said letters patent, which said letters patent are now remaining of record in the Patent Office of the United States, and as by reference to which, or a duly certified copy thereof ready in court to be produced if required, will more fully and at large appear, and by virtue whereof your orator Joseph T. Dunham, became and was the sole owner of all the rights and privileges granted and secured in and by said letters patent.

And your orator further shows that your orator Joseph T. Dunham, having good and lawful cause, after the issuing of said letters patent as aforesaid, surrendered the same to the Commissioner of Patents, and having made due application therefor, and having in all things complied with the conditions and requirements of the acts of Congress in such case made and provided, did on the 10th
5 day of June, 1884, obtain new letters patent for the same invention, upon an amended specification for the residue of the term of seventeen years from the 8th day of May, 1883, which new letters patent were issued in due form of law, under the seal of the Patent Office of the United States signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents, bearing date the said 10th day of June, 1884, and being reissue No. 10488, which said new and reissued letters patent, are now remaining of record in the Patent Office of the United States, and as, by said last-mentioned letters patent, or a duly authenticated copy

thereof, ready in court to be produced if required, will more fully and at large appear.

And your orator further shows, that being so as aforesaid the first and original inventor or discoverer of said improvement in envelopes, and being a citizen of the United States, and being desirious to obtain an exclusive property in said invention, discovery or improvement in envelopes, within and for the United States, your orator did on the 24th day of November, 1884, upon due application therefor, and having in all things complied with the conditions and requirements of the acts of Congress in such case made and provided, obtain other letters patent of the United States for said invention and improvement in envelopes, in due form of law under the seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, bearing date the said 24th day of November, 1885, and numbered 331,118, by which said letters patent there was granted and secured to the said Joseph T. Dunham, his heirs, administrators or assigns, for the term of seventeen years, from the said 24th day of November, the full and exclusive right of making, using, and vending to others to be used the said invention and improvement described
6 and set forth in said last-mentioned letters patent; which said letters patent are now remaining of record in the Patent Office of the United States, and as by reference to which, or a duly authenticated copy thereof, ready in court to be produced, if required, will more fully and at large appear, and by virtue whereof, your orator became and was the sole owner of all the rights and privileges granted and secured by said letters patent.

Your orator further shows unto your honors that being, as aforesaid, vested with the exclusive right aforesaid, he put into use and practical operation the aforesaid inventions and discoveries, and manufactured envelopes and combined tag and envelopes according to the descriptions contained in said reissued letters patent No. 10488, and said letters patent No. 331,118, and put the same upon the market, and made extensive sales thereof, and expended and invested large sums of money, and bestowed great labor and trouble in and about said inventions or discoveries, and the carrying out of the business of manufacturing and selling said envelopes and combined tag and envelopes, according to the description contained in said reissued and last-mentioned original letters patent, and making the same profitable to your orator, and made sales thereof to many purchasers at prices which included patent fees and profits for the same, which said patent fees and profits were known to said purchasers thereof to be so included, and has so continued to manufacture and sell the same down to the commencement of this suit.

Your orator further shows unto your honors that since the issue to your orator of said letters patent as aforesaid, your said orator has been, down to the present date, except for the doings of said defendent as hereinafter set forth, and of other wrong-doers in
7 the premises, in the exclusive possession and enjoyment thereof; and that the said right has been, and is of great value to your said orator.

Your orator further shows on information and belief, that since the 10th day of June, 1884, and since the 24th day of November, 1885, the defendant, well knowing the premises, and the rights and privileges secured to your orator in, and by said letters patent No. 331,118. and reissue letters patent No. 10488, and of all the acts and things herein recited, vesting in your orator the full and exclusive right, title and interest, in the hereinbefore-specified letters patent, and the invention secured thereby, did contrive at the city of New York, State of New York, and in the southern district of New York; in the city of Boston, State of Massachusetts; in the city of Philadelphia, State of Pennsylvania; in the city of Cincinnati, State of Ohio; in the city of Chicago, State of Illinois; and in the city of St. Louis, in the State of Missouri; and at other places, to injure your orator, and to defraud him of his profits, rights, privileges and advantages, which might, and otherwise would have accrued to him; and without the permission or license of your orator since the 10th day of June, 1884, and since the 24th day of November, 1885, has wrongfully and unlawfully manufactured and sold to others to be used, envelopes and combined tag and envelopes, containing and employing the inventions and improvements set forth and described in said letters patent number 331,118 and reissue number 10488, and obtaining and employing devices substantially and materially like the inventions and improvements set forth and described therein; but what number of said envelopes, and combined tag and envelopes, the said defendant has so made and sold to others to be used your orator does not know and cannot therefore state, but upon information and belief, your orator avers that said defendant has manufactured and sold to
8 others to be used or caused to be manufactured and sold to others to be used, and is now manufacturing and selling or causing to be manufactured and sold to others to be used, large quantities of the same; that the said defendant has derived and received and is still deriving and receiving from such manufacture and sale great gains and profits, but to what extent your orator is ignorant and cannot therefore set forth, but your orator believes the same up to this date to be thirty thousand dollars and so charges the fact to be, and prays that the defendant may be compelled to make discovery of such gains and profits.

Your orator in like manner avers that the defendant continues to manufacture and sell to others to be used, envelopes and combined tag and envelopes made according to said letters patent number 331,118 and reissue No. 10488, so as aforesaid, though warned and requested to desist from said manufacture and sale, and refuses to pay over to your orator the said gains and profits, by means whereof the said defendant has greatly injured, and is greatly injuring your orator, and has deprived and is still depriving your orator from receiving the gains and profits from the exclusive right to make, use and sell to others to be used the envelopes and combined tag and envelopes set forth and described in said letters patent; which your orator, otherwise, and but for the wrongful acts of the defendant would have obtained and received.

Your orator further shows unto your honors that he has sustained great damages, to wit: as near as he can state the same, the sum of fifty thousand dollars by reason of the infringement by the defendant as aforesaid, of your orator's rights, secured by said letters patent as aforesaid.

All of which actings and doings of the defendant are con-
9 trary to equity and good conscience, and tend to manifest injury *to* your orator in the premises.

In consideration whereof, and forasmuch as your orator can only have adequate relief in this honorable court, where matters and things of this kind are made cognizable, your orator prays that the said defendant may be compelled by a decree of this court to account for, and pay over to your orator, all such gains and profits as have accrued to or have been earned by said defendant, and all such gains and profits as have been received, by said defendant, or to which the said defendant may be entitled by reason of manufacturing and selling to others to be used envelopes or combined tag and envelopes containing, embodying or employing the inventions or improvements set forth and described in said letters patent, or inventions, improvements or devices materially and substantially like such inventions and improvements, and in infringement thereof; and all such gains and profits as your orator would have received, but for the wrongful and unlawful acts and doings of the said defendant; and also in addition to the profits to be accounted for by the defendant, that the said defendant may pay the damages your orator has sustained by reason of such infringement; and that your honors shall assess such damages, or cause such damages to be assessed under direction of the court, and that the said defendant, its attorneys, solicitors, agents, servants and workmen may be perpetually enjoined and restrained by the decree and injunction of this court, from directly or indirectly, manufacturing, using or selling to others to be used envelopes, or combined tag and envelopes, made according to the description set forth, and claimed in said letters patent, or materially and substantially like thereto; and from infringing upon or violating the said letters patent,
10 reissued to Joseph T. Dunham, on the 10th day of June, 1884, and letters patent issued to him on the 24th day of November, 1885, in respect to the said exclusive rights vested in your orator, and that all such envelopes and combined tag and envelopes manufactured by defendant, may be delivered up to your orator and be destroyed, and that the defendant may be decreed to pay the costs of this suit, and that your orator may have such other and further relief as the equity of the case may require and as to your honors may seem meet.

To the end, therefore, that the said defendant may, if it can, show why your orator should not have the relief prayed for, and may full, true and direct answer make according to best of its knowledge, information and belief, in the several matters hereinbefore named and set forth, as fully and particularly as if the same were here repeated paragraph by paragraph, and said defendant especially interrogated thereunto, may it please your honors to grant

unto your orator a writ of *subpœna ad respondendum* issuing out of and under the seal of this honorable court, directed to the said defendant commanding it to appear and make answer to this bill of complaint, and to perform and abide by such order and decree herein, as to this court may seem required by the principles of equity and good conscience.

And may it please your honors to grant your orator a provisional preliminary injunction, issuing out of and under the seal of this honorable court, enjoining and restraining the defendant, its attorneys, clerks, solicitors, agents, servants and workmen, to the same purport, tenor and effect hereinbefore prayed, in regard to the said perpetual injunction.

And your orator will ever pray.

SAM. TRO. SMITH,
[L. S.] *Solicitor for Complainant and of Counsel.*

11 STATE OF NEW YORK,
Southern District of New York, City and County of New York, } *ss:*

Joseph T. Dunham, being duly sworn says, that he is complainant in the above-entitled cause, that he has read the foregoing bill of complaint and knows the contents thereof, and that the same is true, to his own knowledge, except as to the matters, therein stated to be alleged on information and belief, and as to those matters, he believes it to be true.

JOSEPH T. DUNHAM.

Sworn to before me this 24th day of June, 1887.

J. HOMER HILDRETH,
[L. S.] *Notary Public, N. Y. Co.*

(Bill endorsed:) U. S. circuit court, so. dist. of New York. In equity. Joseph T. Dunham *vs.* The Dennison Manufacturing Company. Bill of complaint. Sam. Tro. Smith, sol'r for compl't, 291 B'dway, N. Y. city.

(File-mark:) U. S. circuit court. Filed Jan. 25, 1887.

United States Circuit Court, Southern District of New York. In Equity.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

The replication of Joseph T. Dunham, complainant in this cause, to the answer of the defendant corporation, The Dennison Manufacturing Company.

This repliant, saving, securing and reserving to himself, now,
12 and at all times hereafter, all and all manner of benefit and advantage of exception which may be had or taken to the manifold insufficiencies of the said answer for replication thereto, says that he will aver, maintain and prove his bill of complaint to be true, certain and sufficient in the law to be answered unto; and

that the said answer of the said defendant is uncertain, untrue and insufficient to be replied unto by the repliant; without this; that any other matter or thing whatsoever in the said answer contained, material or effectual in the law to be replied unto and not herein or hereby replied unto, confessed and avoided, traversed or denied, is true; all which matters and things this repliant is, and will be ready to aver, maintain and prove, as this honorable court shall direct, and humbly prays as in and by his bill he has already prayed.

Dated, March 22nd, 1887.

SAM. TRO. SMITH,
Solicitor for Complainant and of Counsel.

(Endorsed:) U. S. circuit court, so. dist. of New York. In equity. Replication. Joseph T. Dunham *vs.* The Dennison Mfg. Co. Sam. Tro. Smith, sol'r for complainant, 291 B'dway, N. Y. city.

(File-mark.)

(File-mark:) U. S. circuit court. Filed Mar. 25, 1887. Timothy Griffith, clerk.

13 U. S. Circuit Court, Southern District of New York.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

Take notice that I am retained by and hereby appear for The Dennison Manufacturing Company, defendants in the above-entitled action, and hereby demand service of all papers herein upon me at my office, number 5 Pemberton square, Boston, Massachusetts.

Dated New York, February 15th, 1887.

Yours, &c., WILLIAM W. SWAN,
To the clerk. *Defendants' Solicitor.*

(Endorsed:) U. S. circuit court, so. dist. of N. Y. Jos. T.
14 Dunham *vs.* Dennison Mfg. Co. Notice of app'ce. Wm. W. Swan, 5 Pemberton Sq., Boston. U. S. circuit court. Filed Feb. 15, 1887. Timothy Griffith, clerk.

15 U. S. Circuit Court, S. D. N. Y.

JOSEPH T. DUNHAM
vs.
DENNISON MANUFACTURING COMPANY.

Please take notice that we appear for the defendant in the above-entitled suit. Please enter our appearance upon the record.

N. Y., February 25, 1887.

Yours, &c., WETMORE & JENNER,
Def't's Sol'rs, 206 Broadway, New York.

To Timothy Griffith, Esq., clerk.

16 (Endorsed:) Dunham *vs.* Dennison Manfg. Co. Wetmore & Jenner, def't's solicitors, 206 Broadway, N. Y. U. S. circuit court. Filed Feb. 25, 1887. Timothy Griffith, clerk.

I7 SOUTHERN DISTRICT OF NEW YORK, *ss:*

Circuit Court of the United States.

JOSEPH T. DUNHAM
vs.
DENNISON MANUFACTURING CO. } In Equity.

The Answer of the Dennison Manufacturing Company to the Bill of Complaint of Joseph T. Dunham.

The said defendant reserving to itself all right of exception as to all the matters contained in said bill, for answer thereto or to so much thereof as it is advised is material to be answered unto, says:

That it admits upon information and belief, that the said several letters patent in the bill mentioned numbered 277,245 and 331,118, respectively, were issued by the United States to the complainant, and also admits the grant of said reissued letters patent numbered 10488; but the defendant denies that the said reissued patent
18 was for the same invention as said original patent No. 277,245, and it denies that the complainant obtained any exclusive right or liberty by virtue of several letters patent or any of them, and avers that several letters patent are in every respect invalid and void.

That it denies that said several alleged inventions or either of them have hitherto been in the exclusive possession of the complainant, or that the same have been of great or any profit to him, and leaves the complainant to make such proof thereof as he may be advised.

That it denies that it has since the 10th day of June, 1884, or since the 24th day of November, 1885, in this district or elsewhere in the United States, manufactured or sold to others, or that it continues to manufacture or sell to others, envelopes or combined tag and envelopes, containing or employing the pretended inventions or improvements patented in said patent No. 331,118, or in said reissued patent No. 10488, or containing or employing devices substantially or materially like the inventions or improvements set forth or described therein.

And the defendant denies that it has in any way injured or is injuring the complainant or that it has deprived or is depriving the complainant from receiving any gains or profits as alleged in the bill; or that the defendant has received any gains or profits which the complainant would have otherwise obtained or received.

And further answering upon information and belief the defendant avers and charges that said original letters patent No. 277,245 were not inoperative or invalid by reason of such a defective or insufficient specification as was or lawfully could be corrected or
19 amended by the said surrender and reissue; and alleges that said original letters patent were surrendered, not to correct any error which had arisen by inadvertence, accident or mistake, and not as alleged in the bill, with "good and lawful cause" but to

introduce new matter into the specification and to make changes in the description of the alleged invention as to matters which were not erroneous, or if erroneous, had not arisen by inadvertence, accident or mistake, and to claim other and different inventions than those which were patented in the original patent, and the defendant avers that the said reissued patent is not for the same invention as the said original patent No. 277,245 but is for other and different inventions.

And the defendant further alleges that if the original patent was inoperative or invalid by reason of a defective or insufficient specification or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, which error had arisen by inadvertence, accident or mistake and without any fraudulent or deceptive intention, such defect or insufficiency of the specification was apparent upon the face of the specification itself and should immediately after the grant of the original letters patent have been surrendered and a new patent obtained, if he desired to correct the same, but that for more than ten months the said complainant failed to surrender said patent, and thereby waived or abandoned all right, if any, which he had so to do.

That the said reissued letters patent are for matters which are not operative and useful devices or patentable intentions and are wholly invalid and void. And that any inventions claimed in said reissue as to any features, if any, found in the defendant's tags were not patentable under the statutes of the United States.

And this defendant denies that the public has generally or in any part acquiesced in the pretended rights and liberties of the complainant under said patents or either of them.

20 And further answering the defendant denies that said Dunham was the original and first inventor of the alleged invention patented in said patent No. 331,118, or of any substantial or material part thereof, and alleges that if said Dunham was such inventor as alleged, the pretended invention described and claimed in said patent No. 331,118, was by him abandoned to the public long prior to his application for the said patent; but the defendant denies that any alleged improvement described in said patent No. 331,118, or the alleged invention or any material or substantial part thereof was a new and useful invention within the meaning of or patentable under the statutes of the United States, and alleges that the invention described in said patent was described and shown in said letters patent No. 277,245 and was known and used prior to any invention thereof by said Dunham, by the following persons:

Henry B. Dennison	of	Boston, Mass., at said Boston.
Albert Metcalf	"	Newton, " " " "
Henry K. W. Hall	"	Boston, " " " "
Charles Pink	"	Cairo, Ill., " " "
John P. Pultz	"	Plantsville, Conn., at said
L. V. Walkley		Plantsville

And defendant denies that said Dunham was the original and first inventor of the alleged invention patented in said reissued patent No. 10488, or of any substantial or material part thereof, and

the defendant denies that any alleged improvement described in said reissued patent or the alleged invention or any material and substantial part thereof was a new and useful invention within the meaning of the statutes of the United States, and alleges that the invention described in said patent was known and used prior to any invention thereof by said Dunham, by said Dennison, Metcalf and Hall at said Boston, and said Pink at said Cairo, and said Pultz and Walkley at said Plantsville.

And defendant denies that said patented inventions or
21 either of them have been in the exclusive possession of the complainant and avers that the public has not acquiesced in complainant's pretended rights under said patents.

And the defendant further avers, that the only tag envelopes made, used or sold by it since the said 10th day of June, 1884, are substantially the same as tag envelopes made, used and sold by the defendant long prior to the date of the complainant's pretended invention and more than two years before the application for said reissued patent, and more than two years prior to the application for said patent No. 331,118.

That upon information and belief the defendant denies that the improvements described and claimed in said patent No. 331,118, had not been in public use and on sale for more than two years prior to the application for said letters patent as alleged in the bill and charges that the same had been in public use and on sale more than two years before said application was made.

And the defendant denies that the improvements described and claimed in said reissued patent No. 10488, had not been in public use and on sale in the United States for more than two years prior to the application for said reissued patent as alleged in the bill and charges that the same had been in public use and on sale in the United States more than two years before said application was made.

And the defendant further answering, says that the plaintiff is not entitled to an injunction or an account of profits or any other relief against this defendant as prayed for in the bill of complaint, without this that any other matter, cause or thing in the said bill
contained material or necessary for this defendant to make
22 answer unto and not herein and hereby well and sufficiently answered, confessed, traversed and avoided or denied, is true to the knowledge or belief of this defendant; all which matters and things this defendant is ready and willing to aver, maintain and prove as this honorable court shall direct, and humbly prays to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

DENNISON MANUFACTURING CO.,
By HENRY B. DENNISON, *Pres't.*

WETMORE & JENNER,
Defendant's Solicitors, 206 *Broadway, N. Y.*
W. W. SWAN,
Of Counsel and Solicitor.

DISTRICT OF MASSACHUSETTS:

BOSTON, *February* 17, 1887.

There personally appeared, Henry B. Dennison and subscribed the foregoing answer and made oath that he is the president of said Dennison Manufacturing Company, and that the statements and allegations contained in said answer are true except when stated upon information and belief, and as to such matters he believes them to be true.

Before me—

[L. S.] WILLIAM S. ROGERS,
Notary Public.

(Endorsed:) Dunham *vs.* Dennison Mfg. Co. Def't's answer. W. W. Swan, 5 Pemberton Sq., Boston, def't's sol'r.

(File-mark:) U. S. circuit court. Filed Feb. 25, 1887. Timothy Griffith, clerk.

23 United States Circuit Court, Southern District of New York.
In Equity.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

Testimony taken on the part of the complainant under and pursuant to the 67th rule of the Supreme Court of the United States, as amended, before John A. Shields, Esq., a standing examiner of said court.

NEW YORK, *April* 14, 1887.

Present: Sam. Tro. Smith, Esq., of counsel for complainant, and W. W. Swan, Esq., of counsel for defendant.

Mr. JOSEPH T. DUNHAM, the complainant, called as a witness, and being duly sworn, testifies as follows:

Q. 1. Please state your name, age, residence and occupation?

A. Joseph T. Dunham, age 46 years, I reside in 74 Orange
24 street, Brooklyn, N. Y. I am a manufacturer of Dunham's patent combination tag envelope.

Q. 2. Are you the complainant in this cause?

A. I am.

Q. 3. Paper shown witness, and he is asked to look at the paper now handed him, being reissued letters patent of the United States, No. 10488, and state whether or not you are the inventor and patentee named therein?

A. I am.

The letters patent are offered in evidence and marked Complainant's Exhibit Dunham Reissue, April 14, 1887, J. A. S., ex'r.

Q. 4. Paper shown the witness, being letters patent of the United States, No. 331,118, please state whether you are the inventor and patentee named in these letters patent.

A. I am.

The said paper is offered in evidence and marked Complainant's Exhibit Dunham Second Patent, April 14, 1887, J. A. S., ex'r.

Q. 5. Please give the date of reissued letters patent No. 10488.

A. The 10th day of June, 1884.

Q. —. Please give the date and number of the original letters patent on the surrender of which reissue No. 10488 was granted.

A. The number is 277,245, and the date is May 8, 1883.

Q. 7. Please state whether you have put the patented articles described in these letters patent on the market and if so, at how early a date.

A. I did, immediately following the issue of the patents.

25 Q. 8. To what extent have you put your tag envelopes on the market?

A. I have sold nearly two millions and a half as far as I can judge.

Q. 9. Over what territory have these sales extended?

A. I think in every State and large city in these United States with few exceptions.

Q. 10. Papers shown witness; will you state whether the corporation named in the paper now shown you is the defendant in this cause?

A. It is.

The paper shown witness being a certificate of organization of defendant is offered in evidence and marked Complainant's Exhibit Defendant's Certificate of Organization, April 14, 1887, J. A. S., ex'r.

Q. 11. Will you look at the device now shown you and state what it is?

A. It is my patent combination tag envelope made under reissued patent No. 10488.

The same is offered in evidence and marked Complainant's Exhibit Dunham Reissue Specimen, April 14, 1887, J. A. S., ex'r.

Q. 12. Will you look at the two devices now shown you and state what they are?

A. They are my patent combination tag envelope made under patent No. 331,118, dated the 24th day of November, 1885.

The same are offered in evidence and marked respectively Complainant's Exhibit Dunham E & F, second patent specimen, April 14, 1887, J. A. S., ex'r.

26 Q. 13. Were the tag envelopes which you say you have introduced into the market made in form like the ones now presented by you, as Exhibit Reissue Specimen?

A. Exactly the same.

Q. 14. How long after introducing them, did you continue the sale?

A. Continually and incessantly to the present moment.

Q. 15. Will you state whether or not the manufacture and sale of these goods has been profitable?

A. It has.

Cross-examination suspended, in order to take Mr. Rogers' testimony.

Cross-examination by W. W. SWAN, Esq.:

X Q. 16. Do you mean by your answer to the 13th question to state that you have put upon the market tag envelopes like those marked Complainant's Exhibit E and F, second patent specimens?

A. I have some.

X Q. 17. About how many?

A. I can't state the number exactly like these.

X Q. 18. Do you mean by your answer to the interrogatory No. 8 to state that you have sold nearly two million and a half tag envelopes that were like your exhibit marked Dunham's reissued specimens?

A. No, sir; I mean on both patents.

X Q. 19. Which did you put upon the market first, tag envelopes like the one marked reissue specimen, or tag envelopes like those marked Exhibits E, F, second patent specimen?

A. I put the Exhibit Dunham Reissue Specimen on the market first.

27 X Q. 20. How long were the reissue specimens on the market before you put tag envelopes like the second patent specimens on the market?

A. About a year or so, I think a little over a year inside of 2 years, anyhow.

X Q. 21. The tag envelope that you have introduced as Complainant's Exhibit Dunham Reissue Specimen has printed upon it the following words: "Dunham's combination tag and envelope, U. S. patent, May 8th, 1883, June 10th, 1884, and November 24th, 1885. Joseph T. Dunham & Co., sole manufacturers, 12 Cortlandt street, New York." Why do you print on these envelopes the words, and November 24th, 1885?

A. Simply because my whole system of tag envelopes is patented under my patents.

X Q. 22. Does your second patent of November 24th, 1885, cover any feature of the tag envelope marked Complainant's Exhibit Dunham Specimen? If in your opinion it does, what feature is it?

Objected to as not properly cross-examination and as calling for expert testimony which the witness is not shown to be competent to give, and notice is given that a motion will be made at the proper time to strike out any testimony given in answer to the question.

A. I think it does most assuredly. Well, it is only the chicken with the feathers picked off. I can't answer that question.

X Q. 23. What do you mean by saying it is only the chicken with the feathers picked off?

A. I mean that the Dennison Manufacturing Company has robbed

my chicken, plucked its feathers, and is trying to sell it under disguise and evasion.

X Q. 24. In support of the motion for preliminary injunction in this case, your counsel served upon the defendant corpora-
28 tion an affidavit purporting to have been made by you as complainant in which you say, "Deponent further says that soon after he put the article into the market he ascertained that defendant was manufacturing and selling a combined tag and envelope substantially like the one described and shown in complainant's letters patent. Deponent further says that Exhibit G hereto attached is one of such combined tag and envelopes brought to the notice of deponent in the latter part of the summer or in the fall of 1883, and is the first one of which he had knowledge. Deponent further says that as the only difference between the article Exhibit G and deponent's patent device is that the deponent has shortened one of the flaps and made the attaching eyelet at the other end to cooperate with the shortened flap and accomplish the same purpose and as the very form used by defendant was one of the forms invented by deponent but not shown in his patent because he supposed and was informed by his solicitor that one covered the other, deponent considered it a direct infringement of his patent, and consulted counsel in relation to it, and was advised by his counsel as the letters patent were new and did not cover all his invention clearly, to surrender his patent and obtain a reissue."

The affidavit was sworn to, as appears in said copy served upon the defendant corporation, on the 24th day of January, 1887.

Q. When you swore to the affidavit did you believe the statement contained in the passage which I have quoted to be true?

Objected to as not properly in cross-examination, and the same notice of motion given as to question 22.

A. Yes.

29 X Q. 25. Do you now believe them to be true?

The same objection and notice.

A. Yes.

X Q. 26. In this same deposition sworn to by you on the 24th day of January, 1887, you go on to say: "That deponent did surrender said letters patent No. 277,245 and on the 10th day of June, 1884, obtained reissued letters patent No. 10488, but on account of the narrowness of the specification and drawings such reissue could not be made to include all of deponent's invention; whereupon by advice of counsel he made a new application, and on the 24th of November, 1885, obtained letters patent No. 331,118, covering the improvement in mailing and shipping envelopes shown in experimental Exhibits F^1, F^2, F^6 and F^7, and in Exhibit F^9, made under said last-mentioned letters patent." Did you believe the statements contained in this passage last quoted to be true when you made the affidavit, and do you now believe them to be true?

The same objection and notice as to interrogatory 22.

A. Yes, to both branches of the question.

X Q. 27. What do you mean by the sentence "But on account of the narrowness of the specification and drawings such reissue could — be made to include all of deponent's invention" which is found in the passage last quoted from your said affidavit?

The same objection and the same notice as to question 22. Also that there is no ambiguity in the language referred to.

A. I mean that the specification and drawing- in the first
30 patent did not show all the invention that I showed to my solicitor's clerk, who prepared the papers.

X Q. 28. Did you make the inventions referred to in the claims of your patent No. 331,118 before you applied for your patent No. 277,245 of which you took out reissue No. 10448?

The same objection and the same notice as to question 22. and counsel for defendant is reminded that it is using complainant's time and complainant's money in preparing and putting in his defense.

A. Yes.

X Q. 29. In your affidavit before referred to, you say "In consequence of this inconvenience deponent, previous to 1880, conceived the idea of an envelope tag to contain the invoice, and after turning it over in his mind for a year or two, commenced experimenting on the subject, continuing his experiments until he decided what he considered the most desirable form in which to construct a combined tag and envelope to meet the want felt by shippers; many of these experimental devices have been preserved, and the exhibits hereto annexed marked respectively, E, F^1, F^2, F^3, F^4, F^6, F^7 and F^8, are specimens of such preserved experimental devices, and were all designed and constructed by deponent previous to his application for a patent on January 15th, 1883." Are the statements contained in this passage true?

The same objection and notice as to question 22.

A. Yes.

31 It is stipulated by and between counsel for the respective parties that printed Patent Office copies may be substituted for the original letters patent put in evidence by complainant, which is done.

Mr. HERVEY E. ROGERS, a witness called on the part of the complainant, being duly sworn, testifies as follows:

Q. 1. Please state your name, age, residence and occupation.

A. Hervey E. Rogers; age, 25 years; I reside in 82 Hicks street, Brooklyn, N. Y.; I am a druggist.

Q. 2. Where is your place of business?

A. 31 and 33 Fulton street, Brooklyn.

Q. 3. Will you look at the device now shown you and state what it is?

A. This is a shipping tag I bought from the Dennison Manufacturing Company of Boston, Massachusetts, received January 19th, 1887, ordered a few days before.

Q. 4. Did you receive a bill with this order?
A. I did.
Q. 5. Will you produce it?
A. I do, this is the bill.

The device is introduced in evidence and marked Complainant's Exhibit Dennison's Patent Tag Envelope. April 14th, 1887. J. A. S., examiner.

Bill introduced in evidence is marked Complainant's Exhibit Dennison Bill for Patent Tag Envelope. April 14th, 1887. J. A. S., examiner.

HERVEY E. ROGERS.

Sworn — before me—
JOHN A. SHIELDS, *Examiner, &c.*

32 Adjourned to Friday, April 22nd, 1887, at 11 a. m.

NEW YORK, *April 22d*, 1887—11 o'clock a. m.

Adjourned to May 6th, 1887, at 11 o'clock a. m.

NEW YORK, *May 6th*, 1887—11 o'clock a. m.

Adjourned by consent of counsel to a day to be agreed on.

Circuit Court of the United States, Southern District of New York.

JOSEPH T. DUNHAM
vs.
DENNISON MANUFACTURING CO. } In Equity.

It is hereby stipulated and agreed by and between the parties herein that the time within which to take testimony in the above-entitled matter be, and the same hereby is, extended sixty (60) days from June 23rd, 1887.

Dated New York, June 16, 1887.

SAM. TRO SMITH,
Of Counsel for Pl'ff.
W. W. SWAN,
Of Counsel for Defendant.

33 NEW YORK, *August 23rd*, 1887—10 o'clock a. m.

Met pursuant to agreement.
Present: Counsel as before.

LEWIS L. BERGEN, a witness produced on the part of the complainant, being duly sworn, deposes and says:

Q. 1. Please state your name, age, residence and occupation.
A. Lewis L. Bergen, age 16 years, I reside at 448 Gates avenue, Brooklyn, N. Y., am not now employed at anything, but was lately a clerk in the Accident Insurance Company.
Q. 2. Do you know the place of business of the Dennison Manufacturing Company in New York?
A. I don't recollect the number, it is on Broadway.

Q. 3. Have you ever been there?

A. Yes, sir; I was there.

Q. 4. Look at the article now shown you and state if you know what it is?

A. This come from the Dennison Manufacturing Company with several others.

Q. 5. How do you know?

A. From my signature on this envelope tag.

Q. 6. How came it in your hands when you put your signature there?

A. It was handed me and I was requested to sign my name to it.

Q. 7. Where did you first see it and state the circumstances?

A. In Mr. Clapp's office, I saw it in a package of tag envelopes opened in Mr. Clapp's office.

Q. 8. Where did you first see that package of tag envelopes and state the circumstances?

34 A. In the office of the Dennison Manufacturing Company, I received it from one of their clerks.

Q. 9. How came the clerk to give it to you?

A. I bought them of him.

Q. 10. When was this?

A. As near as I can recollect it was in the latter part of December, 1886.

Q. 11. What did you do with the package of tag envelopes which you so purchased?

A. I brought them to Mr. Clapp's office.

Q. 12. And what became of them then?

A. They were opened by Mr. Burr and Mr. Dunham.

Q. 13. Into whose hands did you deliver them at Mr. Clapp's office?

A. Mr. Burr's.

Q. 14. After they were opened and you put your signature on this envelope as you have stated, what became of them as far as you know?

A. When I put my signature on I handed them to Mr. Dunham and he took them.

Cross-examined by Mr. SWAN:

X Q. 15. At whose request did you buy the package of envelopes you have spoken of?

A. At Mr. Burr's.

X Q. 16. Who is Mr. Burr?

A. A clerk in Mr. Clapp's office.

LEWIS L. BERGEN.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

35 Mr. WALTER C. BURR, a witness produced on the part of the complainant, being duly sworn, deposes and says:

Q. 1. Please state your name, age, residence and occupation.

A. Walter C. Burr, age 28 years, I reside in Brooklyn, N. Y., I am general agent of the Fidelity and Casualty Company of New York. Its place of business is at 214 and 216 Broadway, N. Y.

Q. 2. Do you know Joseph T. Dunham, the complainant in this suit?

A. I do.

Q. 3. Will you look at the article now shown you and state what it is and what you know about it?

A. It is one of a number of tag envelopes bought from the Dennison Manufacturing Company, in the latter part of December, 1886, as near as I recollect. I sent our young man in the office to the place of business of the Dennison Manufacturing Company to buy a package of tag envelopes, I gave him a five-dollar bill with which to pay for them and in a few moments he returned with a package of which this sample was one of the number, handing me the change. I opened the package in the presence of Mr. Dunham, and at his request I put my initials on several of the tags and also had our young man Mr. Bergen to do the same in order to identify them. The package or a portion of the package was given to Mr. Dunham, at least those that had the initials on them.

Cross-examined by Mr. SWAN:

X Q. 4. Did you use the remainder of the tag envelopes in your business?

A. I think not.

X Q. 5. Were they bought to be used as tag envelopes, if you know?

36 A. I don't know that they were.

X Q. 6. Why did you buy them?

A. I bought them at the request of Mr. Dunham.

WALTER C. BURR.

Sworn — before me—

JOHN A SHIELDS, *Examiner.*

Mr. JOSEPH T. DUNHAM recalled:

Q. 30. Mr. Dunham, the last witness Mr. Burr testifies that he delivered to you a package or part of a package of tag envelopes purchased from the defendants in the latter part of 1886, of which the article now shown you was one, will you state whether you received such package, and if so, what you did with it?

A. I did, and gave them to my counsel, Mr. Sam Tro Smith.

JOSEPH T. DUNHAM.

Sworn — before me—

JOHN A. SHIELDS, *Examiner.*

At the request of counsel for complainant, counsel for defendant now admits that the several envelopes now produced by complainant's counsel, are envelopes taken from the package handed to him

by Mr. Dunham, as stated in Mr. Dunham's last answer, and he further admits that the said envelopes have been in the hands of complainant's counsel since they were handed to him till the present time.

The article shown to the witness now introduced in evi-
37 dence marked Complainant's Exhibit Bergen Specimen, Dennison Tag Envelope, No. 2, August 23, 1887. J. A. S., ex'r.

Complainant's counsel produces five tag envelopes taken from said package to be marked Smith for identification, No. 1 to 5. August 23, 1887. J. A. S., ex'r.

Mr. HERVEY E. ROGERS recalled:

Q. 6. Look at the article now shown you any state what it is.

A. It is a combination shipping tag envelope.

Q. 7. Have you ever seen it before?

A. I have, yes, sir.

Q. 8. Will you state where and under what circumstances.

A. I bought them of the Dennison Manufacturing Company at Boston, and they were sent to me by express. I received them, if I remember rightly, on the 19th day of January, 1887.

Q. 9. What shape were they in when you received them?

A. They were packed in a pasteboard box.

Q. 10. What did you do with them?

A. Some of them I used for shipping purposes. The balance I sold to Joseph T. Dunham.

Q. 11. When, as near as you can state, were they delivered to Mr. Dunham?

A. Within a week after I received them.

Cross-examined by Mr. SWAN:

X Q. 12. How did you use the tag envelopes which you say you used for shipping purposes?

A. I used them marking parties' names that I shipped goods to and enclosed the bill for the same.

38 X Q. 13. Did you seal up the bottom flap?

A. I did.

X Q. 14. This envelope which you had in your hands when testifying, has its upper flap unfastened, was that the case with those you used in your business?

A. I don't think they were.

X Q. 15. How were the upper flaps fastened in those that you used in your business?

A. I never took any particular notice before how they were fastened. They seem to be fastened by an eyelet with paste on the edge of the flap.

HERVEY E. ROGERS.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Complainant's counsel produces the article shown to witness, to be marked Exhibit Hervey E. Rogers for identification.

Also four other similar articles to be marked Exhibit Smith for identification, Nos. 6 to 9, all of them being tag envelopes taken from the package purchased by Mr. Rogers as stated in his testimony.

Counsel for defendant admits that such envelopes were taken from the package referred to by the witness, Rogers, in his testimony.

The envelope referred to in cross-question 12 is the one marked Hervey E. Rogers, for identification.

39 Mr. HENRY CONNETT, a witness produced on the part of the complainant, being duly sworn, deposes and says:

Q. 1. Please state your name, age, residence and occupation.

A. Henry Connett, age 45 years; I reside at Brooklyn, occupation, patent solicitor and expert.

Q. 2. Do you know the complainant in this suit, Mr. Dunham?

A. I do.

Q. 3. Did you obtain letters patent No. 331,118 for him on a shipping tag and mailing envelope?

A. I did.

Q. 4. What is the date of that patent?

A. November 24th, 1885.

Q. 5. Did you at any time serve a notice on the defendant in reference to this patent?

A. I did.

Q. 6. Please produce it.

A. I have produced the press copy letter book of my firm, Burke, Frazer and Connett, containing a press copy of the letter sent to the Dennison Manufacturing Company, on March 23rd, 1886, by my late firm.

Complainant's counsel request defendant's counsel to produce the original letter, of which the paper referred to by the witness is a press copy.

Defendant's counsel states that he is unable to do so at present.

Q. 7. Please read so that it may be entered on the record, the press copy to which you refer.

A. I will, it is as follows:

40 "MARCH 23RD, 1886.

Dennison Manufacturing Company, No. 198 Broadway.

GENTLEMEN: We have been shown a tag envelope made and sold by you which is, in our opinion, a clear infringement on the patent of our client Mr. Joseph T. Dunham, No. 331,118, of November 24th, 1885, a copy of which we enclose.

Mr. Dunham desires us to say that he is determined to protect himself in the exclusive rights guaranteed by his patent, and hereby notifies you that you must cease such infringement at once.

The tag we refer to as made by you comprises a combined tag and envelope, and has coinciding reinforced holes in the flap and front ply of the body, but not in the back ply. This enable the envelope to be opened and its contents inspected without untying the string.

Very respectfully,

BURKE, FRASER & CONNETT."

HENRY CONNETT.

Sworn to before me—

JOHN A. SHIELDS,
Examiner, &c.

Complainant's counsel requests defendant's counsel to produce a notice served on defendant in reference to the infringement of complainant's reissued letters patent, No. 10488, and served on defendant about the early part of 1885.

Defendant's counsel produces such a notice and since it
41 bears no date, says that he cannot at present tell when it was received.

Complainant's counsel produces notice, which reads as follows:

To the Dennison Manufacturing Company:

Mr. Joseph T. Dunham has called upon me with a combined tag and envelope, said to be of your manufacture, which he contends is an infringement of his rights as secured to him by his reissued letters patent, No. 10488, granted him in the United States Patent Office, on the 10th day of June, 1884, for a combined tag and envelope. I have examined his said letters patent, and the tag said to have been manufactured by you, and am of the opinion that said tag is clearly an infringement of Mr. Dunham's right, as set forth in the claims and specifications.

You are therefore hereby warned and notified to desist from such infringement and to settle for the profits and damages arising from past infringement without delay. The patent of Mr. Dunham may be seen at my office and a settlement and adjustment made by calling on me.

Your early attention to the matter is requested which will obviate the necessity of resorting to the courts to protect Mr. Dunham's rights in the premises.

Respectfully yours, SAM. TRO SMITH.
Att'y for Joseph T. Dunham.

Complainant closes his *prima facie* case.

It was consented on the record that the time for taking testimony be extended till the 15th of November.

42 COMP'T'S EXHIBIT DENNISON BILL FOR TAG ENVELOPE.

April 14, 1877. J. A. S., Ex'r.

DUNHAM
vs.
THE DENNISON MFG. CO.

H. E. F. 1, 19, 87

Dennison Manufacturing Company, tags, gummed labels sealing wax, jeweler's findings, morocco, plush & velvet, jewelry, and silver-ware cases, &c., &c. Boston, Philadelphia, Chicago, Cincinnati, St. Louis.

26 & 28 FRANKLIN ST., BOSTON, *Jan.* 18, 1887.

Sold to H. E. Rogers, 33 Fulton St., Brooklyn.

500 pat. tag env., No. 7..... 7 00 3 50

Received payment.
Jan. 18, 1887.

DENNISON MFG. CO.
E. E. SULEN.

H. E. R.
1, 19, 87.

43 United States Circuit Court, Southern District of New York.

JOSEPH T. DUNHAM
v.
THE DENNISON MANUFACTURING COMPANY. (In Equity.)

Testimony in Rebuttal.

MAY 10, 1888—11 a. m.

Met by agreement.

THOMAS W. BRACKETT, being duly sworn as witness on the part of the complainant, testifies as follows:

1 Q. What is your name, age, residence, and occupation.
A. Thomas W. Brackett; thirty-nine years; occupation, route agent and freight solicitor, National Express.
2 Q. How long have you been engaged in the express business?
A. Twenty-three years.
3 Q. Are you acquainted with the complainant, Joseph T. Dunham?
A. I am.
4 Q. How long have you known him?
A. About nine years.
5 Q. Are you familiar with his tag envelope, which he has in the market, and if so, have you seen it in use?
A. I have, and am familiar with it.

6 Q. When did you first see anything in use upon freight or express packages or other wares in the shape of the tag
44 envelope? I mean an envelope so constructed that it could be used as a tag for marking the package, and also as an envelope for conveing an invoice of the goods contained in the package.

A. The first time I saw one in use was on the stand of Dunham & Schofield, fish mongers, Washington market, in the year 1883.

7 Q. Will you look at the article now shown you, marked "Comp't's Exhibit Dunham Reissue Specimen, April 14, 1887," and state whether or not the tag envelope you then saw was similar to this?

A. It was.

8 Q. When, if ever, did you first see any other tag envelope in use in the market?

A. I never saw any.

9 Q. Will you look at the envelope now shown to you, and state whether or not that would be a practicable tag to be used for packages to be sent by freight or express?

A. I don't think it would. In the first place, nothing to fasten the envelope to package, and if sealed by gum on other end, would be likely to be opened by the moisture of the weather, or if put on wet packages, be opened by same and invoice lost out.

10 Q. If attached to a package by the string which holds down the flap, would or would not that constitute a practicable tag, regardless of the invoice contained in the envelope?

A. It would not.

11 Q. Will you give reasons why?

A. First reason—attached by a string, the tag would become moist by wet weather and would pull fron the string and be lost. Next reason, our instructions are to see that goods are properly marked either by tie-tag securely fastened to the package or marked by ink.

12 Q. Would or would not the fact that the attaching string does not extend through the body of the envelope and is located
45 not at the end or edge of the tag, but, comparatively speaking, in the centre thereof, render it impracticable or an improper marking of packages, whether in wet weather or dry?

A. I think it would.

13 Q. For what reason?

A. Because there is nothing to hold the tag or prevent it pulling through, as displayed in sample.

14 Q. Would or would not a tag so fastened, be liable to be caught against other packages by the projecting end or corners, and thus torn from its fastenings?

A. It would.

The envelope shown witness as above is offered in evidence and marked Comp't's Exhibit "Schultz Tie Envelope, May 10, 1888—J. A. S., ex'r."

15 Q. Will you look at the paper now shown you marked Def's

Exhibit "Pultz & Walkley Tag Envelope, J. A. S., ex'r," and state whether or not that would be a practicable tag envelope to be used for marking packages and conveying the invoice?

A. I don't think it would.

16 Q. For what reason?

A. There is nothing to hold the flap down after it becomes moistened.

17 Q. In using tag envelopes on packages which are in barrels or boxes containing ice for the preservation of the contents thereof, what effect would the ice have on the envelope attached to the outside of the package?

A. The envelope would become wet and useless for either purpose as a tag or envelope.

18 Q. Will you state whether, according to the rules of the company by whom you are employed, such articles as the Schultz envelope and the Pultz and Walkley tag envelope, would or would not be accepted as a proper marking of the packages shipped by said company?

A. It would not be accepted.

46 Cross-examination by Mr. SWAN:

19 X Q. If the string holes in the "Exhibit Schultz Tie Envelope" were reinforced by metallic eyelets as in Exhibit Dunham Reissue Specimen, or by paper washer, as in Exhibit Dunham 2d Patent Specimen, would any of the objections which you find in the use of the Schultz exhibit as a tag envelope be removed?

A. They would not.

20 X Q. Would the envelope be liable to be torn from the string in the manner you describe?

A. It may not be torn from the string, but would become useless if subject to damp weather or come in close contact with wet packages, as in the Exhibit Schultz Tie Envelope, one side of the body is merely held by paste or mucilage, and if it became damp or wet would fall apart.

21 X Q. Would there be any other objection than the one you have just specified to the use of the Schultz envelope if reinforced by metallic eyelets or paper washers?

A. I know of none.

22 X Q. Have you stated all the objections that you find to the use of tag envelopes like the Pultz and Walkley exhibit?

A. I have.

T. M. BRACKETT.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Testimony of R. H. Dumbleton.

1 Q. What is your name, age, residence and occupation?

A. Name, Robert H. Dumbleton; age, 45 years; residence Brooklyn; occupation, expressman.

2 Q. With what company are you employed?

A. The American Express Company.

3 Q. What position do you hold in that company?

47 A. Assistant agent.

4 Q. How long have you been engaged in the express business?

A. 20 years.

5 Q. In what capacity did you commence?

A. In the wagon service.

6 Q. During that time how familiar have you been with the methods of marking packages transmitted by the companies with whom you have been employed?

A. I have seen thousands of packages and observed their marking.

7 Q. When did you first know of the use of tag envelopes being used for marking packages and sending invoices of the goods contained in the packages?

A. I am unable to give the date or year. As near as I can recollect, 5 years ago.

8 Q. Can you state whose tag envelope it was that you first saw on the market?

A. It was one shown me in use on the fish stand of Dunham & Schofield, Pier 24, North river.

9 Q. Was this on a package sent over your line?

A. Can't say as to that.

10 Q. Have you seen such tag envelopes on packages sent over your line?

A. I have.

11 Q. Have you previous to the time of first seeing one of their tag envelopes, seen any similar device for marking packages?

A. I never did.

12 Q. To your knowledge, was there any similar device in the market previous to that time?

A. Not to my knowledge.

13 Q. How extensive a business in expressing packages is done by the American Company?

A. Probably one of the largest in the city.

14 Q. Had tag envelopes been in use for sending packages by express previous to 1883, would you have been likely to have known it from your connection with the express business?

48 A. I would.

15 Q. Will you look at the papers now shown you, "Complainant's Exhibits Schultz Tie Envelope," and "Defendants' Exhibit Pultz & Walkley Tag Envelope," and state whether or not either of them would be a practicable tag envelope for marking packages and enclosing invoices of goods, to be transmitted by express or otherwise?

A. I would not consider them proper marks for goods to be forwarded by express.

16 Q. Will you state your reasons why they would not be proper marks for packages of goods?

A. From their general construction, being secured with gum; moisture or wet weather would cause them to come apart and thus lose the contents.

17 Q. Would the provision made for tying the flap of the Schultz tie envelope down to the envelope with a string be a proper or sufficient means of attaching such envelope to a package as a tag?

A. It would not.

18 Q. Would or would not such envelope attached to a package in that form as a tag be liable to be torn loose by its contact with other packages?

Objected to as leading.

A. It would.

No cross-examination.

R. H. DUMBLETON.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, Etc.

Testimony of ROBERT A. MCKINNEY; being produced and duly sworn, testified as follows:

1 Q. What is your name, age, residence and occupation?

A. Robert A. McKinney; age, 49; residence, Orange, N. J.; occupatio, manager International Express.

2 Q. How long have you been engaged in the express business?

49 A. 35 years.

3 Q. In what capacity did you commence your services in the express business?

A. Pasting labels on packages.

4 Q. How familiar have you been with the methods of marking packages transmitted by express?

A. I had general supervision of the freight department for 15 years.

5 Q. Over how extensive a country does the business of your company extend?

A. The whole of New England and part of Pennsylvania.

6 Q. Have you been connected with any other companies, and if so, with which companies?

A. I have been connected with the American Express Company for more than 30 years.

7 Q. When did you first see a tag enveloped used for marking packages and also sending invoice of the goods contained therein?

A. I can't give the exact time, not more than 3 or 4 years.

8 Q. Whose tag envelope you first saw?

A. Dunham's.

9 Q. Previous to 1883 did you ever see any tag envelope in use or in the market?

A. No, sir.

10 Q. If such tag envelopes had been in use previous to that time for marking express packages would you have been likely from your knowldge of the express business to have seen them?

A. I believe I would.

11 Q. Will you look at the Exhibits Schultz Tie Envelope and Pultz and Walkley Tag Envelope, and state whether either of them would or would not be a practicable tag envelope for marking packages and sending invoices of the goods contained in the package?

A. I should think not.

12 Q. Will you state your reasons?

A. I should think the ends and sides were insecurely
50 fastened together, and would apart when wet.

13 Q. Would or would not such envelopes be accepted as proper marking tags by any of the express companies with whom you have been employed?

A. I should think not.

No cross-examination.

ROBT. A. McKINNEY.

Sworn — before me—
JOHN A. SHIELDS, *Examiner, &c.*

Adjourned to 17th inst., same place, 11 a. m., by consent.

NEW YORK, *May 17th*, 1888, 11 a. m.

Met pursuant to adjournment.
Present: Counsel as before.

THOMAS DOOLEY, a witness called by the complainant, having been duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.

A. Thomas Dooley; age, 55; residence, Jersey City, N. J., and occupation, an expressman.

2 Q. With what company are you employed?

A. The United States Express Company.

3 Q. How long have you been engaged in the express business?

A. Twenty-eight years.

4 Q. What are the principal express companies in the United States?

A. The United States, Adams, Wells, Fargo & Company, National Express, International Express; those are about the principal ones, and American.

4 Q. What portion of the territory of the United States do these expresses cover in their business?

A. I should say, taking them all together, that they cover all of the United States.

51 6 Q. In what capacity did you commence business in the express line, and at what age?

A. I commenced as a freight handler in the office, at 82 Broadway, at about 26 years of age.

7 Q. How much of the time since then have you been engaged in the business?

A. All the time.

8 Q. What is your present position in the company?

A. I am the driver of a money delivery wagon.

9 Q. Are you simply the driver or do you have charge of the money which is delivered from the wagon?

A. I have full charge of the money.

10 Q. In 1881, and previous to that time, were you familiar with the methods of marking packages of freight handled by express companies?

A. Yes, sir; I had charge of picking up freight for the last fifteen years, and was familiar with the way of marking packages.

11 Q. When did you first see a tag envelope for marking packages of freight and also conveying the invoice of goods?

A. I am not positive as to the dates; I think it was in the neighborhood of 1883 or 1884. The first one that I saw was Mr. Dunham's.

Comp't's Exhibit Dunham's Reissue Specimen D shown witness.

12 Q. Do you mean Dunham's patent combination tag envelope, like the one now shown you?

A. Yes, sir; this is the same as the one I first saw except that it was not in a printed form.

13 Q. In your business during that time would you have been likely to see tag envelopes for marking packages and carrying the invoice of other descriptions than Dunham's if they had been in use at that time?

A. Yes, sir; I would.

14 Q. Will you look at the papers now shown you Def't's.
52 Exhibit Pultz & Walkley Tag Envelope and Comp't's Exhibit Schultz Tie Envelope and state whether or not they would be practical devices for marking packages to be sent by freight or express, and whether or not your company would accept packages marked on such envelopes, supposing the Pultz & Walkley tag envelope to be fastened by a string through the eyelet and the Schultz tie envelope to be fastened by the string which holds the flap down to the body of the envelope?

A. In my opinion I don't think they would. I don't think the companies would receive packages so marked. The Schultz tie envelope would be liable to tear out. In the other one the strings would hold. The only objection that I see to the Pultz & Walkley envelope is that it is common paper and would be likely to be torn or damaged by getting wet.

15 Q. Would or would not the fact of these envelopes being secured only by gum render them liable to become unfastened in damp weather or when attached to damp packages, particularly packages containing ice, and render them liable or likely to become opened by the softening of the gum and thus allowing the enclosed invoice to escape and be lost?

A. Yes, sir; it would. I have had letter envelopes put on boxes

where there was ice and they have become wet and rubbed off by other packages coming against them.

Cross-examination:

16 X Q. What kinds of goods does your company transport?

A. They transport all kinds of goods, dry goods, hardware, fish, ice; in fact, all kinds of goods.

17 X Q. How frequently is a package not containing ice likely to come in contact with a package containing ice, and how frequently is a package carried by your company likely to become wet in any manner?

53 A. Well, very often packages that don't contain ice come in contact with packages containing ice; for instance, I might receive a box of fish at the market containing ice, and if I received a box of fruit or dry goods and put it on top of that it would get damp, if not actually wet.

18 X Q. Do you ever carry printing-paper or wrapping-paper?

A. I have carried wrapping-paper.

19 X Q. Do you think that if you carried a package of wrapping paper from New York to Boston it would run any danger of becoming wet from packages containing ice carried at the same time or otherwise?

Objected to by complainant's counsel unless the inquiry is confined to the outside of the package where the mark is found, as witness's testimony on the direct examination refers only to the marking tag on the outside of the package.

A. I have seen packages come in our cars which have got wet by accidentally falling over where they have been piled up.

20 X Q. Do you mean to say that your company would refuse to accept for transportation a package of wrapping-paper weighing, say, 50 pounds, if it were presented to the company with a tag envelope like the Pultz & Walkley exhibit attached thereto, bearing the address of consignee and containing an invoice of the goods?

A. I can't say that the company would refuse it, but from the instructions they gave me when I used to collect I would not receive it without some other mark on it.

THOS. DOOLEY.

Sworn — to before me—

JOHN A. SHIELDS,
Examiner, &c.

54 SYLVESTER CASTLE, a witness called by the complainant, having been duly sworn, testifies as follows:

1 Q. What is your name, age, residence and occupation?

A. Sylvester Castle; age, 43; residence, Jersey City, N. J.; and occupation, expressman.

2 Q. How long have you been engaged in the express business?

A. Fifteen years.

3 Q. With what company are you employed?

A. Wells-Fargo.

4 Q. What position do you hold in that concern?

A. Receiving freight—packing up freight.

5 Q. In and before 1881 were you familiar with the method of marking packages sent by freight and express?

A. Yes, sir.

6 Q. When did you first see packages marked with a tag envelope containing a receptacle for carrying the invoice?

A. To my best recollection it was about in 1883 or 1884 or somewhere along there.

7 Q. State if you know, of whose manufacture such tag envelope was.

A. Mr. Joseph T. Dunham.

8 Q. Look at the tag envelope now shown you, marked Comp't's Exhibit Dunham Reissue Specimen, and state whether or not the first you saw was similar to this specimen.

A. Yes, sir.

9 Q. From your business in receiving and handling packages sent by express, if other tag envelopes had been in use previous to that time would you have been likely to see them?

A. Yes, sir.

10 Q. Please state whether previous to 1881 you had ever seen or heard of such a method of marking packages.

A. No.

55 11 Q. Will you look at the exhibits now shown you marked Def't's Exhibit Pultz & Walkley Tag Envelope, and Comp't's Exhibit Schultz Tie Envdlope, and state whether such envelopes would be practical marking tags for packages sent by express, either simply as marking tags or as tag envelopes to carry the invoice of the goods?

A. They would not, because the Schultz tie envelope has no proper fastening or string and would tear out; the string is stronger than the paper. The Pultz & Walkley tag envelope is of very poor paper for one thing, and the flap is liable to come open at any time and lose the invoice, and I have occurrences every day of the gum becoming loose and the invoice falling out.

12 Q. Would or would not the lower flap and two side flaps of the Schultz envelope be subject to the same difficulty of becoming loose by softening of the gum, and allowing the envelope to escape?

A. Yes, sir.

13 Q. Would or would not the fact that the string of the Schultz envelope by which it would be attached to the package, is not at the end but on the side of the envelope, some distance from the end, render it liable to be torn off by coming in contact with other packages?

Objected to as leading.

A. Yes, sir.

14 Q. According to the rules of your company regarding the marking of packages, state whether or not the packages marked by either of these last-named envelopes would be received for transportation.

A. I think not, to the best of my opinion.

Cross-examination:

15 X Q. Do you refer to tag envelopes when you say in answer to interrogatory 11: "I have occurrences every day of the gum becoming loose and the invoice falling out"?

56 A. Yes, to tag envelopes.

16 X Q. Of whose manufacture, if you know?

A. I won't be positive. I think it is Dennison's.

17 X Q. Who in your company receives packages marked with the tag envelopes, in the use of which the gum becomes loose and the invoices fall out?

A. Myself.

18 X Q. Is it not contrary to the rules of your company to receive for transportation goods thus marked?

A. No, sir.

Redirect examination:

19 Re-D. Q. Will you look at the exhibit now shown you, marked Comp't's Exhibit Dennison's Patent Tag Envelope, and state whether that is such an envelope as you referred to in answer to question 11, in which you say, "I have occurrences every day of the gum becoming loose and the invoice falling out."

A. Yes, sir.

SYLVESTER CASTLE.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

WILLIAM H. WEEKS, a witness called by the complainant, having been duly sworn, testifies as follows:

1 Q. What is your name, age, residence and occupation?

A. William H. Weeks; age, 50; residence, 508 Willoughby avenue, Brooklyn; and occupation, clerk in the poultry business at Fulton market, New York.

2 Q. With what firm are you engaged?

A. A. & M. Robbins.

3 Q. How extensive is their business?

57 A. Probably $500,000 a year; that is within bounds. We consider that we are the biggest poultry dealers in the world.

4 Q. To what places does your firm ship goods?

A. Principally throughout the United States and a great part of Europe and Canada also.

5 Q. How long have you been engaged in the business?

A. 27 years.

6 Q. Were you familiar with the methods in use for marking packages in transportation in use in 1882 and previous to that time?

A. Yes, sir.

7 Q. Are you familiar with tag envelopes?

A. Yes, sir.

8 Q. When did you first see a tag envelope in use for marking packages for transportation, and also conveying the invoice of the goods contained in the package?

A. I can only say that I never saw a tag envelope that was fit for use until I saw the Dunham tag envelope; the others that I saw were not fit for use because they were not safe, as the invoices were lost in transportation. A great many times I have had to send duplicate invoices, in case the original ones were lost, until I got the Dunham tag envelopes, since using which I have never lost one invoice, to my knowledge.

9 Q. Will you look at the exhibit now shown you, marked Defendants' Exhibit Pultz & Walkley Tag Envelope and Comp't's Exhibit Schultz Tie Envelope, and state whether, in your opinion, they would be practical tag envelopes for marking packages in your business and sending invoices of the contents?

A. No, sir; I would not risk invoices in those envelopes, and I will tell you the reason why. A great many of our goods, especially during 9 months of the year, are shipped in ice, with cloth covers, and these tags, being gummed together, would come apart and lose the invoice, and I would not risk an invoice in one of those tag envelopes.

58 10 Q. In the Schultz envelope the string which attaches the flap to the front of the body being an inch or more from the end of the envelope, and the only means of attaching an envelope to a package; would, or would not that be a safe marking tag, even if there was no invoice sent with it?

A. I would not risk it for our goods, because I think it would be unsafe, and would not last until it got to the railroad cars.

WILLIAM H. WEEKS.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, etc.

WILLIAM H. MIDDLETON, a witness called by the complainant, having been duly sworn, testifies as follows:

1 Q. What is your name, age, residence and occupation?

A. William H. Middleton; age, 60; residence, 4 Brevoort place, Brooklyn; and occupation, fish dealer in Fulton market, New York.

2 Q. What is the name of your firm?

A. Middleton, Carman & Co.

3 Q. How long have you been engaged in that business?

A. About 40 years.

4. Q. Are you familiar with the methods of marking goods for transportation?

A. I am.

5 Q. When, if ever, did you first see a tag envelope constructed with a pocket for carrying the invoice of the goods contained in the package marked by it?

A. The first one I ever saw was one Mr. Dunham showed me. I think it was four or five years ago. I don't remember.

59 6 Q. Previous to that time had you ever known or heard of such an article being used in the market?

A. I never had.

7 Q. Will you look at the exhibits now shown you, marked Pultz & Walkley Tag Envelope and Comp't's Exhibit Schultz Tie Envelope, and state whether they or either of them, would be practical tag envelopes for marking packages, and conveying with the package the invoice of the goods therein contained?

A. I don't think they would. I don't think they are any better than a common envelope.

8 Q. What particular objection would you have to their use?

A. Well, in the first place, there is no security about them. If they got wet with the rain they would come open and tear out and lose the invoice.

9 Q. Will you state your opinion as to whether a gum or mucilage fastening for an envelope is a sufficient security when the envelope is sent by express, or as freight, to be exposed to damp weather for days and nights, whether the envelope should become wet by rain or not?

A. My opinion is that it would be very insecure. The dampness would make the envelope so moist that it would tear open.

10 Q. Will you look at the exhibit now shown you, marked "Dunham's Reissue Specimen," and state whether or not that is the Dunham tag envelope you have referred to?

A. Yes, sir, that is it.

11 Q. In your business please state whether it is or not important that the invoice should be sent with the goods.

A. It is very important in a great many cases.

Cross-examination:

12 X Q. Can you not distinguish between the Pultz & Walkley envelope and the common envelope?

A. All the difference I can see is the eyelet at the end.

60 That would come off just as quick if it got wet.

13 X Q. What distinction do you draw between the eyelet in the Dunham specimen in that respect and the eyelets in the Pultz & Walkley exhibits?

A. Well in the Dunham it is in three parts, and is that much stronger.

14 X Q. What is in three parts?

A. The eyelet.

15 X Q. Which eyelet is in three parts?

A. It is in three parts when it is together.

16 X Q. For what purpose is the reinforcement used in the Pultz & Walkley exhibit?

A. I suppose it is put there to add strength.

WM. H. MIDDLETON.

Sworn to before me—

JOHN A. SHIELDS,
Examiner, &c.

JOSEPH T. DUNHAM, the complainant, recalled as witness:

1 Q. What business were you engaged in when you put your tag envelope on the market?

A. Wholesale fish business.

2 Q. How early, if you can state, did you first use one of these tags for marking packages?

A. Positively never until my patent from Washington came to me in May, 1883.

3 Q. Previous to that time were you familiar with the methods used in marking packages to be sent by express as freight?

A. Yes, sir; in every case.

4 Q. For how long had you been so familiar?

A. From 1866 or 1867 continuously to this time—after leaving the army.

5 Q. What was the ordinary method of marking packages?

A. There were several. In the early part of my experience marking was done by pot and brush, then by Dennison tag,
61 which came into use exclusively, which was all the effective marking, until my invention came into use.

6 Q. What first led you to the invention of the tag envelope?

A. The daily shrinkage of my pocketbook from the losses in shipping goods marked in the ordinary way then in vogue, and not being able to get the invoice to the consignee until after the goods had been sent, causing the firm of which I was the head much loss, as stated, as the goods were perishable and often times sold on the supposition of previous price when the market had changed from stormy weather or other reason. When once sold in this way by the consignee, it was impossible to get the loss refunded. This caused me to turn this thing over in my mind to obviate this difficulty.

7 Q. Did you or others to your knowledge try any other methods besides using a tag envelope for sending the invoice of the goods, and if so, describe them?

A. Yes. It was the general practice for some to cut a hole in the burlap cover, place the bill in an ordinary envelope, twist it up and shove it on top of the ice under the cover, and nine times out of ten the bill would be pulp before it reached the consignee. In this case we also nailed them, that is, the common envelope, under the first hoops of the barrel, but they would get torn off by becoming damp from exposure and from handling by expressmen who were not careful, as this was not the mark on the package. We also nailed them on boxes, that is, a common envelope, with bill enclosed, and sometimes they would be torn off before they got on the express wagon. This led to my invention. As I knew that a strong envelope combined with a tag and brought together made of strong rope paper wherein there would be coinciding eyelet holes, in case of a long flap would accomplish the purpose. In the case of a short flap
I could re-enforce the sealed end with an eyelet hole and
62 leave the flap and body of the upper end of the envelope open for placing the bill in the tag. This is not as desirable

as the long flap. Although if the gum should come off, the lower eyelet would hold the tag envelope intact.

8 Q. When you first introduced this tag into the market, did you send out agents, or go out yourself for that purpose?

A. I went out myself, and sent agents at first with these goods.

9 Q. Did you either send an agent or go yourself into a portion of the New England States, and, if so, where did you go?

A. I did; I went myself as far as Portland, Maine, at that time, stopping at all the cities, and most of the small towns, Boston being the objective point.

10 Q. Please state about what time you made that first trip.

A. I think, as near as I can remember, it was from the 15th to the 20th of May, 1883.

11 Q. With how many shippers did you have interviews at that time in relation to your invention?

A. I should think between 200 and 300 at that time.

12 Q. How was it received by them?

A. With much satisfaction and with merchants placing orders immediately in my hands; 30,000 within three or four hours, on Commercial wharf, Boston, in that case being sold.

13 Q. How many shippers or other persons did you interview on that trip, if any, who stated to you that they had ever seen or heard of the tag envelope made for sending the invoice with the goods?

A. There were none who stated that they ever saw them before.

14 Q. What, if anything, did these parties say in relation to the novelty or usefulness of the invention?

Objected to as immaterial.

63 A. They said it was a long-felt want, just the thing they needed, and gave me their orders.

Adjourned to Friday, May 18th, at 11 a. m.

NEW YORK, *May 18th*, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: Counsel as before.

The examination of Mr. JOSEPH T. DUNHAM continued by Sam. Tro. Smith, Esq.:

15 Q. Mr. Dunham, in how many of the Eastern States did you travel at the time referred to, and how extensively did you show your tag envelope in each?

A. In all the Eastern States, and as far as I can remember in all the large cities, and in the largest towns of 4,000 or 5,000 inhabitants.

16 Q. Had you, previously to that time, travelled in the same territory; and, if so, for how long and for what purpose?

A. I had, every year, more or less, from 1866 as far as I can remember down to that time and since, in business that I was connected with. I called on principally fish and produce dealers, and I am personally acquainted more or less with the principal merchants from Montreal to New Orleans.

17 Q. Did you at any of those trips come across anything in the shape of tags or tap envelopes manufactured by Pultz & Walkley of Plantsville, Connecticut, and if so, please describe the same?

A. I never saw a tag envelope of any one's make previous to my own, but I did see cards nailed on packages as tags, and the Dennison tag, which was principally in use, and about 1874 I saw an ordinary tag, made in the same manner as the Dennison, with the tin eyelet clinched on the back side, having only the patent mark on and no mark of identification of who the manufacturer was.

64 This I considered at that time an infringement, as far as I know, on the Dennison patent tag, as it was made under the same principle, yet it was better.

18 Q. Please state whether or not the same eyelet with the same patent mark is found on any of the exhibits in this case.

A. Identically the same as on the "Def't's Exhibit Pultz and Walkley Tag Envelope," also in "Def't's Exhibit P. & W. Company Tag Envelope No. 2," also on Exhibit Hall Tag Envelope.

19 Q. Did you at that time see any other tags containing a similar eyelet?

A. I did not.

20 Q. When and where did you first find a tag envelope other than your own?

A. I think in the fall of 1883, immediately following the introduction of my own, either in Boston or sent to me from Boston, and made by the Dennison Manufacturing Company.

Answer objected to as not in rebuttal.

21 Q. What kind of an eyelet did that have, if any?

Objected to as not in rebuttal.

A. The eyelet holes in that was on the free end of the flap, not made like the present one in Exhibit "Comp't's Exhibit Dennison Patent Tag Envelope," in that there was no re-enforced brass eyelet, but the paper washers were placed on the back body of the envelope and one on the flap coinciding eyelet holes, and the bottom being sealed with gum tight, leaving the envelope open to place the bill inside; it had the patent mark of Dennison on the washer which was pasted on the envelope, which I thought at the time was a violation of the patent laws.

Answer further objected to as not in rebuttal, and also as containing volunteer testimony not called for by the question.

65 22 Q. From your connection with the business of shipping goods and dealing with men largely throughout the country who were engaged in shipping goods, would you have been likely to have seen tag envelopes if the same had been in use previous to your invention?

A. Most assuredly I would.

23 Q. Will you look at Defendant's Exhibit Pultz & Walkley Tag Envelope and state whether or not it would be a practical tag

envelope for marking packages of goods and sending the invoice of the articles contained in the package?

A. It would not, for many reasons. The first: It being nothing but an ordinary envelope made of jute paper, there is no strength to the paper when wet, and consequently when placed in a package of any kind the gum would loosen and the contents come out, as the paper being wet would make it rotten, and lack of strength in the paper would cause it to break from the eyelet.

Secondly: Any package coming in contact with it handled roughly as expressmen handle goods would break it loose from its fastening even if not wet.

Thirdly: Merchants would not adopt anything of the kind where there is such a lack of safety as from general practice tried many times with ordinary envelopes being nailed to packages which were placed on in a stronger manner than the eyelet would give it, and failed, having tried it many times myself with much loss.

24 Q. Would, in your opinion as a shipper, such a device be accepted by express companies as a proper mark for packages?

A. It would not from my own experience.

25 Q. Will you look at Compt's Exhibit Schultz's Tag Envelope and state whether that would be a practical tag envelope for marking packages and sending invoices of the contents?

A. By no means.

66 26 Q. For what reason?

A. The whole construction is nothing more than an ordinary envelope with the exception of a string placed through one thickness of a backbody which would break out nine times out of ten when tied on packages even if on a bag of salt. This language applies to a tag alone, for a tag envelope the gum is very poor, the envelope is not half sealed, and it would not be a proper thing to place a bill in to a consignee, which would be liable to be lost through dampness to which all express packages are liable, in most every carload, wet freight being carried with dry, melting ice causing a dampness which occasionally causes the gum to soften and let the contents out. It is very essential that a tag envelope should be constructed in a different manner, as all express packages are liable to be wet by the rain from exposure even in carrying from the building to their wagons in bad weather, heavy rain storms would sometimes wet an ordinary envelope all through.

27 Q. Please state whether in your opinion such an article would or would not be safe from being opened by softening of the gum by moisture, even if it were well gummed.

Objected to as leading.

A. It would not, as the exhibit shows.

28 Q. You have spoken of a Dennison tag envelope without metallic eyelets; have you a specimen of such envelope with you; if so produce it?

Objected to as not in rebuttal.

A. I have and produce it, one of which I spoke of which is this.

29 Q. Which end of the envelope which you saw was sealed, the one in which the eyelet was contained or the other end?

The same objection.

67 A. The other end from the eyelet.

Complainant's counsel offers the envelope in evidence, marked Comp't's Exhibit Tag Envelope with Eyelet Opposite Sealed End without Metallic Re-enforcement. May 18, 1888. J. A. S., ex'r.

The introduction of the exhibit objected to as not in rebuttal. The title under which it is introduced is also objected to since the exhibit has evidently once been sealed at the end containing the holes, and has never been sealed at the opposite end.

30 Q. While you were in Boston in 1883 did you learn anything concerning Dennison's knowledge of tag envelopes, if so, please state what it was?

A. I did. I think the last of July at Taylor & Mayo's office at the head of Commercial wharf, Boston, from their book-keeper, who stated that a day or two previous one of Dennison's salesmen was in their office trying to sell their common tags which they had generally bought of this party named, who remarked, after being shown the 3,000 tag envelopes which I had sold them, "My God, why could not our firm have thought of that before."

Answer objected to as not in rebuttal, also as hearsay evidence.

Cross-examined by W. W. SWAN, Esq.:

31 X Q. In your original patent No. 277,245 the first claim is in these words: "A combined tag and envelope made substantially as herein shown and described and consisting of an envelope having at one end a flap of sufficient size to cover one side of the envelope as set forth."

Why did you omit this claim in the reissued patent No. 10488?

Objected to by complainant's counsel as not in cross-examination, as being immaterial, and not in any sense competent testimony.

68 A. I didn't think it necessary for the words specified, as a flap of sufficient size did not pertain to a long flap alone but to one of any size.

Complainant's counsel gives notice that he will move at the hearing to strike out the above question and answer for the reason stated in the above objection.

32 X Q. Was it not rather that the examiner in the Patent Office objected to the claim, on the ground that it was "common to provide envelopes with end flaps, sufficiently large to cover one side of the same"?

I call your attention to Defendant's Exhibit File Wrapper, etc., Dunham's reissue patent, 10488, found in the printed record at page 43:

Same objection and notice as to question and answer No. 31.

Also the alterations in the claims were matters in the hands of complainant's solicitor, which he was authorized and empowered to make, and concerning which the inventor is not supposed to have any knowledge.

A. Not being a patent lawyer or expert, I cannot answer that question.

33 X Q. In your affidavit accompanying your application for a reissue, you say, page 49 defendant's record: "Defendant further says that he believes he was the first to construct a marking tag with means for attaching it to merchandise, and provided with a receptacle capable of being closed and adapted to receive a bill or invoice of the goods to which the tag is attached, and that he is entitled to claim this broadly enough to cover such devices;" and the application for the reissue, as appears in the Exhibit File Wrapper, etc. Patent 10488 (page 46 of the record) originally contained the following claim:

"A tag for marking merchandise, provided with an envelope or packet substantially as set forth." Did you not acquiesce in
69 the examiner's objection to this claim that the subject-matter was old and strike it out?

The same objection and notice as to question 32.

A. Not being a lawyer and conversant with technical points, I am generally in the habit of placing such matters in the hands of my counsel, who I pay for his work. In this case, I left the whole matter in my solicitor's hands.

34 X Q. Did you know that the claims were in the application when you executed the application?

Same objection and notice as to question 32.

A. I can't remember; but I think I was entitled to all I claimed.

35 X Q. When did you first know that the claim which I have just quoted was stricken out?

A. I couldn't say.

36 X Q. In your affidavit accompanying your motion for a preliminary injunction in this suit, you say (page 88 of defendant's record), "Deponent further says that the Exhibit 9," hereto annexed, is one sent by S. R. and J. C. Mott, to Messrs. Hardy & Hall, and concerning which deponent wrote the letter to S. R. and J. C. Mott, and that Exhibit L "is the answer received from Mott & Mott thereto, and refers to the circular Exhibit H." Will you look at the letter which I now hand you, and state whether or not it is the letter in the passage quoted as having been written to S. R. & J. C. Mott?

Same objection and notice as to question 32.

A. This seems to be the letter that I wrote. The exhibit shown me, I think, is one sent Hardy & Hall, 31 Clinton street, Brooklyn, from whom I obtained it and gave it to my counsel.

Before making this answer, witness requested to be shown
70 this Exhibit "9," referred to in the question, and was handed

the tag envelope which was furnished defendant's counsel as a fac-simile of the said Exhibit "G," with a copy of the moving papers in the matter of a preliminary injunction.

Defendant's counsel now puts the said tag envelope in evidence, and it is marked on the outside of the unsealed flap, Defendant's Exhibit Mott & Mott, tag envelope, May 18, 1888, J. A. S., ex'r.

He also puts in evidence the letter from the defendant to S. R. and J. C. Mott, referred to in the last question and answer, and it is marked Def'ts' Exhibit Dunham's Letter to Mott & Mott, May 18, 1888. J. A. S., ex'r.

Same objection and notice as to both exhibits.

37 X Q. Was not your knowledge of the manner of shipping goods and forwarding invoices therefor pretty much confined to your then business as a fish dealer and kindred business--I refer to your answer to interrogatory 22?

A. Most assuredly not. I am not a common haddock fisherman, but have friends and acquaintances in all classes of business throughout the United States, and am extensively acquainted, having always looked for improvement in everything that I had occasion to be connected with. There is no business in the country which would test the quality of a tag envelope more severely than the fish, oyster and fruit business, having shipped many times more than 100 packages per day, sometimes as high as 300 in one day.

38 X Q. Do you require tag envelopes of a better manufacture in the fish business than are required in other businesses, the paper business, for instance?

A. Most assuredly.

71 39 X Q. What do you know of the paper business as to the shipping of goods?

A. From observation and general knowledge paper is generally marked with pot and brush, and not with tags, being shipped generally in large car-loads.

40 X Q. Did you never know of the forwarding of a package of paper with an invoice attached thereto?

A. I never did before the introduction of my own tag envelope, but have seen packages of paper shipped with pasted directions on the paper, and possibly the bill may have been placed inside the package of paper somewhere, but I am not certain, never having seen them.

41 X Q. Have you, since the introduction of your own tag envelope, seen packages of paper shipped with tag envelopes attached thereto containing invoices?

A. Never but by defendant's infringement and numerous other infringements.

42 X Q. Have you ever seen packages of paper shipped with Pultz & Walkley's tag envelope attached thereto containing invoices?

A. Never, and I believe it was a fraud from the beginning, never having heard of it in the paper business by enquiry and my acquaintance there is numerous.

43 X Q. Have you ever been in Plantsville, Connecticut?

A. I never have, and never knew any way to get there, till within a short time, as I never heard of the place to remember before the introduction of this article, it being so remote.

JOSEPH T. DUNHAM.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Adjourned to Tuesday, May 22, 1888, at 11 a. m.

72 NEW YORK, *May 22d*, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: Counsel as before.

Mr. CALEB HALEY, a witness produced on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence, and occupation.

A. Caleb Haley; age, 49; I reside at Croton Connecticut; I am a wholesale fish dealer at 14 Fulton market, New York city.

2 Q. Are you acquainted with the complainant Mr. Dunham?

A. Yes, sir.

3 Q. How long have you known him?

A. Over twenty years.

4 Q. In your business as fish dealer, how extensive is your shipment of goods?

A. We ship them anywhere in the United States where people want them.

5 Q. In what kind of packages are they usually shipped?

A. They are usually shipped in the larger quantity in barrels covered with a cloth cover. There are a few shipped in boxes.

6 Q. How long have you been engaged in the fish business?

A. Well, sir, I have been engaged in the fish business 33 years.

7 Q. Previous to 1883, what was the methods used in marking packages?

A. We used to mark them years ago with a brush on the barrel or box.

8 Q. Please state whether at that time you ever sent the invoices with the packages?

A. We did. It wouldn't be always—it would be occasionally—just as some people would request.

9 Q. In what manner?

73 A. It would be a bill enclosed in a stout envelope and nailed on the outside of the package. I would say, further, there have been exceptions where people would be afraid that the invoice would be stolen off, taken off, and those people would wish it wrapped up in a cloth or rubber so that it would not get wet in contact with ice in the package.

10 Q. When, if ever, did you first see a tag envelope made for the purpose of marking packages and inclosing the invoice therein?

A. I should think about four or five years ago, it might be longer, but we never commenced issuing them till about three years ago.

11 Q. Of whose manufacture were the first tag envelopes you saw?

A. Mr. Dunham's.

12 Q. Similar to Complainant's Exhibit Dunham's Reissue Specimen now shown you?

A. I think so; yes, sir.

13 Q. Do you now use them in your business?

A. Yes, sir.

14 Q. Will you produce one of the kind you now use?

A. Yes, sir. I produce one.

The same is marked "Complainant's Exhibit Haley Specimen Tag Envelope, May 22, 1888, J. A. S., ex'r.

15 Q. Will you state whether in the use of these tags you have ever lost any invoices sent with them?

A. No, not to my knowledge.

16 Q. Will you look at the Defendant's Exhibits Pultz & Walkley Tag Envelope and Schultz Tie Envelope now shown you, and state whether you have ever seen any of either of these descriptions in use or in the market as tag envelopes?

A. I can't say whether I have or not.

17 Q. Will you examine the Pultz & Walkley specimens and state whether or not that would be a practical tag envelope for use in your business for marking packages and sending invoices?

74 A. I don't think it would, for the reason that on the tops of the barrel there is ice, and when you snap this onto the cover, it comes in contact with the moisture, and would be apt to open and the bill slide out. That is one of the ways of opening a sealed envelope, by moisture.

18 Q. Please state whether the same objection would hold as to the Shultz patent?

A. I think it would; besides, this is a very awkward, ungainly thing to use—it would be impracticable in our business; we would have to have a sail needle or something to sew it on the cover.

19 Q. In view of the fact that the fastening, provided for the Schultz tie envelope is a string not put through an eyelet at the end of the envelope, but through holes made through the side flap and the back of the envelope at a distance from the end and edges; if the envelope was attached to the package by means of that string would or would it not be a practical fastening of the tag?

A. No, sir—it would not—not where moisture comes in contact.

20 Q. Even if it did not come in contact with moisture but was attached to a dry package, please state whether in your opinion it would be a safe fastening?

Objected to as leading.

A. I think not.

Cross-examined by W. W. SWAN, Esq.:

21 X Q. Where do you write the address when you use the Dunham tag envelope?

A. Right on the front side.

22 X Q. Do you ever write it on the inside of the long flap?

A. We never do.

23 X Q. When you used to send an invoice with your goods by placing it in a stout envelope and nailing the envelope on
75 the outside of the package, did you ever write the address of the consignee of the goods on the envelope?

A. We might have done it but it was never meant to be his address solely, because we marked the barrel besides, and the envelope was likely to be rubbed off. It could be done unintentionally.

24 X Q. I asked not whether you might have written the address of the consignee on the evelope, but whether you ever did?

A. Yes; we always did it because the bills were made out in the office. We had to put the name on the envelope to know which envelope was to go on which package.

25 X Q. And do you not use the same double marking when you use the Dunham envelope?

A. Sometimes.

26 X Q. How long is it since you used to nail the stout envelopes on the packages of goods?

A. I can only answer for ourselves; we haven't done it since we have been using the Dunham tags. Nailing the bill on the barrel—I did it as long ago as 1855.

27 X Q. Were the envelopes which you thus nailed to the goods with the invoice enclosed, stouter than the ordinary envelope used for the mail?

A. I would say they were the best mailing envelope which we could get. I can't say that they were specially made for that purpose.

28 X Q. You say that years ago you used to mark your packages with a brush on the barrel or box. Question 7 calls for all the methods in use by you previous to 1883. Did you name the only method in use by you previous to 1883?

A. I should say it was about 1880 that we commenced using a stout card—they were made specially for the purpose, and we used them previous to using the Dunham tag envelope.

29 X Q. Did you use the double marking when you used the stout card—that is, did you put the address upon the package as well as upon the card?

76 A. We did not use the double marking; we put the address on the card alone.

CALEB HALEY.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Mr. HENRY W. PROSSER, a witness called on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.

A. Henry W. Prosser; age, 53 years. I reside in Englewood, New Jersey. I am an envelope manufacturer.

2 Q. As an envelope manufacturer how long have you been familiar with different styles of envelopes in the market in this country?

A. Twenty years.

3 Q. When did you first know of a tag envelope made for the purpose of marking packages, and also conveying invoice of the goods contained in the package?

A. Mr. Dunham showed me the first one that I recollect having seen before he obtained his patent, I think in 1882, but I will not be positive as to the date.

4 Q. Please state whether what he showed you was similar to Complainant's Exhibit Dunham's Reissue Specimen now shown you?

A. Essentially the same I should say.

5 Q. With what manufacturing house are you connected?

A. Superintendent of Samuel Raynor & Company, 115 William street, New York city.

6 Q. How extensive is their business?

A. They manufacture envelopes very largely; they have a capacity of about a million a day.

77 7 Q. In connection with their business, have you been familiar with styles of envelopes manufactured and on sale in the Eastern States?

A. Yes, essentially so. I don't know that I have seen every kind that they manufacture.

8 Q. Will you look at Defendant's Exhibit Pultz & Walkley Tag Envelope, and state whether or not you have ever seen anything of that kind in use or on sale?

A. I have not.

9 Q. Will you state, if you know, whether there is anything in the printing on that envelope which could not be produced in facsimile at any well-appointed printing office?

A. I don't know of any reason why it may not be reproduced.

Cross-examined by W. W. SWAN, Esq.:

10 X Q. What kind of gum is on the Pultz & Walkley envelope?

A. I don't know.

11 X Q. How does the Dunham envelope differ essentially from envelopes with which you were familiar before the Dunham envelope was first shown you?

A. I have seen envelopes somewhat similar but never anything that was intended to be used as a tag.

11½ X Q. In what respect were the old envelopes similar to the Dunham envelope?

A. Well, they were made of paper for one similarity, and I have seen an envelope of similar shape where the long flap was folded inside and the other end left open for carrying samples through the mail.

12 X Q. Do you mean that the old envelope was substantially like this Dunham envelope, omitting the reinforced eyeleted holes?

A. The shape of the paper was similar to this before the envelope

was folded, but the finished envelope entirely different. What I mean is that the paper, the blank, was similar to this, but
78 when made up was different; it had no eyelets, and was intended for a different purpose—carrying samples.

13 X Q. When made up were the two side flaps pasted together in the same manner as the two side flaps are pasted together in the Dunham envelope?

A. Similar, with the exception that the long flap was on the inside of the envelope.

14 X Q. Was the short-end flap folded over on the finished envelope and pasted to the side flaps as it is in the Dunham envelope?

Objected to by complainant's counsel, as witness had already stated that that end of the envelope was left open.

A. The short-end flap was gummed and folded over, but was not stuck to the body of the envelope.

15 X Q. Will you describe the manner in which this envelope which you have been describing, and which you saw before the Dunham envelope was used, if you know?

A. My business was principally making them. I don't remember of seeing any used.

16 X Q. Before you saw the Dunham envelope, did you not also make envelopes substantially like them, with the exception of the eyeleted holes, for wedding envelopes?

A. I have no recollection of such.

Redirect by SAM. TRO. SMITH, Esq.:

17 Re-D. Q. Do you recollect how the long flap of this envelope you have been describing compared with the long flap of Dunham's tag envelope, as to length and width?

A. Comparatively shorter, and narrower, somewhat.

18 Re-D. Q. Can you state whether the flap was long enough to admit of an eyelet in the end which would correspond with the eyelet in the body of Dunham's tag envelope?

Objected to as leading.

79 A. I don't understand the question.

19 Re-D. Q. I wish to know whether the long flap was long enough so that an eyelet hole in the end of it would, when the flap was folded down, correspond with an eyelet hole in the end of the body at the place where the eyelet is in the end of the body of Dunham's tag envelope?

A. The flaps were not usually long enough for that, I think.

20 Re-D. Q. Will you look at the drawing of Kilburne Tompkin's Exhibit in this case, and state whether that is the envelope to which you refer?

A. That is the one.

H. W. PROSSER.

Sworn to before me—

JOHN A. SHIELDS, *Examiner, etc.*

Mr. LAWRENCE CULLEN, a witness produced on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.
A. Lawrence Cullen; age, 35 years; I reside in New York, and I am a driver on Adams express.
2 Q. How long have you been engaged in the express business?
A. Fifteen or sixteen years, sir.
3 Q. Handling freight and packages all that time?
A. Yes, sir.
4 Q. Will you look at the Defendant's Exhibit Pultz & Walkley Tag Envelope, and Comp't's Exhibit Schultz Tie Envelope now shown you, and state whether or not they would be practical tag envelopes for marking packages and conveying invoices for goods transported by your company?
A. I would not accept packages marked with tags like the Schultz tag envelope. This envelope, Pultz & Walkley envelope, I
80 have never come in contact with, but such envelopes often get loose by coming in contact with moisture.
5 Q. Under your instructions as to receiving marked packages, would you receive packages marked only with either of these exhibits?

Objected to as leading.

A. I would at shipper's risk—the parties that were shipping the stuff.

LAWRENCE CULLEN.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Mr. WILLIAM A. HINCHMANN, a witness called on the part of complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.
A. William A. Hinchmann; age, 55; I reside in Brooklyn, at 136 St. Felix street; I am in the trucking business.
2 Q. How long have you been engaged in trucking?
A. About 20 years.
3 Q. How many trucks do you employ?
A. Six.
4 Q. To how many different steamboat lines and railroad lines does your business extend?
A. Mostly all there is in the city.
5 Q. Are you familiar with the methods of marking packages sent for transportation and conveyed by means of your trucks?
A. Yes.
6 Q. Do you know the complainant, Mr. Dunham?
A. I do; yes, sir.
7 Q. How long have you known him?
A. For the last 10 or 12 years, I suppose.

8 Q. Are you familiar with the tag envelope like Comp't's
81 Exhibit Dunham's Reissue Specimen, and if so, how long have you known it?

A. I am, and have known it, I think, between 4 or 5 years.

9 Q. What other tag envelopes, if any, did you know or see in use previous to the introduction of Dunham's tag envelope in 1883?

A. I don't recollect of any others to my knowledge.

10 Q. From your business as truckman if such tag envelopes had been in use in transmitting packages of goods, would you have been likely to see them?

A. I think I should notice them.

W. A. HINCHMANN.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Mr. HERBERT M. ROGERS, a witness produced on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.

A. Herbert M. Rogers; age, 44 years. I reside at 216 Bergen street, Brooklyn; I am a wholesale fresh fish dealer at No. 11 Fulton wholesale fish market.

2 Q. What firm are you a member of?

A. H. M. Rogers & Co.

3 Q. How long have you been engaged in the business?

A. About 20 years.

4 Q. Do you know the complainant, Mr. Dunham?

A. Yes, sir.

5 Q. Are you familiar with his tag envelope like Dunham's reissue specimen?

A. Yes.

82 6 Q. Do you use them in marking packages in your business and sending invoices therein?

A. Yes, sir.

7 —. Have you any knowledge of tag envelopes for such purposes having been used prior to 1883, and if so state what?

A. I haven't any knowledge.

8 Q. In what kind of packages are your goods usually shipped?

A. Barrels and boxes.

9 Q. Will you look at Def't's Exhibit Pultz & Walkley Tag Envelope and Comp't's Exhibit Schultz Tie Envelope and state whether or not they would be practical and safe tag envelopes to use in your business for marking packages and sending the invoice to consignees?

A. I should not consider them so—we would not use them.

Cross-examined by W. W. SWAN, Esq.:

10 X Q. Why would you not use the Pultz & Walkley Tie Envelope?

A. Because I would be afraid the bill would fall out before the goods got to its destination.

11 X Q. Why?

A. Because the moisture from the top of the package or cloth would open the envelope and let the bill fall out.

12 X Q. Is that the only objection you find to the Pultz & Walkley tie envelope?

A. No, sir; you would have to lick it and stick it down and then when applied to package it would keep moist and open.

13 X Q. Do you think the Pultz & Walkley envelope all right so far as the eyelet hole for the string is concerned?

A. It seems to be here.

14 X Q. What is your objection to the Schultz tie envelope?

A. Well, not convenient in any shape for our business.

83 15 X Q. Would the Schultz tie envelope be convenient enough for your business if at the end where it now has a string it had an eyeleted hole like that of the Pultz & Walkley tie envelope?

A. No, sir.

16 X Q. What would be the objection?

A. The eyeleted hole would be in the wrong place and the same objection to the moisture and opening of the package, allowing the bill to fall out.

17 X Q. I meant of course that the eyeleted hole should take the place of the present string fastening and be inserted at the extreme end of the envelope, opposite to the loose flap; what would then be your objection to the Schultz tie envelope?

A. The moistening of the flap and allowing the bill to drop out.

18 X Q. Would that be your only objection?

A. Yes, I guess so; it wouldn't keep the bill in—that is the way I looked at it—it would drop right out.

H. M. ROGERS.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Mr. ALEXANDER C. ROGERS, a witness, called, on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.

A. Alexander C. Rogers; age, 50 years; I reside at 127 East 17th street, N. Y. city; I am in the fish and produce business; wholesale, 109 South street, N. Y. city.

2 Q. With what firm are you employed?

A. Charles L. Pierce.

3 Q. How long have you been in the fish and produce business?

A. About 30 years.

84 4 Q. During that time how much of the time, if any, have you been engaged in business for yourself?

A. About 20 years.

5 Q. Under what name and style?

A. Rogers & Edwards; about 15 years of that time.

6 Q. How extensive has been your business and experience in shipping goods and packages and over what extent of country?

A. The first 20 years I was in the wholesale fish business. The past 6 years I have been a portion of the time in New York and a portion in the Southern States, from the Gulf of Mexico to New York.

7 Q. Have the firms with which you have been connected also received large quantities of goods shipped or transported from a distance?

A. Yes, sir.

8 Q. You are familiar I suppose with methods of marking packages of goods for transportation?

A. Yes, sir, in the line of business that I have been in.

9 Q. When did you first see in use a tage envelope constructed for marking goods and also conveying the invoice to the consignee?

A. I should think 4 or 5 years.

10 Q. State whose tag envelope it was?

A. The Dunham patent was the first that came under my observation, like Complainant'- Exhibit Dunham Reissue Specimen.

11 Q. Have you made use of such tag envelope in your business?

A. Yes, sir.

12 Q. Will you look at Def't's Exhibit Pultz & Walkley Tag Envelope, and Comp't's Exhibit Schultz Tie Envelope, and state whether in your opinion as a shipper and receiver of goods they, or either of them, would be a practical and safe envelope for marking goods and sending the invoice to the consignee?

A. Not in the lines of business that I have been associated with.

85 Cross-examined by W. W. SWAN, Esq.:

13 X Q. You heard the cross-examination of the last witness, did you not?

A. Yes, sir.

14 X Q. Do you agree with him that if in the Schultz tie envelope instead of the string used at one end of the envelope and eyelet like that in the Pultz & Walkley envelope were used at the extreme end of the envelope to close the flap that the string now closes, the Schultz envelope would still be unfit for use as a tag envelope in your business?

Objected to by complainant's counsel on the ground that the last witness did not testify as to any eyelet used to close the flap.

A. I don't know. I didn't hear what the witness swore to.

15 X Q. What is your opinion then?

A. Well, my opinion is that the envelope would not be a safe envelope to use in some branches of the business that I am connected with, on account of the gum getting damp and not sticking.

16 X Q. To what gum do you refer?

A. I refer to the gum on the flap here.

17 X Q. Do you find any other objection to the use of the Pultz and Walkley tag envelope?

A. I think there are much better ones for some lines of business.

19 X Q. In what respect do these better ones differ essentially from the Pultz & Walkley exhibit?

A. Well, to use on packages of perishable goods that are packed on ice, meat, fish, an envelope where it doesn't fasten with gum is better than a gummed envelope.

20 X Q. Then the only serious objection that you make to the use of the Pultz and Walkley tag envelope in business like your own is the fact that it is a gummed envelope, is it?

86 A. I think the construction of the envelope is not a good one for tagging purposes.

ALEXANDER C. ROGERS.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, &c.

Adjourned to Tuesday, May 29th, 1888, at 11 a. m.
Adjourned to June 19th, 1888, at 11 a. m., by consent.

NEW YORK, *June 19th*, 1888—11.00 o'clock a. m.

Met pursuant to adjournment.
Present: Counsel as before.

JOHN S. SMITH, a witness sworn on behalf of complainant, testifies as follows:

1 Q. What is your name, age, residence and occupation?

A. John S. Smith. I am 45 years of age. I reside at 147 W. Tenth street, New York city. I keep a billiard-room.

2 Q. Are you acquainted with Joseph T. Dunham, the complainant?

A. I am.

3 Q. Will you look at the tag envelope now shown you, and state what, if anything, you know about it?

A. I procured it at Dennison's store on Broadway, early in the fall of 1884.

Question and answer objected to as not in rebuttal.

Counsel for complainant states on the record that he does not offer the evidence as evidence of infringement, but for the purpose of connecting with other evidence, to be offered hereafter.

87 4 Q. Will you state what occurred at the time you received this tag envelope?

Same objection.

A. I entered the store and asked the clerk if he had any tag envelopes, and he showed me two samples, stating the price of each. I can't tell the price. I took the samples and marked them, and gave them to complainant.

Cross-examination *de bene:*

5 X Q. Did you go to Dennison's store and ask for tag envelopes at the solicitation of Mr. Dunham?

A. At his suggestion—yes.

JOHN S. SMITH.

Sworn to before me—

JOHN A. SHIELDS,
Examiner, &c.

ALONZO B. SMITH, a witness called on behalf of the complainant, having been duly sworn, testifies as follows:

1 Q. What is your name, age, residence and occupation?

A. Alonzo B. Smith; I am 56 years of age; I reside at 57 Cranberry street, Brooklyn; I am sexton of Plymouth church.

2 Q. Are you acquainted with complainant?

A. I am.

3 Q. In 1886 where did you reside?

A. I resided at the same address, at 57 Cranberry street, Brooklyn.

4 Q. Will you look at the tag envelope now shown you, and state what you know about it?

Objected to as not in rebuttal.

A. Well, I was taking orders for Dunham for his envelope during the year of 1886, and going about I frequently came in contact with the Dennison tag envelope and reported this to
88 Dunham, and he wished me to go to their store and ask if they made a tag envelope. I went there and they told me they did so, and showed me samples and prices. I then returned to Dunham and he immediately went with me to the store of Dennison. I asked the clerk if their tag envelope was patented, and he told me that it was. I asked them if they would protect me in using them. He said that he would. I asked if he would give me a written guarantee; he stepped to another party in the store and said he could not do it just then, but would give it to me in a day or two after. This conversation occurred in the presence of Dunham, who then told them their tag was an infringement and he should sue them for damages. I think we went out then.

Same objection to the answer.

ALONZO B. SMITH.

Sworn to before me—

JOHN A. SHIELDS,
Examiner, etc.

JOSEPH T. DUNHAM recalled by Mr. S. T. SMITH:

74 Q. Will you look at the tag envelope I now show you, and state where you first saw it?

Objected to as not rebuttal.

A. It was given to me by John Smith.

75 Q. When?

A. I think in the latter part of 1884 as near as I can remember.

76 Q. Is that the same tag envelope referred to by him in his testimony?

Same objection.

A. It is.

Tag envelope offered in evidence and marked Comp't's Exh. John S. Smith, June 19th, 1888, J. A. S., ex.

89 Introduction of exhibit objected to as not in rebuttal.

77 Q. Will you look at the tag envelope I now show you, and state when you first saw that?

Same objection.

A. On December 22d, 1886.

78 Q. Where?

Same objection.

A. It was handed to me by Mr. Alonzo B. Smith.

79 Q. Is it the same tag envelope referred to by him in his deposition?

Same objection.

A. It is.

80 Q. In whose handwriting is the endorsement upon it?

Same objection.

A. My own.

81 Q. When was that endorsement made?

Same objection.

A. December 22nd, 1886, at 2.30 p. m.

Tag envelope offered in evidence, marked Complainant's Exh. Alonzo B. Smith, June, 1888, J. A. S., ex'r.

Introduction of exhibit objected to as not in rebuttal.

82 Q. Will you now look at tag envelope I now show you, and state when you first saw that?

Same objection.

A. I think it was in August, 1883.

83 Q. Where?

Same objection.

A. I think at Taylor & Mayo's office in Boston.

84 Q. From whom did you receive it?

90 Same objection.

A. I think from Taylor & Mayo's book-keeper, as I was there about every week, sometimes twice a week of that year.

Tag envelope offered in evidence, and marked Comp't's Exh. Taylor & Mayo, June 19th, 1888, J. A. S., ex'r.

Introduction of exhibit objected to as not in rebuttal.

85 Q. Did you receive the card which it contains, with the envelope?

Same objection.

A. I did.

86 Q. Whose business card is it?

Same objection.

A. Dennison Manufacturing Company, Boston, Mass.

87 Q. Whose name is at the bottom of it?

Same objection.

A. Henry Barber, Jr.

88 Q. In whose handwriting is the pencil endorsement on this card?

Same objection.

A. In my own, made at the time.

89 Q. Will you read the endorsement?

Same objection.

A. It reads, "Party who presented to Taylor & Mayo's bookkeeper in August, 1883."

90 Q. Will you state any difference that exists between the three tag envelopes Exhs. "Taylor & Mayo," "John S. Smith" and "Alonzo B. Smith," in their construction?

Objected to as not in rebuttal and as immaterial.

A. There is a very perceptible difference in every case.
91 The Exhibit Taylor and Mayo is sealed at the bottom, and the top left open with nothing but ordinary paper washers and eyelet holes coinciding, one washer on the flap and one washer on the back body of the envelope. Exhibit John S. Smith is made with the bottom flap open and the top flap sealed down tight with paper washers on the flap and back envelope. Exhibit Alonzo B. Smith is made in the same manner as Exhibit John S. Smith, with an additional metal eyelet passed through the paper washers and seemingly fastened down.

91 Q. What do you mean by seemingly?

Same objection.

A. I mean that it is to hold the eyelet together. It is clamped.

92 Q. Have you observed the difference in the construction of Dennison's tag envelopes that have come under your observation at these different periods in other instances, or not?

A. I have seen the different specimens of the kind shown here.

93 Q. In your visit to Boston in 1883 at the time you received the Exhibit Taylor & Mayo, did you see or hear of any tag envelopes similar to Defendant's Exhibit Pultz & Walkley Tag Envelope?

A. I never did, as there was nothing of the kind on the market.

94 Q. Will you look at the paper I now show you, and state if you ever saw it before, and if so, when and where?

A. I have. I received it on February 13th, 1886, at 4.45 p. m., from the Dennison Manufacturing Company.

95 Q. Will you read it?

A. "Circular.

To —— ——:

Whereas some of our customers who sell or use our tag envelope have been threatened with suits for alleged infringement of certain letters patent of the United States (more especially a re-
92 issued patent, No. 10488, granted to Joseph T. Dunham and dated June 10th, 1884), we hereby agree to protect our customers in the sale and use of our tag envelope, and further agree that we will pay the cost of the defense and also all damages that may be recovered in any suit brought against any seller or user of our tag envelope for the alleged infringement of any letters patent of the United States, including said reissued patent, provided the entire control and direction of said defense is placed in our hands.

DENNISON MANUFACTURING CO.,
Boston, New York, Philadelphia, Chicago, Cincinnati, St. Louis.

June, 1885."

96 Q. How did you receive this circular?

A. In a sealed envelope with the Dennison Manufacturing Co.'s printed card thereon, by mail, addressed to me on the date recorded.

97 Q. When was this circular received, referring to the letter written by you in evidence as Def't's Exh. to Mott & Mott?

A. The second day after I wrote the letter to S. R. & J. C. Mott.

98 Q. In the fall of 1883, did you have any agent engaged in taking orders for your tag envelopes in Boston and the vicinity?

A. I did.

99 Q. What was his name?

A. I think it was George Andrews.

100 Q. Will you look at the letter I now show you with the attachment and state what it is?

Objected to as not in rebuttal and immaterial.

A. It is a letter written August 3d, 1883, to Joseph T. Dunham & Co., by George Andrews, and addressed to the firm.

Same objection.

(Letter read.)

93 "BOWDOIN SQUARE, BOSTON, MASS., *August 3d*, 1883.

Messrs. J. T. Dunham & Co.

GENTS: I have been canvassing, hoping to get a customer so as to send the order and reply to yours. It's up hill, guess you have got

the cream when here. The greatest stumbling block is (too costly) by every one I have approached, and other obstacles too numerous to mention now.

Is not your paper too good? causing the high cost, and then again all who use them can write their consignees to send them back for use over and over. Some see the point now, and I found some now using the common envelope with eyelets for same purpose yours are used and designed for; and again what is there to prevent any one from adopting one like the enclosed of size larger to enclose bill and put the address on the outside, when they don't care who sees it, or they can double the envelope over.

Some offered $10 per M printed, some will buy them when they can purchase for $5. All admit they are very good.

But the American express are doing their level best to persuade all that ship by them to dispense with cards entirely, because many cards get torn off; then they (are) put to great trouble to ascertain "who belongs to the package," and is a great source of annoyance to the party to prove goods, and often are obliged to wait several days and sometimes weeks to get around the proof. The beef and mutton dealers put bills up in the carcasses and sew up in cloth. Butter and cheese put the bill inside the cases; the liquor dealers dare not put bills in envelopes, they might give them away to the smelling gentry; especially those who ship to the State of Maine and they are numerous in this city, most all of them ship there.

94 If made of cheaper paper, say manilla paper instead of hemp, something one-half the price, and put the price so as to induce shippers to use, would you not realize more profit in the end?

If prices are to remain as now a canvasser would require big territory, and use steam to get around to make grub.

I have perhaps written too much, but they are facts and my experience in this case. I have done considerable canvassing in my life, and never met with so little success in any other thing. Hiscock & Prior orders five hundred printed; with the word bill instead of invoice on the outside.

Yours as yet, GEORGE ANDREWS,
B. S. D. D., Boston."

101 Q. Is the envelope attached to this letter the one referred to by him as being enclosed?

A. Yes.

102 Q. How is it addressed?

A. Joseph T. Dunham & Co., pier 24, North river, New York, N. Y. city.

103 Q. How does that envelope differ from the tag envelopes manufactured by the Dennison Company?

Objected to as immaterial and not in rebuttal.

A. It does not differ in some cases. In some cases they put the coinciding eyelet holes through all three parts, *i. e.* to say, through the flap and through both the back and front as in this envelope attached to the letter. In other cases they only put through the flap and back body of the envelope.

104 Q. How about reinforcing the eyelet holes?

Same objection.

A. I never saw them in the first instance, only the paper washers.

105 Q. What do you mean by that?

Same objection.

95 A. There is no difference, except this does not have the paper reinforcing washer around the eyelet holes.

106 Q. How long after the receipt of this letter was it that you first learned that Dennison was manufacturing a tag envelope?

A. Very soon after this letter came to me.

107 Q. Had you any suspicion that this tag envelope and your agent had anything to do with Dennison & Co.'s putting their tag envelope on the market?

A. I had.

108 Q. What caused that suspicion?

A. From hearing from different parts of the country that Dennison had put a tag envelope on the market about that time.

Either party at the hearing may bring into court the tag attached to the Andrews letter filed with the motion for preliminary injunction in this case.

109 Q. In your affidavit which appears in evidence from defendant's printed record on page 81 I find this statement:

"Many of these experimental devices have been preserved and the exhibits hereto annexed marked respectively Exhibits E, F 1, F 2, F 3, F 4, F 5, F 6, F 7 and F 8 are specimens of such preserved experimental devices, and were all designed and constructed by deponent previous to his application for a patent on January 5th, 1883."

Will you look at the specimens now shown you, marked E, F1, F 2, F 3, F 4, F 5, F 6, F 7 and F 8, and state whether or not they are made in the same form and in all respects like the exhibits referred to in such affidavit?

Objected to as immaterial.

A. They are the same.

96 These envelopes are offered in evidence, and marked respectively Comp't's Duplicates E, F 1, F 2, F 3, F 4, F 5, F 6, F 7 and F 8, June 19th, 1888, J. A. S., ex'r.

110 Q. Will you make and produce, at the next hearing, the duplicate of the envelope which is attached to the Andrew's letter?

A. I will.

111 Q. From your practical knowledge of the use of tag envelopes, please state whether one of Dennison's tag envelopes could be used in such a way as to write the address of the party to whom the goods are consigned, on the inside of the flap?

A. It could.

112 Q. Will you produce one having such an address?

A. I do produce one, "J. B. Watson & Co., Chicago, Ill., 127 Michigan avenue."

113 Q. Please state whether such envelope, attached to a package by a string, could be opened or the flap raised, so as to disclose such address?

A. Very easily, as has been done in this envelope as marked previously.

Envelope offered in evidence, and marked Comp't's Exh. Dennison Tag Envelope, with address inside of flap, June 19th, 1888, J. A. S., ex'r.

Cross-examination by Mr. SWAN:

114 X. Q. Who wrote the address on the inside of the flap of the tag envelope just produced?

A. I never saw this until it has just been entered here. My counsel tells me he wrote it.

115 X Q. When the envelope was originally made, which end was left open for the reception of the invoice, the end upon which your counsel has written the address as just stated, or the opposite end?

A. It is hard to tell; either end will open; it has an apology for a fastening at the washers' end, which can be very easily opened if sealed.

116 X Q. In what does the apology to which you refer consist?

97 A. Simply a brass eyelet not half clinched.

117 X Q. Say what you mean by half clinched?

A. It is not completely finished, and doesn't do the business intended.

118 X Q. What was the business intended?

A. To evade my patent. This is the third change in manufacture.

119 X Q. How was it intended to evade your patent?

A. Possible thinking to put a brass eyelet through, and fastening it down tight they could induce me to believe that the idea was old and drive me from the market.

120 X Q. If the eyelet in the exhibit under consideration were fully clinched, could the flap through which it passes be afterwards opened that an address might be written upon the inside?

A. I think it could.

121 X Q. Then you think it immeaterial whether the eyelet is fully clinched or not, do you?

Objected to as the witness is not, and does not claim to be an expert.

A. I can't say.

122 X Q. The envelope in question with "address inside of flap" was originally sealed at the end through which the eyelet passes, was it not?

A. I couldn't say, but it don't look as if it were sealed very practically.

123 X Q. (*de bene*). Did you make any reply to the Andrews letter which you read in answer to question 110?

A. I think I did.

124 X Q. Have you that reply or a copy of it?

A. I have not; I never kept a press copy book in my life.

125 X Q. Do you remember what your reply was?

A. I don't now, as I only happened to find this letter amongst my own letters.

126 X Q. (*de bene*). In answer to interrogatory 90 you speak of certain "very perceptible differences," between Comp't's
98 Exhibits "Alonzo B. Smith," "John S. Smith," and "Taylor & Maryo;" state whether or not you consider these difference essential.

Objected to as witness is not an expert.

A. I can't answer it technically, my expert will do that.

JOSEPH T. DUNHAM.

Sworn — before me—

JOHN A. SHIELDS,
Examiner, etc.

Adjourned to Wednesday, 20th of June, 1888, at 11 a. m.

NEW YORK, *June 20th*, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: Counsel as before.

Mr. HENRY CONNETT recalled:

8 Q. You stated that your occupation was patent solicitor and expert. How long have you been engaged in that business?

A. I have been engaged in the business for about twenty-one years, and as an expert in patent cases for about eight years.

9 Q. In your business as patent solicitor, have you had occasion to examine and ascertain the similarity and difference between claims and specifications for patented inventions? If so, to what extent and for what purposes?

A. I have, extensively. My business has been in part devoted to opinions on these points, for many years.

10 Q. Have you examined and are you familiar with the specification and claims of the patent of Joseph T. Dunham, No. 277,245, dated May 8th, 1883, for combined tag and envelope? If so,
99 please state generally the invention described in the specification and referred to in the claims thereof.

A. I have examined this patent, and believe I am familiar with it. The invention described in the patent is a combination of a marking tag and an envelope to contain the bill or invoice of the goods to which the tag is to be attached. The combination tag and envelope described and illustrated by the drawing, comprises an envelope of substantially the ordinary form, having a flap that closes

the mouth of the envelope, overlapping the body of the letter, and having a hole or eyelet in it, which, when the flap is folded down, coincides with a hole in the body of the envelope, so that the cord or hook for attaching the tag to the package may be passed through both holes, and thus serve the double purpose of securing the flap over the mouth of the envelope and securing the whole to the package.

There are two claims in the patent; the first is laid to a combined tag and envelope, consisting of an envelope having at one end a flap of sufficient size to cover one side of the envelope. This claim is not limited to the use of eyelets arranged in the manner I have stated, but it is limited to the flap, having sufficient area to cover one side of the envelope.

The second claim is laid to a combined tag and envelope, having a flap that closes the mouth of the envelope of sufficient length to extend over the pocket of the envelope, so that an eyelet in the free end of the flap may be made to coincide with a similar eyelet on the end of the envelope opposite to that where the flap is attached. The peculiar limitation in this claim lies in this: That the flap shall extend over or across the pocket of the envelope, as in the combined tag and envelope illustrated in the drawing in the patent.

11 Q. Will you read the first claim so that the examiner may spread it on the record?

A. I will. I quote: "A combined tag and envelope, made
100 substantially as herein shown and described, and consisting of an envelope, having at one end a flap of sufficient size to cover one side of the envelope, as set forth."

12 Q. In view of the first and last clauses of this claim, will you explain the statement in your former answer, which is in these words: "This claim is not limited to the use of eyelets, arranged in the manner I have stated." Do you mean that this claim is limited to a claim for an envelope of the stated form, without regard to the eyelets, or what do you mean?

A. I meant that the language of the claim did not, as I understand it, restrict to the specific arrangement of the eyelets, as shown in the drawing. I did not mean that the claim was broad enough to cover merely an envelope with a plain flap of the same size as the envelope; however, it is somewhat difficult to define precisely what this claim does cover.

13 Q. Please state what, in your opinion as an expert, is necessary, in addition to a plain envelope to constitute a "tag envelope," as mentioned in the first clause of the claim?

A. It would require to be provided with some means, whereby it could be attached to the package. The holes or eyelets of the patent provide such means of attachment, but the distinction between the two claims of the patent seems to lie in this: That the first claim does not specify nor indicate distinctly where these attaching devices or eyelets are to be arranged, while the second claim specifies this distinctly. There should be what is called a "patentable difference" between the several claims of the patent, and if the first claim of his patent were construed to limit to the precise arrange-

ment of the eyelets or holes shown in the drawing of the patent, then there would be no patentable difference between the two claims.

14 Q. I have marked on Complainant's Exhibit "Dunham Reissue Specimen D" near the end of the flap where it is
101 attached to the body, a circle. If an eyelet hole was placed in that location, and a corresponding eyelet hole on the body of the envelope, what effect would said construction have with reference to this device coming under claim first?

A. If the cord or hook, by which the tag envelope was secured to the package, were passed through the coain-ding holes in the position you have indicated on the envelope, it would serve the purpose of closing the mouth of the envelope sufficiently to prevent the accidental escape of the bill or invoice from the pocket, and would, in my opinion, fulfill the conditions of the invention, and be covered by the first claim of the patent, as a fair equivalent of the combined tag and envelope illustrated in the drawings of the patent.

15 Q. What do you regard the advantages sought to be secured, and secured by the invention described in this patent?

A. The inventor states the advantages, and objects very clearly on lines 63 to 71 of his printed specification, which I quote: "By using the above-described combined tag and envelope, the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable; as it is desirable that the purchaser is informed in regard to the prices of the merchandize, as soon as possible, so that he can sell immediately. Furthermore, the address is concealed, and dealers cannot ascertain the addresses of the customers of their competitors."

16 Q. What specific construction or arrangement of the parts serves to prevent the invoice from escaping from the envelope?

A. The flap that closes the mouth of the envelope is held down over the mouth by the cords, hook, or other device by which the tag is secured to the package, sufficiently close to prevent the accidental escape of the bill or invoice from the envelope.

17 Q. What material effect does the length of the flap have on the general object of the invention?

A. These tag envelopes are usually made of moderately
102 stiff paper, and in order that the closing flap, which is held down over the mouth of the envelope by the attaching cord, shall not permit the enclosure to escape, it is only necessary that this flap shall extend a little way over onto the inner ply of the envelope at the mouth, provided the flap is held down somewhat snugly or tightly.

18 Q. What, if anything, would be the objection in this invention, to sealing the flap down to the inner ply of the envelope, instead of fastening it by the string which passes through the eyelets, and attaches it to the package?

A. One objection to sealing the flap down would be that it could not be readily opened without destroying the envelope, and if no eyelets or holes were employed, the tag envelope could not be at-

tached to the package in the ordinary manner of attaching marking tags. The provision of the coinciding eyelets of the patent enables the envelope to be closed, and the tag to be attached to the package by the same means; that is, by a string or wire hook.

19 Q. Did Mr. Dunham ever call upon you for counsel in relation to his patent 277,245?

A. He did.

20 Q. Please state in brief what occurred as the result of such consultation?

A. I advised him to apply for a reissue of the patent, which he did.

21 Q. In view of your knowledge of the invention obtained from him, and your knowledge of his original patent, please state what the defects were, which in your opinion rendered a reissue necessary?

A. I considered the original patent inoperative within the meaning of the statute, for the reason that it did not fully protect him in the exclusive right to make, use and sell his invention, which is the purpose and function of a patent. The claim, while fairly covering the particular form of tag envelope illustrated in the patent, and which I understood to be the preferred form, could be evaded by
103 a very slight change in the shape and size of the flap, and this change would not materially affect the value of the tag envelope. In other words, I believe that his invention extended to the closing or fastening down of the flap by the cord or device employed to secure the tag to the package, without reference to the size of the flap so long as it sufficed to close the mouth of the envelope when it was tied down. I saw no necessity for limiting him to making the flap large enough to cover the flap of the envelope. This use of a large flap merely provided an extended surface on which to write directions or other matter, and this latter formed no part of the invention claimed. Furthermore, I did not consider the first claim of the original patent as being expressed in clear and distinct terms. There were also some defects in the language of the specification, which I thought required correcting. I do not now recollect distinctly what these were.

22 Q. What was the result of this consultation?

A. I prepared and prosecuted Mr. Dunham's application for the reissue of his patent, and the reissue was granted June 10th, 1884, No. 10488.

23 Q. Having prepared the papers, I presume you are familiar with the reissued letters patent. Will you state under whose name, as attorney, the application was made, and what the invention is that is described in the specification and referred to in the claims?

A. The attorneys of record in the case were Arthur C. Fraser and myself, at that time constituting the firm of Burke, Fraser & Connett. Mr. Fraser, however, had no hand in the preparation of this case. The invention of the reissue as set forth in the specification, is a tag provided with means for attaching it to the merchandise, and with

an envelope or pocket to receive the bill or invoice of the merchandise. The flap which covers the mouth of the envelope is fastened down by the cord or other device, which secures the tag to the merchandise.

104 This expresses the character of the invention in its broadest or generic sense, and is covered by the first claim. In its more limited sense, as expressed in the second claim of the reissue, the flap is provided with an eyelet hole, which, when the flap is folded down on the envelope, coincides with an eyelet hole in the envelope, so that the attaching cord or hook may pass through both of these holes, and thus hold the flap down.

The specific form of the tag envelope, as illustrated in the drawing, and as covered by the third claim, shows the flap which closes the mouth of the envelope as extending over the pocket and provided with an eyelet hole in its free end, coinciding with a similar eyelet hole in the end of the envelope opposite to that where the flap is attached.

This specific construction necessarily requires a flap of substantially the same length as the envelope.

24 Q. Will you state, particularly, wherein the claims of reissue patents 10488 differ from the claims of the original patent 277,245?

A. I will; the second claim of the original patents is the same as the third claim in the reissue. Both of these claims cover the specific form of the tag envelope illustrated in both the original and reissued patents, and represented by Complainant's Exhibit "Dunham Reissue Specimen D."

That is to say, these claims are limited to the extension of the flap over the pocket of the envelope, as I have before stated, but not necessarily to the flap being the full width of the envelope. The first claim of the original patent, as I have said, is limited to the flap being of sufficient size to cover one side of the envelope. This limitation does not exist in either of the claims of the reissued patent. The first claim of the reissued patent is generic, and is broad enough to cover a combined tag and envelope wherein the device employed for securing the tag to the merchandise also fastens down the flap which closes the mouth of the envelope.

105 This claim is not limited specifically at all to the special device employed for holding down the flap, and securing the tag to the merchandise.

The second claim is limited to the coinciding eyelet holes in the flap and envelope, but not to their special arrangements as illustrated in the drawing of the patent, and in the exhibit before referred to.

They may be placed in any other position, provided they accomplish the end sought, and which is clearly set forth in the first claim, namely, to hold down the flap so that the invoice cannot escape from the envelope, and at the same time serve as means of attaching the tag to the merchandise.

25 Q. Are you familiar with the patent of Mr. Dunham, in suit,

No. 331,118, and if so will you state the invention described in the specification, and referred to in the claims thereof?

A. I am. I prepared the application for Mr. Dunham.

The specification of this patent at lines 7 to 10, page 1, states very clearly to what the invention relates; I quote: "My invention relates to an envelope designed principally for mailing samples and other like matter, and for use as a tag for marking goods to be shipped." The leading feature of this invention is a provision made for securing or holding down the flap, or one flap of the envelope in such manner that the contents cannot readily escape, and at the same time, allow the mouth of the envelope to be opened for the inspection or removal of the contents without injury to the envelope.

This the inventor effects by constructing a flap on one end of the envelope, connected to the front ply of the body, and overlapping, when folded down, the free end of the back ply of the body. This flap and the front ply and the body are provided each with a reinforced hole, said holes coinciding and adapted to receive, as a means of fastening down the flap, a string, a paper fastener or other like device.

106 The overlapping flap, held down as I have stated, effectually closes the mouth of the envelope, and prevents the accidental escape of the enclosure, but does not prevent the mouth of the envelope from being opened by design.

This is effected or may be effected without removing the fastening, by bending back the flap so as to expose the free end of the back ply of the envelope at its mouth. This flap that closes the mouth of the envelope may, when the envelope is to be used as a tag, and is liable to rough usage, be lightly gummed down at the corners on the back ply of the envelope, but not so securely as to prevent its being readily unsealed by inserting the finger under the flap. The envelope has a flap also at the other end which is usually left unsealed until the enclosures are inserted.

Complainant's counsel produces a duplicate of the envelope attached to the "Andrews letter" introduced yesterday, and offers it in evidence; marked Complainant's Exhibit Andrew's Envelope, June 20, 1888, J. A. S., ex'r.

The time for taking testimony in rebuttal is extended to August 1st, 1888, by consent.

Adjourned until July 6th, 1888, at 11 a. m.

NEW YORK, *July 6th*, 1888—11 a. m.

Met pursuant to adjournment.

Present: Sam. Tro. Smith on part of complainant.

No appearance for defendant.

Direct examination of HENRY CONNETT by S. T. SMITH:

26 Q. Will you more fully describe the invention referred to in the last question, and construe the claims of the patent No. 331,118?

107 The first claim I laid to an envelope, having a flap to close its mouth and having coinciding re-enforced holes, one in

the flap, and the other in the front ply of the body, whereby when the flap is folded down and held down, by any suitable device, the mouth of the envelope is held closed by the overlapping of the flap on the free end of the back ply of the envelope; the said back ply being thus "removably secured" so that the envelope may be opened designedly and its contents inspected and replaced without a necessity of removing the fastenings. The second claim is laid to a mailing and tag envelope, that has a flap which closes the mouth of the envelope, this flap being "secured down" to the inner face of the front ply of the envelope body, and overlapping the free end of the back ply of the body.

The first claim is limited to the re-enforced coinciding holes in the flap and front ply respectively but is not limited to any means of fastening the flap down, nor to the flap being fastened down.

The flap may be fastened down, as the specification states, by a string, paper fastener or the like, which would permit the flap to stand somewhat loose or free; and thus enable the free end of the back ply to be the more readily drawn out from beneath the flap when it is desired to inspect the contents of the envelope. The second claim is not limited to the coinciding re-enforced holes as a means of securing down the flap; it is within the scope of this claim to use other means for securing this flap down to the inner face of the front ply of the body; but the claim is limited to the flap being secured down to the front ply.

The leading idea or principle of the invention is the holding down of the back ply of the envelope by the overlapping of the flap thereon, and the omission of any permanent or secure attachment of the flap to the said back ply. The flap is secured to the front so close to its free end that the back ply is clamped
108 down quite securely without the necessity of any means for permanently attaching the back ply and flap. These tag envelopes are usually made of paper sufficiently stiff to effect a secure closure of the mouth of the envelope in this manner.

27 Q. Will you state whether there is a patentable difference between this device and the device described and shown in reissue letters patent No. 10488, and if so, describe such difference?

A. In my opinion there is a clear patentable difference between them. I consider the later patent, No. 311,118, as a subsidiary patent for a specific improvement on the previous reissued patent. The reissued patent relates to a tag envelope solely, while the latter patent relates to a device to be employed as a tag envelope, or as an envelope for mailing purposes. The specific construction shown and claimed in the latter patent and which I have fully described in my last answer is not specifically described and claimed in the reissued patent; that is, the free end of the back ply of body held down in place by the overlapping of the envelope flap thereon, said back ply being left free or unattached, so that the envelope can be opened without removing the fastening; also the securing down of the flap on the inner face of front ply of the body, the back ply being left unattached. I mean to say that these specific features of construction are not shown, and specifically

claimed in the reissued patents, although, I think, generally covered by the first and second claims of the reissue. The construction shown in the drawing of the reissued patent, and covered specifically under the third claim of that patent implies the closure of the envelope in such a manner that the contents of the envelope could hardly be removed without removing the string, hook or other device by which the flap is held down. It is true the flap is not secured to the free end of the back ply of the body in the specific construction of the reissued patent, but an attaching
109 hook or string passes through all the plies or thicknesses of the envelope as well as through the flap. It might be possible to remove and replace the contents of tag envelope illustrated with drawings of the reissue without the removal of the fastenings, provided the envelope was quite long, and the flap loosely tied down. I consider Mr. Dunham's late patent as a proper and legitimate improvement patent to supplement his prior reissued patent.

26 Q. In Dunham's original patent 277,245, I find in the description contained in the specification the terms "eyelet C" and "eyelet D." What do you understand to be the meaning of such terms, and the function of the device represented by them?

A. Evidently the parts referred to as "eyelet C" and "eyelet D" are merely eyelet holes, or holes in the paper of the tag envelope, re-enforced by metal eyelets. The usual function of an eyelet, which is a tubular rivet, is to secure two or more sheets of paper, or the like, together, but in the patent No. 277,245 their function is merely that of a re-enforce, or binding for the holes in the paper, and they serve the same purpose as the washers *d* and *d'* described and shown in Dunham's patent No. 331,118.

29 Q. Have you examined Defendant's Exhibit Pultz and Walkly Tag Envelope?

A. I have.

30 Q. Will you state what, if any, difference you find between that envelope and the device described and shown in complainant's reissue patent No. 10488?

A. The difference is very marked; the tag envelope of the reissue patent shows a construction wherein the flap that closes the envelope is held down, and the envelope thus held closed by a string or hook which serves also to secure the tag envelope to the merchandise. In the Pultz and Walkley exhibit I find only an ordinary envelope precisely like those in common use for mailing letters, with an open sealing flap at one side, and having a strip of
110 stiff paper enclosed in it at one end, and a reinforced hole at the end of the envelope and extending through this strip. This hole was evidently designed to receive a string or the like for securing the envelope to the parcel, but the flap that closes the mouth of the envelope is designed to be sealed down after the enclosure is inserted, and the attaching string would have no effect whatever on the flap; that is to say, the flap is perfectly free to be opened and closed whether there is a string through the reinforced hole or not. I do not see any connection whatever in this exhibit between the means of attaching it to the parcel and the means for

holding down the flap that closes the envelope mouth, yet these are essentials in the tag envelope described and shown in Dunham's reissue. Another difference I note between the Pultz and Walkley exhibit and the tag envelopes of the reissue is this: In the exhibit the reinforced hole for attaching the envelope is at one of its ends, while the closing flap and envelope mouth are at one side as in the ordinary and well-known form *form* of the commercial envelope. In the Dunham tag envelope the holes to receive the attaching string, hook or other device is at the end, as described in said patent. I consider it practically essential that the means of attaching an oblong tag or tag envelope shall be arranged at one end or shorter side thereof, and, when the attaching string or hook is designed to secure the flap as well, it is essential that the mouth and closing flap shall also be at the end. This is the construction shown and described in the reissue No. 10488.

31 Q. Will you state what, if any, difference, you find between this Exhibit "Pultz and Walkley," and the device described and shown in complainant's letters Patent, No. 331,118?

A. Substantially the same differences exist between the exhibit and the envelope described in the patent No. 331,118, as exist between it and the tag envelope of the reissue. The envelope
111 described in the patent No. 331,118, shows the devices used for holding down the flap that closes the envelope mouth, as serving also for the attachment of the envelope, when used as a marking tag, to the merchandise.

The closing flap is at the end of the envelope in the patent, which is not the case with the exhibit envelope. It is essential to the envelope of the patent that the means for securing the flap down when the envelope is to be used as a marking tag shall also serve for the attachment of the tag to the parcel to be marked thereby. That is to say, in all the Dunham patents, one of the reinforced holes is in the closing flap, which folds over and shuts the mouth of the envelope. In the Pultz and Walkly exhibit there is no hole in the closing flap, the gum being relied on for holding down the flap. In this exhibit, also, the metal reinforce or eyelet extends through and secures both plies of the envelope at one end thereof, and there is no coinciding hole in the flap; indeed, the flap does not extend over the hole in the envelope body, when the flap is folded down; and it would be impossible to employ in this envelope the coinciding eyelet holes which form an important feature in the tag envelopes of the Dunham patents.

32 Q. Will you look at the device I now show you, marked "Complainant's Exhibit Shultz Tie Envelope," and the letters patent of Alexander H. Shultz for "improvement in sample envelopes," and state whether or not such exhibit is the device described in said letters patent?

A. I have examined the Shultz patent and the exhibit, and I find the exhibit to be constructed according to the patent, except that in the exhibit the square corner pieces lettered H I in the patent, are omitted in the exhibit. These corner pieces would

merely strengthen and reinforce the envelope, and would not alter the principle of its construction materially.

33 Q. Will you state what, if any, differences or similari-
112 ties you find between the Shultz envelope and the combined tag and envelope shown and described in complainant's letters patent and represented by Complainant's Exhibits "Dunham's Reissue Specimen D," and "Dunham's Second Patent Specimen"?

A. In the first place, the Shultz envelope is not a tag envelope, was not designed to be used as a tag envelope, and is not adapted to be used as a tag. In a tag the string or hook for attaching it to the goods should pass entirely through it at one end and near the margin. In the Shultz mailing envelope there is a hole in the flap and two holes in the back fly of the envelope, the string employed for closing the envelope passing in through the hole in the flap and one of the holes in the back fly, and then out through the other hole in the back fly, and is tied on the outside. It does not pass through the front fly at all, and is arranged at some distance from the end margin of the envelope. It differs from the construction in the Dunham patents in this: In the Dunham tag envelope there is no hole in the free end of the back ply of the body at the mouth of the envelope, and the flap is not secured by the string to the back ply, as in the Shultz envelope.

In the Dunham tag envelopes as represented in his exhibits and patents, in every case, the string that secures the flap passes through the front ply of the envelope body, and there are coinciding holes to receive the string in the flap and front ply of the body. This peculiarity of construction appears in all his tag envelopes, and it is entirely wanting in the Shultz envelopes.

34 Q. Please give your reasons for stating that the Shultz envelope is not designed for or adapted to use as a tag envelope?

A. To resist rough usage, a marking tag should hang free and be presented endwise to the package to which it is attached. When attached in this manner, as in the case of the Dunham tag
113 envelope, the tag envelope offers very little surface to any force tending to tear it loose.

In the case of the Shultz envelope, if used as a tag, the envelope would be presented with its entire face to the package, owing to the attaching string being wholly on one face of the envelope, and down a considerable distance from the end. Any force tending to tear the tag loose from the package would be exerted practically over the whole surface of the envelope or nearly so; thus the force acting to detach the tag would strike the face of the envelope in the same way that the wind strikes a kite, the force acting or liable to act all around the point of attachment of the string to the face of the envelope. Another point of weakness in the Shultz envelope that unfits it for use as a marking tag is the fact that the string does not pass through and take hold of the front ply of the envelope.

A marked difference between the Shultz envelope and that described in the Dunham patent No. 331,118 lies in this, that while the Schultz envelope is adapted only for mailing purposes, the

Dunham envelope is equally well adapted for mailing purposes, and for use as a tag envelope.

35 Q. Will you look at the patent now shown you, marked "Defendant's Exhibit Ullman 1868 Patent" and state what similarities or differences you find between the device described and shown therein and the tag envelopes described and shown in complainant's patents reissued No. 10488 and No. 331,118?

A. The Ullman patent relates to an envelope for mailing purposes, and the object of the inventor was to produce such an envelope that could be conveniently closed by a rivet in lieu of gum, so that the contents could not be abstracted without defacing the envelope. Prior to his patent envelopes had been closed, he says, by means of hollow rivets or eyelets, and he provides the flap of his envelope with an eyelet secured to the flap by gumming a strip
114 of paper over it. The user, after inserting the letter in the envelope, closed down the flap, the eyelet attached thereto, passing through all the plies of the envelope. He then clinches the eyelet down, thus effecting a permanent riveted fastening. I am unable to find anything of this character in the Dunham patent and exhibits. In the Ullman envelope the fastening is permanent and the contents of the envelope cannot be examined, without first defacing or destroying the envelope, and it would not be possible with his construction to take out, examine and return the contents of the envelope during its transit through the post office. In the Ullman envelope this rivet or eyelet that secures the flap passes not only through the front ply of the envelope but through the back ply also. In this envelope the eyelet performs only one of its functions, viz: that of a rivet. Except that it is more convenient to clinch an eyelet or tubular rivet than a solid one, a rivet of the latter kind would serve the purpose in Ullman's envelope equally as well as an eyelet. One important and notable difference between the tag envelopes of the Dunham patents and the Ullman envelopes lies in this, that the flap of the Ullman envelope is not secured or held down by a string or other device for attaching it to a package, as in the Dunham tag envelope, and also in this, that the Ullman envelope is permanently closed by a rivet, while in the Dunham tag envelopes the closing flap is not permanently fastened down. This latter would defeat his object.

Adjourned to Saturday, July 7th, 1888, at 11 a. m.

115 NEW YORK, *July* 7, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: Sam. Tro. Smith, Esq., of counsel for complainant.

No appearance for defendant.

The direct examination of Mr. CONNETT continued:

36 Q. Please describe more fully the construction shown in the Ullman patent, at the end which is supplied with a metallic unclinched eyelet, and the similarity and differences between that construction and the patents of the complainant in suit?

A. In my last answer I described the Ullman envelope with reference to the mode of using it as set forth in his patent.

The Ullman envelope, as furnished to the trade, and as shown in the drawings of the patent, has a flap at one end, permanently and fixedly fastened down by a rivetted eyelet. This end of the envelope could not be opened without defacing or destroying it. At its other end the envelope is open and has a hole marked *f* in the drawing, through both the front and back plies of the envelope. At this end of the envelope is a short closing flap, provided with an unclinched eyelet or hollow rivet. The drawing shows this eyelet placed in a hole in the flap, and projecting through the flap inwardly, the eyelet being held in place and covered by a part of the flap, which is turned back and gummed down over the outer end of the eyelet. This envelope differs from the Dunham tag envelope in three important respects: It could not be used as a tag envelope for the reason that there is no hole in the closing flap through which to pass a string or hook to hold the flap down, and the hole in the body of the envelope lettered *f*, passes through the back ply as well as the front ply of the body. In this latter respect it differs
116 from the later patent of Mr. Dunham, No. 331,118. However, as there is no hole through the flap, the hole occupied by the eyelet being covered in the manufacture, no provision is made for using a fastening like that employed in the Dunham patent, where the same string or hook that serves to attach the tag to the merchandise serves also to hold down the flap, and close the mouth of the envelope. Should the paper gummed down over the eyelet in the Ullman envelope be stripped off so as to expose the eyelet, and open a passage for the string, the eyelet would fall out, as the gummed strip of paper is all that holds it in place. If this strip of paper which covers the eyelet and the hole in the flap should be punched in order to open a passage for the string, the eyelet would still be too loose to afford a proper reinforce for the hole, and would work out; moreover, the eyelet being unclinched, its sharp edges would fray or cut the string. I have merely called attention to these modifications of the Ullman envelope in order to show that its construction wholly unfits it for use as a tag envelope. I wish to reiterate, that in the drawing of the Ullman patent there is no hole through the closing flap (*c*) through which a string or hook could be passed, and therefore this envelope could not be employed as a tag envelope in the manner that Dunham employs his, nor did Ullman contemplate any such use of it. He merely sought to provide his envelope with a rivet attached to the flap whereby the user could, after inserting the enclosure, rivet the flap down permanently. I find nothing in the Ullman patent to suggest or disclose to the public the invention of Mr. Dunham, nor do I find anything in the Schultz patent that suggests or discloses Mr. Dunham's invention.

37 Q. Will you look at complainant's exhibits marked "Dennison's Patent Tag Envelope," and "Bergen Specimen Dennison Tag Envelope No. 2," and state what, if any, similarity you find between them and complainant's device as described and shown

117 in his letters patent No. 331,118, and reissue No. 10488 as represented by complainant's exhibits marked "Dunham's Reissue Specimen D," and "Dunham's Second Patent Specimen"?

Objected to by defendant's counsel as not in rebuttal. Objection is made to any testimony relating to infringement, at this stage of the case.

A. I have examined the complainant's infringing exhibits named in the last question, and find them to be alike, and marked "Dennison's, pat'd '63, '74." This is an oblong tag envelope with an open gummed flap at one end and a flap at the other end, formed integrally with the front ply of the envelope body, and closed down on and overlapping the free end of the back ply of the envelope body. There are coinciding holes in the closing flap and the front ply of the body, but there is no hole in the free end of the back ply of the body. On the closing flap and the front ply of the tag envelope there are reinforcing washers surrounding the holes. I find the closing flap tightly gummed down to the back ply of the envelope body. This is the case particularly with the Exhibit "Dennison's Patent Tag Envelope." On the "Bergen specimen" there are slight traces of gum on the closing flap (which I mark *X* on both exhibits), but I do not find the flap gummed down.

On the open flap at the other end of the tag envelope (which I mark *Y* in both exhibits) I find a sufficient quantity of gum to fasten the flap down securely. The closing flap in both of the infringing exhibits is held down upon the back ply of the body by a short eyelet which passes through the coinciding holes in the flap *X*, and the front ply of the body.

In my opinion these exhibits show clearly the construction covered by the claims of the Dunham patents; they meet the conditions of the late patent No. 331,118, in that each has a closing flap
118 having a reinforced hole which coincides when the flap is turned down, with a reinforced hole in the front ply of the body; this flap overlapping the free end of the back ply of the body, and thus holding the pocket closed against the accidental escape of the contents, but leaving said back ply free, so that the pocket may be opened, and its contents removed, inspected and replaced, and the fastening replaced, without destroying or materially defacing the tag envelope.

The application of a little gum to the corners of the flap, to stick it down lightly to the back ply, was contemplated in the Dunham patent No. 331,118, as stated in his specification, page 2, lines 4 to 13 of the printed Patent Office copy.

The eyelet appears to be unnecessary, as the gum on the flap (*X*) would suffice to hold the flap down temporarily, or until the string passed through the holes. It is not required as a reinforce, in addition to the reinforcing washers, and it is so short, and the clinch is so meager or slight that the eyelet does not prevent the flap from being raised without difficulty. However, if this eyelet was long enough to be clinched securely down, and form a permanent attachment of the flap to the front ply of the body above or beyond

the free end of the back ply of the body, the exhibit would still be clearly infringements of the second claim of the Dunham patent No. 331,118, as the fastening would still leave the back ply free, and allow the pocket to be opened and closed.

The infringing exhibits are capable of being used in precisely the same manner as the envelope described in the Dunham patent No. 331,118, and for the purposes set forth in that patent; that is to say, the contents may be inserted at the open end, and the flap y sealed down, the other end, where the mouth of the envelope is situated, will then be left in precisely the same condition as
119 that end of the Dunham envelope is left; and the envelope may be employed either for mailing purposes or for a tag envelope.

These infringing Dennison exhibits in my opinion clearly infringe the second claim of the Dunham reissue No. 10488, as this claim broadly covers the coinciding reinforced holes in the flap, and envelope body, through which the string for securing the tag envelope to the merchandise is passed.

I consider the reinforcing washers of the infringing exhibit to be a well-known equivalent of the metal reinforces shown in the reissue and lettered C and D.

Both of these reinforcing devices are well known and have been for more than twenty years. In view of the facts, as I have before stated, the eyelet shown in the infringing exhibits serves no useful purpose, and appears to be employed to effect a colorable distinction in the construction, with a view of evading the claims of the Dunham patent,

I am of opinion that they also infringe the first claim of the reissue, as the string employed to attach the tag envelope to the package serves as the real means of holding down the flap.

38 Q. I hand you a Dennison tag envelope marked "Exhibit Smith for Identification No. 7" containing an inclosure; will you examine the same and state whether the envelope can be opened and the enclosure taken out by raising the flap marked *x* without breaking loose the fastening made by the metallic eyelet; and if it can be done please open it in presence of the examiner.

The same objection and as immaterial.

A. I have examined the exhibit handed me by counsel, and have opened it by raising the flap, *X* and drawing out the free end of the back ply of the body, without marring the envelope, and without breaking loose the fastening provided by the metallic eyelet.
I have also removed and replaced again the enclosure that I
120 found in the envelope, and rearranged the back ply under the flap as it was at first.

In opening this exhibit envelope I find that the eyelet and eyelet hole extend only through the flap *X* and the front ply of the body of the envelope, and that the mouth of the envelope was held closed only by the overlapping of the flap X on the back ply of the body.

The tag envelope is offered in evidence and marked Complainant's Exhibt Connett Experiment, July 7, 1888, J. A. S., ex'r.

The introduction of exhibit is objected to as immaterial and not in rebuttal.

39 Q. I hand you another Dennison tag envelope marked "Exhibit Smith for Identification No. 9," and ask you to examine it and if practicable open it in presence of the examiner, by breaking loose the fastening made by the metallic eyelet, without untying the string, and remove the inclosure, and replace it, without destroying or injuring the envelope.

The same objection.

A. I have examined the "Exhibit Smith for Identification No. 9," handed me by counsel, and find it in the same condition as the last exhibit opened by me, the eyelet in the flap X passing through the reinforced hole in the front ply and lightly clinched at the front. I now open the envelope by raising the flap X the eyelet offering no material resistance. I find that the eyelet does not extend through a hole in the back ply of the envelope, nor does the string or tape that passes through the coinciding re-enforced holes pass through the back ply. I draw forward the free end of the back ply, thus opening the mouth of the envelope and removing the enclosure. I replace the enclosure in the envelope, rearrange the back ply and close the flap X down over it again. I find now
121 that the string or tape, which I have not found it necessary to untie, serves to hold the flap X down and prevent the accidental escape of the enclosure, precisely as in the Dunham tag envelope.

The tag envelope is offered in evidence and marked Complainant's Exhibit Connet Experiment, No. 2, July 2, 1888, J. A. S., ex'r.

The same objection as to the last exhibit.

Adjourned until Wednesday, July 11, 1888, at 11 a. m.
Adjourned until July 17th, 1888, at 11 a. m., by consent.

NEW YORK, *July 17th*, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: Sam. Tro. Smith, Esq., of counsel for complainant, and W. W. Swan, Esq., of counsel for defendant.

The direct examination of Mr. CONNETT continued by SAM. TRO. SMITH Esq.:

40 Q. In answer to question 3d, Mr. Henry B. Renwick, on page 94 of the defendant's printed record, uses these words: "I did not refer to these words, because they have no bearing in my opinion upon the second claim, although they do show that the envelope, to be used in this manner, in connection with the strap, must be provided with a long flap, substantially such as provided in the patent."

Will you look at the device I now show you and state whether in your opinion, it does or does not come within the description referred to in the patent, in view of such answer of the witness Renwick?

A. In my opinion, the device shown me by counsel comes fairly within the language of the reissued patent No. 10488. The
122 device shows a strip tacked over that end of the envelope, opposite to that at which the longer flap is attached, and this flap is tucked under the said strip. There is nothing in the language of the patent to indicate any special width of the strip, and the envelope may be readily opened by simply withdrawing the end of the flap from under the strip. The patent specifies metal, rubber, or oil-cloth as the material for the strip, and the device or exhibit shows a strip of paper, but the paper sufficiently illustrates the use or function of the strip.

The device is offered in evidence, and marked Complainant's Exhibit Connett Tag Envelope Tacked on Box, with strip over one end, July 17th, 1888, J. A. S., examiner.

41 Q. Will you look at the tag envelope I now show you, and state whether or not, in your opinion, said tag envelope comes within the description set forth in the specifications, and claimed in reissued patent No. 10488?

A. In my opinion it clearly does come within the scope of the patent, and is fairly covered by all three of the claims of the patent. The flap, which closes the mouth of the envelope, is fastened down by the wire hook by which the tag envelope is to be secured to the merchandise; it has an eyelet hole in the flap, which, when folded down on the envelope, coincides with a similar eyelet hole in the envelope, so that the attaching hook or cord may be conveniently passed through both holes, and it has a long flap extending over the envelope from one end to the other—a condition called for by the third claim of the patent.

The tag envelope is offered in evidence and marked Complainant's Exhibit Connett Tag Envelope with Long Narrow Flap, July 17, 1888, J. A. S., examiner.

42 Q. On page 106 of defendant's printed record in the testimony of Henry B. Renwick I find in reference to patent 331,118,
123 and the paper fastener mentioned therein, this language: "Eyelets have been used for paper fasteners for thirty years or more to my knowledge." Will you state whether in your opinion eyelets were intended to be used as the paper fasteners referred to in that patent; and if not, what kind of paper fasteners were intended to be used, and give your reasons for such opinion?

A. The paper-fasteners referred to in the patent, and illustrated in figure 3 of the drawings, is not in any sense an eyelet, nor does such a fastener perform the usual functions of an eyelet; that is, the paper-fastener referred to in the patent is a specially constructed device, well known to all professional men under that name, and its purpose is to secure the sheets together in such a manner that they may be readily separated and again secured. The fastener may be removed and replaced at will. The eyelet while used as a fastener is in the nature of a rivet, and when one is placed and clinched it is next to impossible to remove it without tearing the

paper; and after being removed it cannot be replaced. The term paper-fastener in the patent is in my opinion a specific name for a particular kind of fastening device know- to the trade under this name; eyelets are not known to the trade as paper-fasteners so far as I am aware.

43 Q. On page 108 of defendant's printed record in the testimony of Mr. Renwick, I find the following language: "And the invention would be substantially the same if the envelope had holes in the same position not reinforced, the difference being one of degree." Will you state whether in your opinion the difference between a hole in the paper without reinforcement, and a hole in the paper, reinforced by the addition of a disk made of paper, metal or other substance, would or would not be a difference of degree?

A. In my opinion the difference between a hole in the paper without a reinforce, and one provided with a reinforce of the
124 character stated, would be one of kind rather than degree. The difference between a strong or weaker paper, or a thinner or thicker paper, would be merely one of degree; but in the case referred to there is something added, namely, the disk or metal plate. This in my opinion is something more than a mere difference of degree, over the plain hole in the sheet of paper.

Cross-examined by W. W. SWAN, Esq.:

44 X Q. Then you consider the reinforcement of the holes an essential feature of the envelope described and claimed in patent 331,118, do you?

A. Only so far as the patentee limits himself to such reinforcement by the language of his first claim. There is no such limiting language in his second claim.

45 X Q. Is this all the difference you find between the invention set forth in the two claims of the patent 331,118?

A. No, there are other differences which I believe I have pointed out in my direct examination.

46 X Q. In answer to interrogatory 26 you say, referring to the invention set forth in the first claim of patent 331,118: "The said back ply being thus removably secured so that the envelope may be opened designedly and its contents replaced without a necessity of removing the fastenings." Is this true of the envelope set forth in the second claim of said patent?

A. Yes; this is the characteristic feature of the envelope of the patent.

47 X Q. How, in this respect, does the envelope of the patent differ from the envelope of the reissued patent 10488?

A. In the envelope of the patent 331,118, the envelope may be opened without removing the device that secures the flap in place. In the envelope of the reissue, No. 10488, the fastening device of the flap was designed to be removed, in order to get at, remove and replace the enclosure,

48 X Q. Do you consider that the phrases "removably
125 secured" and "secured against accidental opening" in the two claims of patent 331,118 mean the same thing?

A. Taken in connection with the description of the envelope given in the specification, I think they do mean the same thing or express the same idea with respect to the purpose or object of the invention.

49 X Q. In what sense do you understand the word "clamped" to be used in the first claim of patent 331,118?

A. In the sense of holding down the back ply of the envelope body by the overlapping end of the flap C, which presses on said ply when the said flap is folded down and held down by suitable means.

50 X Q. In your opinion does the word "clamped" in the first claim of patent 331,118, add to, take away from, or in any way modify the force and effect of the words "removably secured" in the same claim?

A. In my opinion the two phrases do not in any way modify each other, each being independently descriptive of the effect produced by the flap on the back ply of the envelope body. However, in my opinion, this language of the claim, properly construed, means that the back ply of the envelope body should be both "clamped" and "removably secured" by the overlapping flap. The back ply might be removably secured, without any material clamping pressure on the back ply beyond that necessary to "removably secure" the said ply.

51 X Q. Do you find any essential difference between the two claims of patents 331,118, respecting the manner in which the back ply is to be "removably secured" by the overlapping flap?

A. No; the difference does not lie in that.

52 X Q. Do you find any essential difference between the two claims of patent 331,118 respecting the manner in which the flap is folded over on and secured down to the inner face of the front ply of the body of the envelope?

126 A. The essential difference between the two claims in this respect lies in this: That in the second claim it is essential that the flap shall be secured down to the front ply, but there is no limitation as to the means to be employed for the purpose; while in the first claim there is no limitation in respect of the flap being secured down at all in the envelope as an article of trade, but there is a limitation with respect to providing the flap and the front ply with coinciding holes, thus adapting it to receive the fastening device for holding the flap down. These are the features of difference between the two claims. The first claim does not mention any fastening device in the nature of a paper-fastener, or a string for securing down the flap, because, as I understand it, these do not constitute a part of the envelope as covered by the claim, and as designed to be furnished to the trade; nevertheless, the envelope covered by the first claim is adapted to receive such fastening devices.

53 X Q. Do you mean that the second claim of patent 331,118 includes the fastening device, and that the first claim does not include it?

A. I mean that the second claim is limited to a mailing envelope in which the flap is secured down by some means; while the first

claim is limited to a specific construction which adapts it to receive a fastening device for that purpose; but the requirements of the first claim would be fulfilled by an envelope in which the flap was not actually fastened down. Neither claim mentions specifically any particular fastening device for the flap; but an envelope that fulfilled the requirements of the second claim would in my opinion necessarily embody some means for securing down the flap to the front ply of the envelope body.

54 X Q. In the specification of 331,118 is the following: "Figure 5 shows metal eyelets, as substitute for the washers *d d'*; when these are used I usually make the flap C longer, so as to lap over further on the envelope back *b*, as these eyelets do not provide such an extent of clamping surface as the washers." Do you understand that in the construction here referred to two metal eyelets are required, or otherwise?

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A. Certainly, one re-enforcing eyelet in the front ply of the envelope body and the other in the flap C, as shown in figure 5 of the drawing.

55 X Q. In one of your letters to the Patent Office, while the application for patent 331,118 was pending, you said: "Applicant's invention has two features of novelty or supposed novelty. First, the construction whereby the back ply B is removably secured by flap C; secondly, the reinforcing of the holes in the flap and ply by reinforcing devices which are wholly independent of the fastening device, which may be a string, a wire, or a paper-fastener." Does this passage, which I have quoted from your letter, correctly represent your present views as to the novelty of the invention?

A. It does, with this further explanation, that what was meant therein respecting the reinforcing of the holes being independent of the fastening devices, was this: That these reinforces, and especially the washers, performed another function in addition to that of a reinforce in this particular envelope; that is, they stiffened the flap and front ply at the point where the back ply was embraced by these parts, and thus as I think and then thought, serve to hold the back ply of the envelope body the more securely, and this function would be the more marked in envelopes made from rather thin or flimsy paper.

56 X Q. What essential difference if any do you find between the two ends of the envelope shown in figure six of the patent 331,118, so far as the inventions set forth in the claims are concerned. Do you consider that one end is within the patent and that the other end is without it?

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A. There is a very important difference between the two ends of the envelope shown in figure 6. The flap at the right is permanently secured down by a hollow rivet F, which passes through the flap, and both plies of the envelope body, and is clinched or riveted down. This mode of securing the flap was not new at the time the patent was granted, I believe, and is not claimed in the patent. The left end of figure 6 shows the construction claimed.

57 X Q. When the envelope of patent 331,118 is used as a tag envelope, at which end is the invoice inserted?

A. That would depend somewhat on the taste of the user, and somewhat on the choice of the forms of envelope represented respectively on figures 1 and 6. If the form shown in figure 1 be chosen the user might insert the invoice at either end, preparatory to folding down the flaps B and C, which is the preferred form for a tag. If the form shown at figure 6 were chosen, the user would have of course to insert the invoice at the end closed by the flap C, as the flap B in this form is permanently closed in the manufacture of the tag envelope.

58 X Q. The application for the reissued patent 10488 originally contained the following claim: "A tag for marking merchandise, provided with an envelope or pocket substantially as set forth." Why did you withdraw that claim?

A. It has been several years since the reissue application was made, and I cannot recall distinctly, just the reasons why the claim was withdrawn at that time. To the best of my recollection the claim was refused by the examiner on the ground that it was too broad to be patentable in view of some use of envelopes as tags within his own knowledge, and after a conference respecting it with the patentee Mr. Dunham, the examiner's decision was not contested, and the claim was stricken out.

59 X Q. The application for the reissue No. 10488 also contained the following claim, namely: "A combined tag and envelope, made substantially as herein shown and described, and consisting of an envelope having at one end a flap of sufficient size to sub-
129 stantially cover one side of the envelope as set forth." Why was this claim withdrawn?

A. I will first state that it was inserted in the reissue application only because it formed the first claim of the original patent, and it was my custom always to insert the original claims in the reissue application.

It was rejected by the examiner, to the best of my recollection, but I do not now recall just what his objections were; my impression is that he did not give the same construction to the claim that I did, however. As the claim was too narrow to have any protective effect whatever, as I think and then thought, I struck it out after consultation with Mr. Dunham.

Adjourned to Wednesday, July 18th, 1888, 11 a. m.

NEW YORK, *July 18th*—11 o'clock a. m.

Met pursuant to adjournment.
Present: Counsel as before.

The cross-examination of Mr. CONNETT continued by W. W. SWAN, Esq.:

60 X Q. In giving your reasons for advising Mr. Dunham to apply for a reissue of his patent 277,245, you say, "In other words I believe that his invention extended to the closing down or fasten-

ing down of the flap, by the cord or device employed to secure the tag to the package, without reference to the size of the flap, so long as it sufficed to close the mouth of the envelope when it was tied down."

Where were the eyelet holes, and how many were there in this envelope with a different-sized flap, which you considered within the original invention?

A. The claims of the original patent limited him to an
130 envelope with a closing flap, extending from one end to the other, and inferentially, at least, limited him to the arrangement of the coinciding eyelet holes at the end of the envelope, opposite to the mouth, where the flap is attached. I believe that a tag envelope, having the coinciding eyelet holes arranged at the mouth end of the envelope, was clearly within the scope of his invention, generically, although he could not specifically claim that construction in the reissue. It was only essential that there should be coinciding reinforced holes in the flap, and front ply of the body; there might be a hole in the back ply also, and be within the scope of the invention.

61 X Q. The second claim of the reissue patent 10488, "whereby the cord or hook for fastening the tag may be passed through both holes, as specifically set forth," and the text of the specification ends with the following passage: "The cord or hook employed for securing the tag to the merchandise also serves, as shown, to close or secure the envelope, and prevent its contents from escaping in transit." Do you find any similar passages in the original patent 277,245. What authority do you find for those two passages in the original patent?

A. The language quoted from the specification and claim of the reissued patent merely states what seems to be an obvious fact, namely, that when the fastening device is passed through the coinciding holes, and then attached to the merchandise, the flap will close the envelope, and prevent its contents from escaping. In the original patent 277,245, lines 46 to 51, I find the following: "And a cord, hook or other device for holding the tag to the box, barrel, package, &c., is passed through the eyelets C D, and is then secured to the package, &c., whereby it will hold the flap closed over the envelope." I also find in the specification, lines 62 to 64, the following: "By using the above-described combined tag and envelope, the bill or invoice can be sent with the goods." I understand this language to mean that the invoice or bill is to be
131 put in the pocket of the envelope, the flap of the envelope folded down over the mouth of the same, and the cord or hook passed through the coinciding eyelet holes, and then attached to the package. The result of this would certainly be to close the envelope and prevent its contents from escaping in transit; therefore I think the language I have quoted from the original patent fairly warrants the use of the language quoted in the question, from the specification and claims of the reissue.

62 X Q. The language which you quote in your last answer from the original is to be found in the reissue patent, is it not?

A. It is. The language of the original patent was not departed from any further than seemed necessary in the preparation of the reissue, and the claim quoted from the reissue descriptive of the purpose or object of the invention was added for the purpose of emphasizing or rendering more clear the description as set forth in the original, and not with a view of introducing any new matter not warranted by the invention as illustrated and described in the original patent. I think the word "also" in the quotation in the preceding question, and found on line 87 of the reissue specification is perhaps superfluous, as tending to imply that the cord or hook performed a function different from and in addition to that set forth in the description preceding it, whereas it does not; the holding of the flap closed down by the string would, I think, necessarily prevent the invoice from escaping.

63 X Q. In the tag envelope, with the big flap, shown in the original patent, 277,245, and the reissue, 10488, through what flaps and what plies does the string or hook pass that is to secure the tag envelope to the merchandise?

A. The string passes through the eyelet hole in the large flap and through the eyelet hole C at the bottom, or other end of the envelope. This eyelet passes certainly through the flap that closes that end of the envelope and the front ply of the envelope
132 body; the drawing of the patent does not clearly show whether eyelet C, which is a rivet, passes also through the back ply or not. The drawing of the reissue is simply a copy of the drawing of the original patent.

64 X Q. In which end of the envelope is the invoice inserted, in the use of the envelope with the long flap, shown in the original patent, 277,245? Is it put into the end of the envelope that is secured to the package, or at the other end?

I understand that the envelope shown in the patent, 277,245, had only one open mouth, and that is at the end opposite to the end that is to be attached to the package; although the description in the patent does not, I believe, set forth this fact, respecting the end of the envelope where the eyelet C is placed; however, I think the drawing and description fairly warrants the inference that the end of the envelope, where the eyelet C is placed, was designed to be permanently closed in the manufacture.

65 X Q. What change would be necessary in the envelope at figure 1, in the patent 277,245, to give it a short flap in place of a long flap, and still keep it within the scope of the original invention?

A. The flap B might be cut off, and the coinciding eyelet holes to receive a string or other fastening device placed at the opposite end of the tag envelope. I do not consider it material in making this change whether the flap B is materially abbreviated, but in order to have a proper space in the pocket for the invoice, the coinciding holes should be at one or the other end of the envelope, unless the envelope was quite large. This is an advantage, when the envelope is to be used as a tag in placing the holes that receive the attaching device near one end.

66 X Q. I mean could you alter one of Mr. Dunham's envelopes like those shown at figure 1, of the patent 277,245, to an envelope having a short flap, instead of a long flap without departing
133 from the original invention? I mean, of course, without substantially altering the capacity of the envelope for holding the invoice. If you could, please state how you do it?

A. I do not think there would be any difficulty in doing that. I would first cut off the flap, to the proper length, then fold it down over the mouth of the envelope, then punch a hole through the flap and the body of the envelope, a little way from the end of the latter.

This would provide the necessary coinciding holes. I would then reinforce the holes in the flap, and the front ply of the envelope body. This construction would in my opinion be within the scope of Mr. Dunham's original invention, as covered generically by the second claim of his reissue No. 10488.

67 X Q. After making this change, then, you would reverse the ends to which you attach the string, to secure the tag envelope to the package, would you not?

A. Of course; the string would necessarily be at the end, where the coinciding holes are placed, and these would be at the other end of the tag envelope.

68 X Q. After making the changes described in your answer to cross-interrogatory 66, how would the tag envelope differ from the tag envelopes described and claimed in the later patent 331,118?

A. That would depend on conditions not included in my answer. The envelope specifically claimed in the patent No. 331,118, has of necessity a free-ended back ply, the string or fastening device not passing through a hole in said back ply. The claim to this device in the later patent is specific and subsidiary to the generic, claim, two, of the reissue. In the supposed construction that I have described, the attaching string might or might not pass through the back ply of the envelope body. If this ply extended up under the flap, beyond the point where the coinciding holes are placed, then there would be a hole in the free end of the back ply.
134 The claims of the later patent are limited to this end of the back ply being left free.

69 X Q. If the envelope of figure 1, of the original patent 277,245, were altered by cutting off most of the long flap and placing gum upon the short flap thereby remaining, the eyelet marked C, in the patent being still used for the attachment string, would there in your opinion be any departure from the original invention of patent 277,245?

A. In my opinion it is essential to the invention of the patent No. 277,245, that there shall be a free flap to be held down by the attaching string, and as I understand the eyelet C of the drawing, it is employed as a rivet for permanently securing the flap down on the envelope; therefore, such construction would be a departure from the invention. This eyelet C, serves a double purpose, as represented in the drawing and described in the patent, namely, as a rivet to permanently secure the plies together, and is a reinforce

for the holes in the plies and flap. If the eyelet C was not so firmly clinched as to prevent the flap from being readily raised, in that case I think the construction would be within the scope of the patent, as I do not consider it important to the patent whether the other flap is secured by gum or by a rivet.

70 X Q. If the envelope of figure 1, of the original patent 277,245, were altered as suggested in my last question, would it in your opinion come within the scope of either claim of the patent 331,118?

A. To determine that I would have to assume certain conditions that are not very clear in said figure 1. If the flap in which eyelet C is placed were not otherwise secured down on the back ply so that it could not be readily detached; or if the eyelet C passed through the end of the back ply, either or both, so that the envelope could not be opened at that end, in the manner described in the patent 331.118, then it would not come within the scope of the claim of said patent.

HENRY CONNETT.

135 Time for taking testimony is extended until September 1st, 1888.

Adjourned until August 20th, 1888, at 11 a. m.
Adjourned by consent to September 3, 1888, at 11 o'clock a. m.

NEW YORK, *September 3d* 1888—11 o'clock a. m.

Met pursuant to adjournment.
Present: Sam. Tro. Smith, Esq., of counsel for comp't.

Mr. HENRY W. PROSSER recalled:

1 Q. Mr. Prosser, are you familiar with the forms of legal-tie envelopes and of wedding envelopes which have been in the market in this country?

A. I think I have manufactured or seen every kind that has been in use or for sale.

2 Q. For how many years?

A. Something over 20 years.

3 Q. Will you describe the legal-tie envelopes or document envelopes which have been in the market?

A. Those that are intended to be tied with tapes are usually made open at the sides, so that the string goes around the narrow way of the envelope instead of lengthwise, although I have seen them open on the end with a short flap, and tape around the whole length of the envelope.

4 Q. How was the string attached to these envelopes, and where?

A. Usually attached to the flap, by eyelets or fasteners, although I have seen it attached to the envelope directly underneath a short flap, and fastened through an eyelet in the flap.

5 Q. To whose manufacture of envelopes do you refer in the last clause of your last answer?

A. To Schultz's patent-tie envelope.

6 Q. What other form of legal or tie envelope, if any, have
136 you ever seen in which the string or tape was attached to, or passed through both the body of the envelope and the flap?

A. I don't recollect any other.

7 Q. Will you state what is the construction of wedding envelopes which you have manufactured or seen in the market; I mean wedding envelopes in which the flap substantially covers one side of the envelope?

A. I have made and seen envelopes where the flap covered the entire surface of the envelope, but such envelopes have always been open at the side, never at the end, to my knowledge.

H. W. PROSSER.

Mr. RICHARD H. CLARKE, a witness produced on the part of the complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence and occupation.

A. Richard H. Clarke; age, 40 years; I reside at 283 Franklin avenue, Brooklyn; I am an envelope salesman.

2 Q. How long have you been engaged in the business?

A. About 23 years.

3 Q. Are you familiar with the style of legal-tie envelopes and wedding envelopes which have been in the market in this country during that time?

A. I have sold and handled quite a number in that time.

4 Q. Will you describe the style of legal-tie envelopes which have been in the market during that time?

A. Those that I have seen have usually been open on the side and fastened through the short flap by an eyelet, by a string or tape which passed around the envelope and tied.

137 5 Q. Have you ever seen any other form of legal-tie envelope?

A. Yes, I have seen an envelope open on the end and fastened to the body of the envelope by an eyelet or fastener, and which passed through the short flap of the envelope lengthwise.

6 Q. To whose manufacture of envelope do you refer in your last answer?

A. To Schultz's patent-tie envelope.

7 Q. If you have seen any other form of legal-tie envelope, please describe them.

A. I do not remember any other style.

8 Q. In your business would you have been likely to see other forms if they had been on the market?

A. I think I should. Yes, sir.

9 Q. Will you describe the style of wedding envelopes, having a flap substantially covering the body of the envelope, which you have seen in the market during your experience as a salesman?

A. I have seen several styles of wedding envelopes, where the flap covered the whole surface of the envelope, such envelope being open on the side.

10 Q. Will you state whether or not you have ever seen such wedding envelopes made open on the end?

A. I don't remember ever seeing any such.

RICHARD H. CLARK.

Mr. HENRY N. OSBORN, a witness produced on the part of complainant, being duly sworn, testifies as follows:

1 Q. Please state your name, age, residence, and occupation.

A. Henry N. Osborne; age, 50 years; I reside at 674 Lexington avenue, Brooklyn; I am an envelope salesman.

2 Q. How long have you been engaged in business as such salesman?

A. Thirty-three years.

138 3 Q. During that time have you been familiar with the styles of legal-tie envelopes and wedding envelopes, which have been on sale in the market?

A. I have.

4 Q. Will you describe the legal-tie envelopes which you have seen in the market?

A. Oblong in shape, the flap running the full length of the envelope, with the tape encircling the flap, fastened to it with an eyelet or fastener, the tape wound around the envelope and tied.

5 Q. Please state whether or not you have ever seen a legal-tie envelope made in any other form?

A. I never have. I have seen patent envelopes generally used for transmitting samples through the mails, which were fastened with tape through the body of the envelope on the back, with eyelets on the flap.

6 Q. To whose manufacture of envelopes do you refer in your last answer?

A. Schultz's tie envelope, patented Sept. 23d, 1879.

7 Q. Have you ever seen any other?

A. I don't remember any other.

8 Q. Would you have been likely to see other forms if they had been in the market?

A. I think I should.

9 Q. Will you describe the style of wedding envelopes which you have seen in the market having a flap substantially covering the body of the envelope?

A. I have seen wedding envelopes both nearly square and oblong, with flap extending full width of the envelope, or covering the full surface of the envelope. The opening of the envelope is on the longer side.

10 Q. Will you state whether or not you have ever seen such wedding envelopes having the opening on the shorter side?

A. I don't remember ever seeing such.

139 11 Q. In your business would you have been likely to see such envelopes if they had been on the market?

A. I believe I should.

HENRY N. OSBORN.

Adjourned till Tuesday, Sept. 4th, 1888, at 11 a. m.

NEW YORK, *September 4th*, 1888—11 o'clock a. m.

Met pursuant to adjournment.

Present: W. W. Swan, Esq., of counsel for def'ts, and Sam. Tro. Smith, Esq., of counsel for compl't.

It is stipulated that the time for taking testimony herein be, and it is hereby, extended to and including October 15, 1888.

It is agreed that the envelope now produced and marked "Def't's Exhibit Ullman-Renwick" is a specimen of the Ullman envelope, such as Mr. Renwick agreed to produce in answer to interrogatory 7, page 99 of def't's printed record.

Also that Compl't's Exhibit "Schultz Tie Envelope," is a specimen of the Schultz envelope such as Mr. Renwick agreed to produce in same answer.

The testimony in rebuttal was here closed.

J. A. SHIELDS,
Examiner, &c.

140

(No Model.)

J. T. DUNHAM.

COMBINED TAG AND ENVELOPE.

No. 277,245. Patented May 8, 1883.

No. 294.
Dunham
v.
Dennison
Mfg Co.
p. 140.

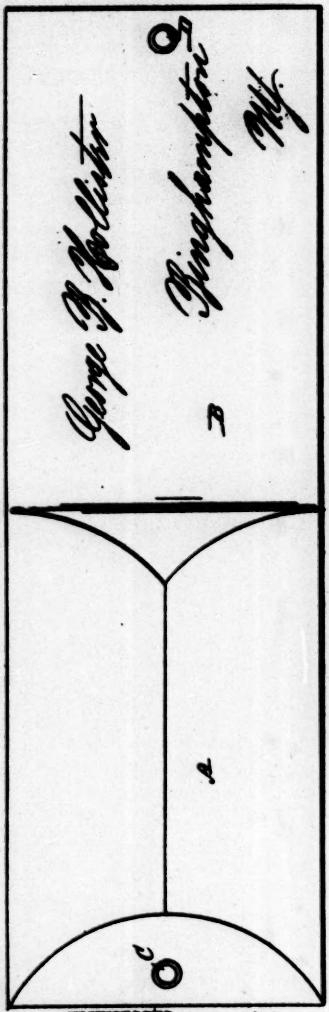


Fig. 1.

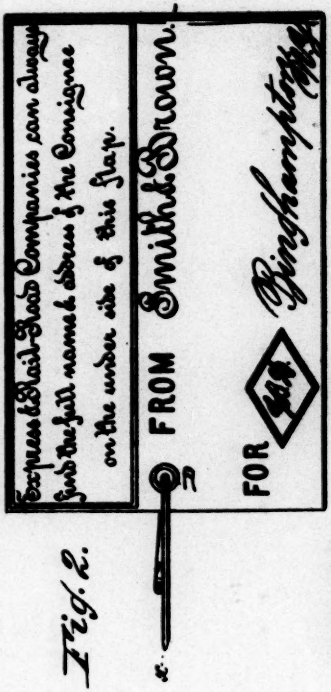


Fig. 2.

Fig. 3.

WITNESSES:

Theo. G. Hoster
C. Bedgwick

INVENTOR:

J. T. Dunham

BY Munn & Co.

ATTORNEYS.

141 UNITED STATES PATENT OFFICE.

JOSEPH T. DUNHAM, of Brooklyn, New York.

Combined Tag and Envelope.

Specification forming part of Letters Patent No. 277,245, dated May 8, 1883; application filed January 15, 1883. (No model.)

To all whom it may concern:

Be it known that I, Joseph T. Dunham, of Brooklyn, Kings county, New York, have invented a new and improved combined tag and envelope, of which the following is a full, clear, and exact description.

The object of the invention is to form an envelope with an end flap covering its side, as hereinafter described.

Reference is to be had to the accompanying drawings, forming part of this specification, in which similar letters of reference indicate corresponding parts in all the figures.

(Here follows diagram marked p. 140.)

Figure 1 is a longitudinal view of my improved combined tag and envelope, showing it opened. Fig. 2 is a longitudinal view of the same, showing it closed; and Fig. 3 is a longitudinal sectional elevation of the same on the line *x x*, Fig. 2.

An envelope, A, preferably made of strong water-proof paper, is provided with an end flap, B, of sufficient size to cover the entire envelope. An eyelet, C, is secured in that end of the envelope opposite to the one to which the flap B is attached, and the flap B is provided on its free end with an eyelet, D, which, when the flap B is folded over the envelope, rests upon the eyelet C. The full address of the consignee is written on the inner surface of the flap B, as shown in Fig. 1. The name, business address, trade-mark, &c., of the consignor or shipper are printed or otherwise produced on the outer surface of the flap B, and the initials or mark, &c., of the consignee and the destination of the invoice are written, printed, or otherwise produced on the inner surface of the flap B, as shown in Fig. 2. The following or similar information is printed on the outer surface of the flap B, at the top or bottom or ends of the same: "Express or railroad companies can always find the full name and address of the consignee on the under side of this flap."

The combined tag and envelope is used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over the envelope A, and a cord, hook, or other device for holding the tag to the box, barrel, package, &c., is passed through the eyelets C D, and is then secured to the package, &c., whereby it will hold the flap closed over the envelope; or the envelope can be tacked to the barrel, box, &c., and the free end of the flap is passed under a metal, rubber, or oil-cloth strip tacked transversely over that end of the envelope opposite to the one to which the flap is fastened,

whereby the flap will be held closed over the envelope, and in either case can easily be opened in case an employé of a railroad or express company wishes to read the address written on the under side of the flap.

By using the above-described combined tag and envelope the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable, as it is desirable that the purchaser is informed in regard to the prices of the merchandise as soon as possible, so that he can sell immediately. Furthermore, the address is concealed, and dealers cannot ascertain the addresses of the customers of their competitors. At the same time the express and railway companies can easily ascertain the addresses by raising the flap B.

If desired, the address, &c., shown in Fig. 3 can be printed or otherwise produced on the back of the envelope, and the flap placed under the envelope in attaching the name.

Having thus described my invention, I claim as new and desire to secure by letters patent—

1. A combined tag and envelope made substantially as herein shown and described, and consisting of an envelope having at one end a flap of sufficient size to cover one side of the envelope, as set forth.

2. In a combined tag and envelope, the combination, with an envelope, A, having a flap, B, at one end, of the eyelet D in the free end of the flap, and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described, and for the purpose set forth.

JOSEPH T. DUNHAM.

Witnesses:
OSCAR F. GUNZ.
C. SEDGWICK.

142

J. T. DUNHAM.

COMBINED TAG AND ENVELOPE.

No. 10,488. Reissued June 10, 1884.

No. 294. Dunham vs. Dennison Mfg. Co. v. 142.

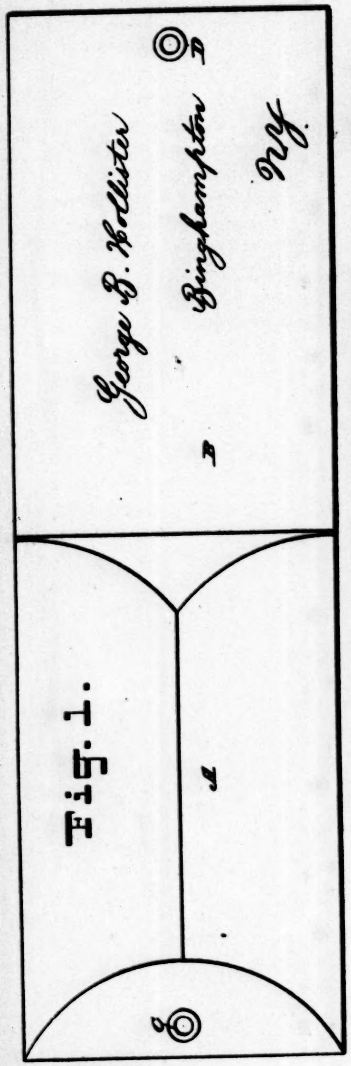


Fig. 1.

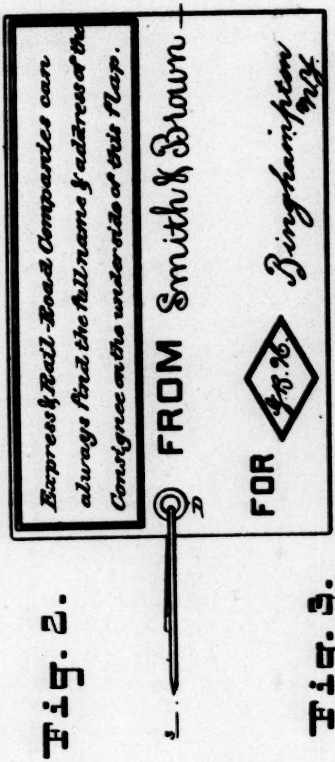


Fig. 2.

Fig. 3.

WITNESSES:
Geo. H. Fraser.
E. B. Bolton

INVENTOR:
Joseph T. Dunham
By his Attorneys.
Burke, Fraser & Connolly

143 UNITED STATES PATENT OFFICE.

JOSEPH T. DUNHAM, of Brooklyn, New York.

Combined Tag and Envelope.

Specification forming part of Reissued Letters Patent No. 10488, dated June 10, 1884; original No. 277,245, dated May 8, 1883. Application for reissue filed March 18, 1884.

To all whom it may concern:

Be it known that I, Joseph T. Dunham, of Brooklyn, Kings county, New York, have invented a new and improved combined tag and envelope, of which the following is a full, clear, and exact description.

My invention consists in a tag provided with means for attaching it to the merchandise, and with an envelope or pocket to receive a bill or invoice of the merchandise.

In order that my invention may be the better understood, reference may be had to the accompanying drawings, forming part of this specification, wherein I have shown my combined tag and envelope in its preferred form.

(Here follows diagram marked p. 142.)

Figure 1 is a longitudinal view of my improved combined tag and envelope, showing it opened. Fig. 2 is a longitudinal view of the same, showing it closed; and Fig. 3 is a longitudinal sectional elevation of the same on the line *z z*, Fig. 2.

I will now describe my invention as shown in the drawings.

An envelope, A, preferably made of strong water-proof paper, is provided with an end flap of sufficient size to substantially cover the side of the envelope. An eyelet-hole, C, is arranged in the end of the envelope opposite to that at which the flap B is attached, and the flap B is provided at its free end with an eyelet-hole, D, which coincides with eyelet-hole C when the flap is folded over on the envelope. The full address of the consignee is written on the inner face of flap B, as shown in Fig. 1. The name, business-address, trade-mark, &c., of the consignor or shipper are printed on the outer face of flap B, and the initials or mark, &c., of the consignee and the destination of the invoice are written on the outer face of flap B, as shown in Fig. 2. The following or similar information is printed on the outer face of flap B: "Express or railroad companies can always find the full name and address of the consignee on the under side of this flap."

The combined tag and envelope is used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over the envelope A, and a cord, hook, or other device for holding the tag to the box, barrel, package, &c., is passed through the eyelets C D, and is then secured to the package, &c., whereby

it will hold the flap closed over the envelope; or the envelope can be tacked to the barrel, box, &c., and the free end of the flap is passed under a metal, rubber, or oil-cloth strip tacked over that end of the envelope opposite to the one to which the flap is fastened, whereby the flap will be held closed over the envelope, and in either case can easily be opened in case an employé of a railroad or express company wishes to read the address written on the under side of the flap.

By using the above-described combined tag and envelope the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable, as it is desirable that the purchaser be informed in regard to the prices of the merchandise as soon as possible, so that he can sell immediately. Furthermore, the address is concealed, and dealers cannot ascertain the addresses of the customers of their competitors. At the same time the express and railway companies can easily ascertain the addresses by raising the flap B.

If desired, the address, &c., shown in Fig. 3 can be printed or otherwise produced on the back of the envelope, and the flap placed under the envelope in attaching the name.

By the means for attaching the tag to the merchandise, I refer to the holes C and D, through which the cord or hook is passed. These, as intimated, are re-enforced by eyelets of some suitable material.

The cord or hook employed for securing the tag to the merchandise also serves, as shown, to close or secure the envelope and prevent its contents from escaping in transit.

Having thus described my invention, I claim—

1. A combined tag and envelope, substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise, as set forth.

2. A combined tag and envelope, substantially as described, the flap having an eyelet-hole which, when the said flap is folded
144 down on the envelope, coincides with an eyelet-hole in the envelope, whereby the cord or hook for attaching the tag may be passed through both holes, substantially as set forth.

3. In a combined tag and envelope, the combination, with an envelope, A, having a flap, B, at one end, of the eyelet D in the free end of the flap, and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described, and for the purpose set forth.

In witness whereof I have hereunto signed my name in the presence of two subscribing witnesses.

JOSEPH T. DUNHAM.

Witnesses:
SAM. TRO. SMITH.
PHILIP A. BROWN.

THE LAW ASSOCIATION
OF
PHILADELPHIA.

145

(No Model.)

J. T. DUNHAM.

ENVELOPE.

No. 331,118. Patented Nov. 24, 1885.

Fig. 1.

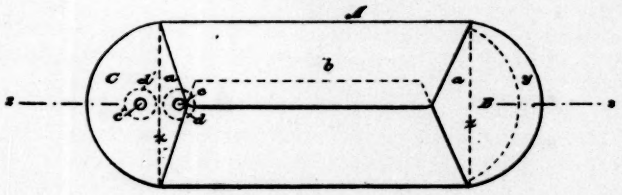


Fig. 2.

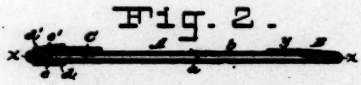
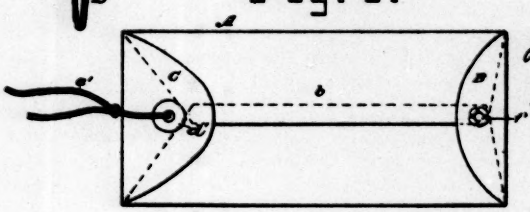


Fig. 3.

Fig. 4.

Fig. 5.

Fig. 6.



No. 294 Dunham & D. Mfg. Co. } p. 145

WITNESSES.

E. M. Botton

Geo. H. Fraser.

INVENTOR:

Joseph T. Dunham

By his Attorneys,

Burke Fraser & Connett

JOSEPH T. DUNHAM, of Brooklyn, New York.

Envelope.

Specification forming part of Letters Patent No. 331,118, dated November 24, 1885; application filed January 26, 1885. Serial No. 153,971. (No model.)

To all whom it may concern:

Be it known that I, Joseph T. Dunham, a citizen of the United States, and a resident of Brooklyn, Kings county, New York, have invented certain improvements in envelopes, of which the following is a specification.

My invention relates to an envelope designed primarily for use as an envelope for mailing samples and other like matter, and for use as a tag for marking goods to be shipped. An envelope for mailing samples must, in order to be subject only to postage rates as third-class matter, be left unsealed; and it has been customary to provide envelopes of this character with a sealing flap at one end and a flap secured by a string or paper fastener at the other end; but in order to get at the contents of the envelope for examination it has been necessary to untie the string or remove the fastener, both of which must be carefully replaced. My invention obviates these difficulties by rendering the removal of the fastenings unnecessary, by reason of the peculiar construction of the envelope.

(Here follows diagram marked p. 145.)

In the drawings which serve to illustrate my invention, figure 1 is a back view of my improved envelope as I prefer to make it for use as a mailing envelope for samples. Fig. 2 is a longitudinal mid-section of same, but showing the flaps folded down. Fig. 3 is a similar section to Fig. 2, showing the top flap secured by a paper fastener and the envelope partly opened for examining the contents. Fig. 4 is a view similar to Fig. 3, but showing a string employed for securing the top flap in lieu of a paper fastener. Fig. 5 shows metallic eyelets in lieu of the disk or washer re-enforcing eyelets shown in the previous figures. Fig. 6 shows my improved envelope as I prefer to construct it for use as a tag and envelope, the bottom flap in this case being secured by a metallic eyelet.

Referring to Figs. 1, 2, and 3, A is the body of an envelope, of any desired size and proportions and made from any suitable material, but usually of some tough kind of paper. This body has two "plies" or thicknesses—one forming the front *a* and the other the back *b*.

In Fig. 1 a triangular portion of the front *a* is seen at each end of the back *b*.

B is what I call the "bottom flap," and C is what I call the "top flap." In closing the envelopes these flaps are folded on the dotted

lines *x x*, as will be well understood. The bottom flap, B, is or may be provided with a coat of gum, *y*, to make it self-sealing.

The front *a* of the envelope has a hole, *c*, punched in it quite close to the end of the back *b*, as seen at the left in Fig. 1, and this hole is re-enforced by a washer, *d*, gummed to the face of the envelope. The flap C has also a hole, *c'*, punched in it in a position to register with the hole *c* when the flap C is folded down, as in Fig. 2, and this hole is re-enforced by a washer, *d'*.

The envelope may be furnished to the trade with the flap C turned down and secured by a paper fastener, *e*, as in Fig. 3, or any other suitable fastening. The flap B is left unsealed, and the user inserts the material to be mailed at the bottom and seals down flap B, in order to close the filling aperture. The flap C and the washers *d d'* overlap the end of the back *b*, and thus secure this end of the envelope from being accidentally opened and the contents lost; but the examining official at the post-office may with very little trouble open the envelope at this end by bending back the flap C and the washer thereon far enough to enable him to draw out the end of back *b*, (as in Fig. 3,) and thus gain access to the interior. After examination the parts may be returned to their normal position.

Fig. 5 shows metal eyelets as substitutes for the washers *d d'*. Where these are used, I usually make the flap C longer, so as to lap over farther on the envelope back *b*, as these eyelets do not provide such an extent of clamping surface as the washers. The washers *d d'* are usually made from thick tough paper, and cemented to the envelope with a water-proof cement. These may be replaced by metallic washers secured by clinched clips. Where the flap C is secured by a readily applied fastening, the bottom flap, B, might be sealed down in the manufacture, thus leaving the other end open for the insertion of the matter to be mailed, the flap C to be secured by the user after filling the envelope. The flap C might be conveniently secured by a string, *e'*, as indicated in Fig. 4; and where the
147 envelope is to be used as a tag for marking goods to be shipped this string may serve to attach the envelope tag to the goods.

I may sometimes gum the flap C to the exposed portion of the inner face of the front *a*, but this I do not consider necessary; and I may also, where the envelope is to be used as a tag and is liable to rough usage in handling, gum the corners of flap C lightly to the back *b*, to prevent its being too easily bent back; but this sealing, if used, should be of such a character as to be readily broken by the insertion of the finger under flap C.

In Fig. 6 I show the envelope as I prefer to construct it for use as a tag. In this construction the bottom flap, B, is permanently secured by an eyelet, *f*, that passes through and is clinched. This is better than sealing with the ordinary gum, as the flap will not be freed by dampness. The bill or invoice is to be inserted at the other end and the flap C secured by the string or wire whereby the tag is attached to the goods.

Having thus described my invention, I do not claim the use of the washers *d*, broadly, as these have long been used on tags; nor do I

claim the fastening together of envelopes by means of clinched eyelets in lieu of gum, as this is not new.

As I have before stated, mailing envelopes have been used having one flap, tied or fastened down in some similar way, and the other flap sealed; but in these the fastening device must be removed to get at the contents. In my former patent, also, I showed a combined tag and envelope, and this I make no claim to herein; but

What I claim as new is—

1. An envelope having a flap, C, provided with a re-enforced hole, *c'*, and having a similar hole, *c*, in the front ply of its body, and the said holes constructed to register or coincide when the flap C is folded down, whereby the end of the back ply, *b*, of the envelope body, which extends entirely across the latter, is clamped and removably secured, substantially as shown and described.

2. A mailing and tag envelope having a flap, C, folded over on and secured down to the inner face of the front ply of the body, and said flap being also constructed to take over the free end of the back ply of the body, as shown, whereby the mouth of the envelope covered by said flap C is secured against accidental opening, substantially as and for the purposes set forth.

In witness whereof I have hereunto signed my name in the presence of two subscribing witnesses.

JOSEPH T. DUNHAM.

Witnesses:
HENRY CONNETT.
ARTHUR C. FRASER.

148 U. S. Circuit Court, Southern District of New York.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

Testimony taken on the part of the defendant under and pursuant to the 67th rule of the Supreme Court of the United States, as amended, before John A. Shields, a standing examiner of said court.

NEW YORK, *December 8th*, 1887.

Present: W. W. Swan, Esq., of counsel for defendant, Sam. Tro. Smith, Esq., of counsel for complainant.

GEORGE E. TUCKER, a witness called by the defendant, being duly sworn, testifies as follows:

Q. 1. What is your name, age, residence and occupation?
A. George E. Tucker, age 50; residence, Plantsville, Conn.; occupation, printer.
Q. 2. By whom are you employed as printer?
A. The Pultz & Walkley Company.

Q. 3. Is L. M. V. Walkley of Plantsville, Connecticut, a member of that company, and if so, what office does he hold, and how long has he been an officer of that company, if you know?

149 A. He is manager of the business; whether he held an office outside of that I don't know; he was treasurer for years.

Q. 4. Was Mr. John P. Pultz a member of that company?

A. He was one the directors, he is dead now, he died ten years ago the 3rd day of this month.

Q 5. What is the business of the Pultz & Walkley Company, and how long have they been engaged in it?

A. Manufacture of paper machine bags, flour sacks, hand bags, tags, tag envelopes, job printing; etc. The Pultz & Walkley Company was organized July, 1870.

Q. 6. You mention the manufacture of tag envelopes as a part of their business, how long have you known of such manufacture by them?

Objected to by complainant's counsel as immaterial, unless the tag envelopes are shown to have been similar to those upon which this suit is founded.

A. I know they manufactured the tag envelopes in 1875.

Q. 7. If you have with you a tag envelope such as they manufactured in 1875, to your knowledge, will you produce it to be marked as an exhibit in the case?

Complainant's counsel objects to the production of such tag envelope unless it is shown to have been actually produced at the time referred to and not merely similar to one thus manufactured.

A. I have a tag envelope here the same as they manufactured at that time, I produce it as requested.

150 Defendant's counsel puts in evidence the tag, produced by the witness; and it is marked Defendant's Exhibit Pultz & Walkley Tag Envelope, J. A. S., ex'r. Complainant's counsel objects to the introduction of the exhibit as immaterial, it does not appear to have been manufactured previous to the date of complainant's patent.

Q. 8. Will you state, if you can, when this identical envelope produced by you in the answer to the last interrogatory, was made?

A. It was made previous to November 1st, 1876.

Q. 9. How do you fix this date?

A. I fix it by the type and printing, the type for the lines invoice tag envelope was issued previous to that time, and because the factory was burned the last Sunday night in October, 1876, and we never used that font of type since in the shop on a tag envelope, we have never had the font in the shop, we never replaced it since the fire.

Q. 10. Who did the printing upon the exhibit?

A. I did.

Q. 11. Will you read the printing upon the exhibit?

A. Upon the front side under a space for the address are the words, "from the Pultz & Walkley Co., manufacturers of the patent clasp eyelet shipping tag and invoice tag envelopes, Plantsville, Conn.," and on the back "sample of No. 25 M, price $3.50 per 1,000.

No. 20 M, size smaller, $3.00 per 1,000.

No. 30 M, size larger, $4.00 per 1,000.

Printing, $1.00 per M extra.

Stringing, 50 cents per M extra.

Sent free to any address on receipt of price.

"This novel and useful invention answers the double pur-
151 pose of the common tag and envelope, so that the invoices may be sent with express and other packages saving time and money. Send plain printing directions with orders."

Q. 12. State whether or not you have known of the manufacture by the Pultz & Walkley Company of tag envelopes similar to this Pultz & Walkley Exhibit which you have produced, since November, 1876, and if so, to what extent?

Objected to by complainant's counsel as immaterial, as the exhibit is in no respect similar to complainant's tag envelopes upon which this suit is brought.

A. They have manufactured them similar since that date but they have not done a heavy business, I could not say exactly the quantity. Several thousand a year, I should judge.

Same objection.

Q. 13. How has your attention been called to this manufacture from time to time?

A. I was superintendent of the room they were manufactured in.

Q. 14. State whether you are able to fix the time of the manufacture of any of those tag envelopes by Pultz & Walkley otherwise than by the date of the firm you have spoken of?

Same objection.

A. I can fix it by the date of their invoices in their books.

Q. 15. State whether you have recently examined the books
152 of the Pultz & Walkley Company, with a view to fixing the date of the manufacture of some of their tag envelopes, and if you have, state with what result?

Same objection.

A. I have examined their books, and find their charges for tag envelopes to different parties previous to the date of the firm.

Q. 16. Where are the books of the company which you have thus examined? Who has charge of them?

Same objection.

A. They are in their office at Plantsville, Connecticut, and George Bond has charge of them at the present time.

Q. 17. If you have with you a transcript from the books of the company indicating the sale of such tag envelopes by the company,

will you produce such transcript to be marked as an exhibit in this case, and state the circumstances under which the transcript was made and how you identify it?

Same objection; and also complainant's counsel objects to the evidence as secondary evidence and insists upon the production of the book itself.

A. I have such a transcript and produce it as requested. It was copied from the books in the office, and I compared it with the books and found it to be correct, as the books showed. Also I wrote on the margin of the exhibit in red ink. I recognize the entries as E. A. Wood's writing, and so wrote upon the exhibit, "E. A. Wood's
153 writing, and again, "Do." "do." "do." "do."—I also noticed J. P. Pultz's writing on some entries, and against the corresponding entries in the transcript wrote, "J. P. Pultz's writing and "do." These words in red ink on the transcript are in my handwriting. I also signed my name at the end of the transcript.

Defendant's counsel puts the transcript produced by the witness in evidence and it is marked "Exhibit Transcript from P. & W. Co.'s Books," J. A. S., ex'r.

Counsel for defendant further states that he is authorized by the Pultz & Walkley Co. tc say that they will exhibit their books at their office in Plantsville, Conn., to any of the parties interested in the present suit, that the same may be examined with a view to verifying the transcript produced by the witness.

Complainant's counsel objects to the transcript on the grounds, first, that it is immaterial with reference to an exhibit similar to complainant's tag envelope; second, that it is a copy of written evidence and as such is inadmissible.

Q. 18. Will you read from the transcript that you have produced and that is marked "Exhibit Transcript from P. & W. Co's, Books" the second and last but one entries thereon?

Same objection.

A. They are as follows: the second entry is—

154 Feb., 1875.

378	26	Brooks, Bancroft & Co., Boston, Mass.		
"		2 M No. 1 pat. tags,	2.50.....	5 00
"		5 M No. 3	3.50.....	17 50
"		10 M No. 4	3.75.....	37 50
"		10 M No. 5	4.00.....	40
				100 00
		40 & 10 per cent.....		46
				54 00
"		1 M "25 tag envelopes, $3.50		
"		1 case 205 No. ¼ per cent., 87.....		2 63
				56 63

The second entry referred to in the question is:

March, 1876.

392	9	H. K. W. Hall.			
"		2 M No. 2 Eagle tags, 88.....		1 76	
"		1 M 25 tag envelopes, 3.50.....		3 50	
				5 26	
		1 bdl. ex. 25 per cent.....		1 31	$3 95

Same objection to answer as to question

Q. 19. State whether or not you have done any other printing with reference to tag envelopes manufactured and sold by Pultz & Walkley Company, and if so, state of what it consisted?

Complainant's counsel objects to the evidence as immaterial unless confined to printing having reference to tag envelopes like the tag envelopes of the complainants.

A. A circular and price-list.

155 Q. 20. If you have with you such circular and price-list will you read it and state when it was printed?

Same objection.

A. I have such a circular and price-list and produce it. It was printed by me previous to November 1st, 1876. It is as follows:

Tag envelopes.

We desire to call the attention of the manufacturers and merchants and all who have occasion in their business to send express packages to their customers to our

New Invoice Tag Envelopes.

In introducing this novel and useful article, we feel confident that it meets a want long felt by shippers, and will prove a great saving of both time and money.

It often happens that a package is sent to a customer by express and invoice by mail; the package reaches its destination before the invoice and is a source of great inconvenience to the customer; the invoice tag envelope remedies this, as package and invoice reach them at the same time. Packages are sent to city customers with invoice inside, which causes a delay in shipping department waiting for invoice; by using the tag envelope (which costs about the same as a tag) the package is done up and invoice and tag ready to put on package at once, it saves marking the package, takes the place of a tag, and is perfectly safe.

In a thousand uses that this can be put to it is in every case a penny saved, and doing away with a great many annoyances;

156 in fact it answers all purposes of a common tag, and the double purpose of a tag and envelope combined.

Sent free to any address on receipt of price. Give plain printing directions.

No. 20 M, $3.00 per 1,000.
No. 25 M, $3.50 per 1,000.
No. 30 M, $4.00 per 1,000.
Printing, $1.00 per 1,000 extra.
Stringing, 0.50 per 1,000 extra.
Address all orders to sole manufacturers—

THE PULTZ & WALKLEY CO.,
Plantsville, Conn.

I have written my initials "G. E. T." at the top of the circular I have just read.

Defendant's counsel puts in evidence the circular just read and it is marked "Exhibit Pultz & Walkley Co's. Circular," J. A. S., ex.

Counsel for complainant objects to the exhibit as evidence as above.

Q. 21. What enables you to say that you printed this circular prior to November 1st, 1876?

A. The factory was burned up on the last Sunday night in October, 1876, and there are several fonts of type on this circular which have never been replaced in the new shop, at least three.

Cross-examination by complainant's counsel *de bene esse*, without waiving any objections previously taken:

X Q. 22. Will you point out and mark on this circular and price-list, the three kinds of type burned up as you say and not replaced?

A. The first line, "tag envelopes," for one. On the fifth
157 line, "new invoice, tag envelopes." Also the five lines making up the price-list.

X Q. 23. How long have you been in the employ of Pultz & Walkley Company?

A. Since July, 1870.

X Q. 24. When was the company organized?

A. July, 1870.

X Q. 25. Were you a stockholder in the company?

A. Never.

X Q. 26. What were your duties and position in the business in 1870?

A. Superintendent of the printing and had charge of all the printing.

X Q. 27. What are your duties and business at the present time?

A. Superintendent of the printing and the tag department.

X Q. 28. How soon after you commenced with the company did you have charge of the tag department?

A. I had charge of the tag department at the time the company was formed, but the business increased and I could not attend to it, and they put another man in charge of the tag department, that is in charge of the manufacturing of the tags; I continued to do the printing.

X Q. 29. When was this change made?

A. I cannot tell the date of that.

X Q. 30. Was it before the factory burnt down?

A. Yes, sir.

X Q. 31. How long before?

A. Probably two or three years.

X Q. 31½. What was the name of the man you say they put in your place?

A. Mr. Henry W. Atwood was put in charge of the manufacture at the time.

X Q. 32. Where is Henry W. Atwood?

A. He is in the city of Waterbury, Connecticut.

158 X Q. 33. In what business?

A. I don't know.

X Q. 34. How long did he remain in that position?

A. I should say till within three or four years past.

X Q. 34½. When did you resume the management of the tag department?

A. When Mr. Atwood severed his connection with the company—some three or four years ago.

X Q. 35. From 1870 down to 1875, was the business, manufacture, printing, &c., done in one building or in different buildings?

A. Done in one building.

X Q. 36. How has it been since that time?

A. In one building.

X Q. 37. Was Mr. Atwood one of the proprietors or an employee?

A. An employee.

X Q. 38. What constituted the business of this company at the time of its organization in 1870?

A. Manufacture of machine paper bags, flour sacks, seed bags, hand bags, tags, job printing, &c.

X Q. 39. Did this company publish and send out price-lists or circulars to their customers or the public?

A. They did.

X Q. 40. Where was the office of the company?

A. In the same building where the manufacturing is done.

X Q. 41. Did they have the manufactory or place of business at any other place than Plantsville?

A. No, no manufactory; they had a paper mill at Westfield, Mass.

X Q. 42. Did they manufacture all the paper they used at their establishment?

A. No.

X Q. 43. When did they first manufacture envelopes like Defendant's Exhibit Pultz & Walkley?

A. I can't give the date of their first manufacture.

X Q. 44. As nearly as you can give it?

159 A. I know they manufactured them in 1875.

X Q. 45. Did they use an ordinary envelope machine in the manufacture?

A. They used an ordinary envelope, they did not manufacture the envelopes themselves.

X Q. 46. Who did manufacture the envelopes which they used?

A. I know they purchased some of them of the Plympton Envelope Company, of Hartford, Connecticut.

X Q. 47. Do you know of purchasing envelopes of any other company or firm?

A. I can't give any other firm of purchasing of, but I think they did.

X Q. 48. When did they purchase envelopes of the Plympton Company out of which, as you say, they made tag envelopes?

A. I can give no date of invoices.

X Q. 49. Will the books of the Pultz & Walkley Company show when such purchases were made?

A. I think they will.

X Q. 50. What do the letters G. E. T. on the Exhibit Pultz & Walkley Tag Envelope mean?

A. They are my initials, they mean George E. Tucker.

X Q. 51. Did you put them there?

A. I did.

X Q. 52. When?

A. I put them something like a week ago when I furnished the envelope to the gentleman who called for it so as I should know it.

X Q. 53. Did you know the use to which the envelope was to be applied?

A. I did not till after I had put my initials upon it, when I was told what was wanted, that was the first I knew.

160 X Q. 54. Was that the first time you knew of the pendency of this suit for infringement?

A. It was.

X Q. 55. What did the gentleman say to you that induced you to furnish him this envelope and put your initials upon it?

A. He asked me, as far as I can remember, if I printed it and when.

X Q. 56. Did he have the envelope or did you?

A. He got the envelope in the office, the book-keeper gave it to him.

X Q. 57. Was you present when he gave it to him?

A. I was not.

X Q. 58. Then what you swore to, that the book-keeper gave it to him, is something not within your knowledge, is it not?

A. The book-keeper brought the envelope out to me before I had seen the gentleman and asked me if I knew anything about the printing of it.

X Q. 59. Did you then put your initials on it before handing it back to the book-keeper?

A. I did not, I went into the office with the book-keeper then.

X Q. 60. Do you know where the book-keeper got this envelope?

A. I know he got it out of some drawer in his desk.

X Q. 61. Was you present when he took it out of the drawer?

A. I was not that day, but I had seen it there with other papers at other times.

X Q. 62. Were your initials there when you had seen it at other times?

A. No, sir.

X Q. 63. Then how are you able to swear that you had seen this identical envelope which now has your initials upon it in the book-keeper's desk at another time?

A. For the reason that that was the only one in the office
161 with the style of letters shown in the words "invoice tag envelope."

X Q. 64. How long had you known of this being in the office?

A. I can't tell, I had seen it and looked at it as a curiosity.

X Q. 65. Did you ever hear any one say how this identical envelope happened to be "saved"?

A. I did not.

X Q. 66. Had you ever before that time had your attention drawn to the date when this envelope was printed?

A. I have made a statement to Mr. Wood, who was book-keeper, that that was some of my work in the old shop, or something to that effect.

X Q. 67. Who was the book-keeper at the time of the fire?

A. Edward A. Wood, who was the book-keeper 10 or 12 years.

X Q. 68. Who is now book-keeper for the company?

A. George Bond.

X Q. 69. Is Edward A. Wood in the employ of the company?

A. He is not.

X Q. 70. Where is he?

A. He is down at Southington.

X Q. 71. When was the first time as nearly as you can state, after the fire, that your attention was drawn to this envelope?

A. I can't say when; I can't give any time.

X Q. 72. Was it one month ago, or one year ago, or ten years ago; what is your best recollection as to the date?

A. I might have seen it two or three times within 4 or 5 years.

X Q. 73. I ask you when, as near as you can state, you saw it since the fire in 1875?

162 A. Well, I can't tell you.

X Q. 74. Was it ten years ago?

A. I kept no time when I had seen it, I had nothing to go by.

X Q. 75. Then you can't tell within 5 or 6 years when you first saw it since 1875?

A. I can't give any date.

X Q. 76. What was saved at the time of the fire?

A. The books and papers in the office were saved.

X Q. 77. Was the office furniture saved?

A. No desks or anything of that kind, the drawers were taken out of the desks, some of them and carried out.

X Q. 78. Was this tag envelope, as you call it, ever used for directing goods shipped or sent by express or otherwise, having enclosed therein the invoice of such goods?

A. I think that one never was used.

X Q. 79. Was this one ever made for you?

A. I think it was.

X Q 80. For what use?

A. As it says on there, invoice tag envelope.

X Q. 81. Was the printing which is on this envelope printed on the tag envelopes which were made and sold elsewhere?

A. This is simply an advertisement on this envelope for the Pultz & Walkley Company showing that we printed any one's business cards on these envelopes if they wanted it or we sold them plain without any printing.

X Q. 82. In other words, this is simply an advertisement sample of the style of the goods the company made but the printing consisting of Pultz & Walkley's advertisement on the front and back thereof was not on such tag envelopes as the company sold to others to use. Is this what you mean to be understood?

163 A. The envelope is the same as they use for every one, but the printing is different.

Adjourned till Friday, 10 a. m., 9th December, 1887.

NEW YORK, *December 9th*, 1887—10 a. m.

Met pursuant to adjournment.

Present: Counsel as before.

Cross-examination of GEORGE E. TUCKER continued:

X Q. 83. How many employees did Pultz & Walkley Company have in their employ?

A. I couldn't say positively as to numbers; probably from 25 to 35.

X Q. 84. Was all their printing done in their establishment?

A. I think it was, unless commercial printing such as letter-heads.

X Q. 85. Are you a practical printer?

A. I think I am.

X Q. 86. Don't you know?

A. I have worked at it for more than 20 years; probably I should not be considered a practical printer in New York.

X Q. 87. Did you set up the type on Pultz & Walkley tag envelopes?

A. I did.

X Q. 88. Have you a distinct recollection of doing so?

A. I have not.

X Q. 89. How then do you know that you set them up?

A. Because I was the only man in their employ who was setting type on that class of work or any other.

X Q. 90. Is that your only reason for knowing that you did the work?

164 A. I know I done all their printing and set all their type

Aswer objected to as irresponsive.

X Q. 91. (Question repeated.)

A. Yes.

X Q. 92. Is this type with which "invoice tag envelopes" is printed, an unusual form of type in the market?

A. I don't know that it is. I presume it can be bought in any of the type foundries.

X Q. 93. Would it not be possible to have the same matter which is printed on this envelope set up and printed on any other envelope in any well-appointed printing office with the same kind of type and in the same form?

A. It might be done, they might have to go out and borrow some type.

X Q. 94. Will you give me the name of the type used on each line on the front of that envelope?

A. I can't give the exact form of letters, I should say the first word "from" was a long primer type. The second line is a pica italic heavy face. The third line I should say was a long primer italics caps; the fourth line is a great primer type; the fifth line is what we call a brevier skeleton extended; the sixth line I should say was a two-line English ornamented; the seventh line was a pica antique.

X Q. 95. What is the name of the type used on the back?

A. I think the name of that font of type is No. 12 pica, in our fonts.

X Q. 96. How long did you continue to be the only person who set up type in that establishment?

A. They haven't employed any other man to set type since the company was organized.

X Q. 97. Can you produce any specimen of tag envelope made by your company in any of the years from 1876 to 1880 inclusive?

165

A. I don't know that I can produce any made in that time. I can produce some made since 1876.

X Q. 98. Did you ever sell any tag envelopes similar to Exhibit Pultz & Walkley Envelope?

A. I never sold any envelopes for Pultz & Walkley, or anything else.

X Q. 99. Have you any personal knowledge of the sales of such envelopes by your company previous to 1881?

A. I know they sold them, thousands of them, and manufactured them.

Answer objected to as irresponsive.

X Q. 100. Question repeated.

A. I know they manufactured and sold them previous to that date.

That part of the answer referring to manufacture objected to as irresponsive.

X Q. 101. To whom do you know of their making such sales?

A. From my own personal knowledge I don't know.

X Q. 102. How did you obtain your knowledge of such sales?

A. If I wanted to know what had been done or was doing, I should go into their office and examine their books, that would be conclusive to me of what they had done.

X Q. 103. Is that the way you obtained your knowledge?

A. That would be the way in a particular transaction with parties.

Answer objected to as irresponsive.

166 X Q. 104. Question repeated.

A. If I wanted to be accurate, that is the way I should do.

Answer objected to as irresponsive.

X Q. 105. Question repeated.

A. It is not the way I obtained my knowledge of what the company was doing or what I was doing.

X Q. 106. Is that the way you obtained your knowledge that the company sold tag envelopes like Exhibit "Pultz & Walkley Tag Envelope" between the years 1876 and 1880, inclusive?

A. Whenever there was an order received for printing on tag envelopes, bags, labels, etc., it was entered in an order book which was always kept in my room.

Answer objected to as irresponsive.

X Q. 107. I am not asking you anything in relation to printing or orders for printing. I am only enquiring concerning your personal knowledge of actual sales of the tag envelopes referred to. You have said you know of such sales and if you wanted to find anything about them, you should refer to the book. I now ask you if you obtained your knowledge of such sales by referring to the books?

A. That is the way I obtained my knowledge.

X Q. 108. The Exhibit Pultz & Walkley Tag Envelope has a metallic eyelet attached to it, marked "Patented August 6th, 1872;" do you know who was the owner of that patent?

A. Mr. Pultz and Mr. L. B. Walkley I always understood owned the patent.

X Q. 109. On what was the eyelet used besides envelopes?

A. On shipping tags.

X Q. 110. At how early a date was it so used?

167 A. I don't remember the exact date when it was first used. I know it was used after it was patented, and has been used ever since.

X Q. 111. Did your company ever manufacture tags for the Dennison Manufacturing Company?

A. Never, they were the only competitors in the market that we had, who amounted to anything.

X Q. 112. In what articles did they compete with your company?

A. Shipping tags.

X Q. 113. Have they not competed with you also on tag envelopes?

A. I didn't know that Dennison made any tag envelopes until recently; he might have done so.

X Q. 114. How recently did you learn that the Dennison Manufacturing Company was manufacturing tag envelopes?

A. I think it was last week that they spoke of it; I didn't know about it before this.

X Q. 115. Is Exhibit Pultz & Walkley Circular the only circular and price-list ever published by such company?

A. I think not.

X Q. 116. In what other form, if any, did they publish price-lists and circulars?

A. I don't know. They published different kinds.

X Q. 117. Did you set up the type, make up the forms and print such circulars and price-lists?

A. I set the type, made up the forms, locked them and put them in the press; the presses were usually run by a boy or girl.

X Q. 118. When was the circular and price-list Exhibit Pultz & Walkley Circular printed?

A. I don't know the date it was printed, but I do know that it was printed previous to November 1st, 1876.

X Q. 119. Why was it not dated?

168 A. I don't know unless it was that the copy was not dated. I set up from the copies that were brought me.

X Q. 120. Who furnished you with the copy?

A. Our copies were brought from the office. Mr. Walkley usually wrote them—I don't know who wrote that one.

X Q. 121. When did you first see that exhibit after it was printed?

A. I don't know that I ever saw it since it was first printed until last week. The book-keeper brought it to me then, and asked me if I knew anything about printing that circular.

X Q. 122. Then you had not seen this lying about the book-keeper's desk for six or eight years or more, prior to his bringing it to you, had you?

A. I have no remembrance of seeing the circular.

X Q. 123. Did the book-keeper tell you where he obtained it?

A. I think I asked the book-keeper where he got the circular, and he told me that he found it among some other papers in the office; that is my recollection about it.

X Q. 124. Did he tell you this before you told him what you knew about its being printed?

A. I think he did.

X Q. 125. Is there anything about this circular or the paper on which it is printed which would render it impossible that it might have been produced at any time since 1880, in any well-appointed printing office?

A. I think not. I think you could go out to-day and get it duplicated.

X Q. 126. When did you put your initials G. E. T. on this circular?

A. Last week.

X Q. 127. Have you any other means of identifying this

169 circular as having been printed by your company previous to December, 1875, except the fact which you have mentioned that it contains three kinds of type which was destroyed by the fire at that time, and have never been replaced since then in your office?

A. No other means except that I done all their printing.

X Q. 128. Are you willing to swear that this identical circular was not printed outside of your office?

A. I am willing to say that I don't believe it was.

X Q. 129. Who purchased the type for your office, to replace that which was destroyed in the fire?

A. It was purchased by the Pultz & Walkley Company.

X Q. 130. Do you know from whom the type was purchased?

A. It was purchased from New York, I think from Farmer, Little & Company. I don't know that it was all purchased from that firm. The wood type was purchased from Page & Company, of Greenwich, Connecticut, I think that was the name of the firm.

X Q. 131. Do you recollect any type being purchased from any other firm in New York, besides Farmer, Little & Company?

A. I don't think of any that I can call to mind.

X Q. 132. Was all your type purchased at one time, or was it purchased at different times?

A. There has been fonts purchased occasionally. The main part was purchased at one time.

X Q. 133. On Defendants' Exhibit "Transcript from P. & W. Co.'s Books," you have marked in red ink, "E. A. Wood's writing;" also "J. P. Pultz's writing." To what writing do these writings refer, the writing on this exhibit, or the writing in the book?

A. The writing on the company's books.

X Q. 134. Do you know what your company paid per thousand for envelopes like Exhibit Pultz & Walkley Tag Envelope, in or about 1875?

170 A. I do not.

X Q. 135. Do you know what such envelopes were worth at that time?

A. No.

X Q. 136. Do you know the number of this envelope as sold in the market?

A. I should say it was No. 30.

X Q. 137. Do you know the cost of the eyelets?

A. I do not.

X Q. 138. How were the eyelets put into the envelope, by hand or by machinery?

A. That slip of tag stock was cut the right width and slipped in, the hole was punched through the envelope with a small power press and the eyelet set by a foot press.

X Q. 139. Was this labor performed by men, boys, or girls?

A. Usually by girls.

X Q. 140. How many of these envelopes could be fitted with the eyelets, as you have stated, in a day?

A. A pretty quick girl would set from 5 to 8 thousand in a day of ten hours.

GEORGE E. TUCKER.

Sworn — before me—

JOHN A. SHIELDS, *Examiner.*

Defendant's counsel puts in evidence a duly certified copy from the files of the Patent Office of the file-wrapper and contents in the matter of the letters patent granted Joseph T. Dunham, May 8th, 1883, No. 277,245 for improvement in combined tag and envelope and the same is marked "Defendant's Exhibit File-wrapper, etc., Dunham's patent 277,245, J. A. S., ex'r."

Also similar certified copy in the matter of the reissued
171 letters patent granted Joseph T. Dunham, June 10th, 1884, No. 10488 for improvement in combined tag and envelope, and the same is marked "Defendant's Exhibit Dunham's Reissued Patent 10488, J. A. S., ex'r."

Also a similar certified copy in the matter of letters patent granted to Joseph T. Dunham Nov. 24th, 1885, No. 331,118 for improvement in envelopes and the same is marked "Defendant's Exhibit Dunham Patent 331,118, J. A. S., ex'r."

Defendant's counsel puts in evidence a Patent Office copy of letters patent to Sigmund Ullman, dated September 8th, 1868, No. 81,962 for improvement in envelopes, and the same is marked "Defendant's Exhibit Ullman (1868) Patent, J. A. S., examiner."

Also a Patent Office copy of letters patent to A. H. Schultz, dated September 23rd, 1879, No. 219,879, and the same is marked "Defendant's Exhibit Schultz (1879) Patent, J. A. S., examiner," and it is agreed that the said Ullman and Schultz exhibits may be used at the hearing with the same effect as if duly certified.

Counsel for defendant gives notice that at the hearing he shall refer as a part of the record to the affidavit of the complainant, Joseph T. Dunham, sworn to January 24th, 1887, and filed in the matter of the motion for a preliminary injunction; and that the same may appear in the printed record he produces the
172 copy of the said affidavit that was served upon the defendant, and asks that it be marked "Defendant's Exhibit Dunham's Affidavit, J. A. S., examiner," and it is so marked.

Defendant's counsel also puts in evidence, duly certified from the files of the Patent Office, a tracing of the drawing filed January 26th, 1885, in the matter of the above-named letters patent to Dunham, No. 331,118, and the same is marked "Defendant's Exhibit Tracing Drawing Patent 331,118, J. A. S., examiner."

It is agreed that the time for taking testimony be extended to December 31st, 1887.

Adjourned subject to notice.

173 DEFENDANT'S EXHIBIT FILE-WRAPPER, ETC., DUNHAM'S PATENT, 277,245. J. A. S., Ex'r.

JOSEPH T. DUNHAM
vs.
THE DENNISON MFG. CO.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the files of this office, of the file-wrapper and contents, in the matter of the letters patent granted Joseph T. Dunham, May 8th, 1883, number 277,245 for improvement in combined tag and envelope.

In testimony whereof I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office to be [SEAL.] affixed this 23rd day of February, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the United States the one hundred and eleventh.

M. V. MONTGOMERY,
Commissioner.

174 *Petition.*

To the Commissioner of Patents:

Your petitioner Joseph T. Dunham a citizen of the United States, at present residing in Brooklyn, county of Kings and State of New York prays that letters patent may be granted to him for the improvement in combined tag and envelope, set forth in the annexed specification, and he hereby appoints O. D. Munn and A. E. Beach, of the firm of Munn & Co., of the cities of New York and Washington, or their accredited agents, to act as his attorneys in prosecuting this application with full power of substitution and revocation to make alterations and amendments therein, to receive the patent and to transact all business in the Patent Office therewith connected.

JOSEPH T. DUNHAM.

To all whom it may concern:

Be it known that I, Joseph T. Dunham, of Brooklyn, Kings county, New York, have invented a new and improved combined tag and envelope, of which the following is a full, clear and exact description:

The object of my invention is to provide a new and improved combined tag and envelope which is adapted for attachment to packages and which is also adapted to receive the bills or the invoices, so that the consignees will receive the bill, or the invoice, with the goods.

Substitute P, Ap'l 9, '83.

[Matter enclosed between rules erased in original.]

A further object is to prevent the public from seeing the full and exact address of the consignee for the purpose of preventing dealers from becoming acquainted with the addresses of the competitor's customers.

The invention consists in an envelope provided at one end with flaps on the outer surface of which the address of the consignor and the information that the address of consignee can be found on the under surface of the flap is printed or otherwise produced, into which envelope the bill is placed, whereupon the envelope is secured to the box, barrel, package, etc., and the flap is held on the envelope.

Reference is to be had to the accompanying drawings forming part of this specification in which similar letters of reference indicate corresponding parts in all the figures.

Figure 1 is a longitudinal view of my improved combined tag and envelope, showing it opened.

Figure 2 is a longitudinal view of the same, showing it closed, and

Figure 3 is a longitudinal sectional elevation of the same on the line *x x*, Fig. 2.

An envelope A, preferably made, of strong water-proof paper is provided with an end flap B, of sufficient size to cover the entire envelope. An eyelet C, is secured in that end of the envelope opposite to the one to which the flap B, is attached, and the flap B, is provided on its free end with an eyelet D, which when the flap B, is folded over the envelope rests upon the eyelet C. The full address of the consignee is written on the inner surface of the flap B, as shown in Fig. 1. The name, business address, trade-mark, etc., of the consignor or shipper is printed or otherwise produced on the outer surface of the flap B, and the initials or mark, etc., of the consignee and the destination of the invoice are written, printed, or otherwise produced on the inner surface of the flap B, as shown in Fig. 2. The following or similar information is printed on the outer surface of the flap B, at the top or bottom or ends of the same. "Express or railroad companies can always find the full name and address of the consignee on the under side of this flap."

The combined tag and envelope are used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over the envelope A, and a cord, hook or other device for holding the tag to the box, barrel, package etc., is passed through the eyelets C D and is then secured to the package, etc. Whereby it will hold the flap closed over the envelope. Or the envelope can be tacked to the barrel, box, etc., and the free end of the flap is passed under a metal, rubber, or oil-cloth strip tacked transversely over that end of the envelope opposite to the one to which the flap is fastened whereby the flap will be held closed over the en-

[Matter enclosed between rules erased in copy.]

velope and in either case can easily be opened in case an employee of a railroad or express company wishes to read the address on the under side of the flap. By using the above-described combined tag and envelope, the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable, as it is desirable that the purchaser is informed in regard to the price of the merchandise as soon as possible, so that he can sell immediately. Furthermore the address is concealed and dealers cannot ascertain the addresses of the customers of their competitors at the same time the express and railroad companies can easily ascertain the addresses by raising the flap B. If desired the address, etc. shown in Fig. 3, can be printed or otherwise produced on the back of the envelope and the flap placed under the envelope in attaching the name.

Having thus described my invention, I claim as new and desire to secure by letters patent:

1st. A combined tag and envelope, made substantially as herein shown and described, and consisting of an envelope
Ap'l 5, '83. having at one end a flap of sufficient size to cover [one side of] the envelope as set forth.

177 2nd. In a combined tag and envelope, the combination with an envelope A, having a flap B, at one end of the eyelet D, in the free end of the flap, and the eyelet C, in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described, and for the purpose set forth.

3d. An envelope A, provided at one end with a flap B, on the outer surface of which flap, the address of the consignee is printed or otherwise produced, substantially as herein shown and described, and for the purpose set forth.

Erased Ap'l 5, '83. 4th. An envelope A, provided with a flap at one end on the outer surface of which flap, or envelope, the information is printed or otherwise produced, that the address of the consignee will be found on the under surface of the said flap, substantially as herein shown and described, and for the purpose set forth.

JOSEPH T. DUNHAM.

Witnesses:

OSCAR F. GUNZ.
C. SEDGWICK.

[Matter enclosed between rules erased in original.]

In the Matter of the Application for Letters Patent of JOSEPH T. DURHAM.

COUNTY OF NEW YORK, } ss:
State of New York, }

On this 11th day of January, 1883, before the subscriber a notary public in and for said county, personally appeared the above-named Joseph T. Dunham and made solemn oath that he is a citizen of the United States; that he verily believes himself to be the original and first inventor of the within-described combined
178 tag and envelope, that he does not know or believe that the same was ever before known or used, or has been in public use or on sale in the United States for more than two years prior to this application, and that the invention described and claimed in the annexed specification, has not been patented to him, nor to others, with his knowledge or consent, in any country.

JOSEPH T. DUNHAM.

CHAS. SEDGWICK,
[L. S.] *Notary Public, N. Y. Co.*

The United States Patent Office.

To all persons to whom these presents shall come, Greeting:

This is to certify that careful search has been made of the digest of this office, and no assignment, agreement, license, power of attorney, or other instrument of writing is found of record up to and including March 6, 1884, under or relating to letters patent granted Joseph T. Dunham, May 8, 1883, No. 277,245, "combined tag and envelope."

In testimony whereof, I, Benj. Butterworth, acting Commissioner of Patents, have caused the seal of the Patent Office to be
[L. S.] hereunto affixed this eleventh day of March, in the year of our Lord one thousand *one* hundred and eighty-four and of the Independence of the United States the one hundred and eighth.

BENJ. BUTTERWORTH,
Commissioner.

179 Room No. 95.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *March* 22, 1883.

Combined tag & envelope. Jan'y 15th, 1883. No. 82014.

Joseph T. Dunham, care Munn & Co., present:

The 1st clause of claim should be amended as indicated in pencil.

The 3d and 4th clauses of claim involving an address of consignor or consignee are untenable as it is shown that such form of

envelope and tag may be used in various ways so far as involving the matter of address, &c.

J. P. CHAPMAN, *Ex.*

Examiner's room 95.

Serial number, 82014.

To the Commissioner of Patents:

In the matter of the application for letters patent for combined tag and envelope, filed 15, 1, 1883, I hereby amend the specification as follows:

In the first clause of the claim, insert the words "one side of" after the words "to cover."

Also erase the third and fourth clauses of the claims, and adjust ordinals to correspond.

With above amendment, the case is respectfully submitted for further action.

JOSEPH T. DUNHAM,
Per MUNN & CO., *Attorneys.*

180 Room No. 95.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 7, 1883.

No. 82014. January 15, 1883.

Joseph T. Dunham, care Munn & Co., present:

The statement of invention should be modified to correspond with the clauses of claims, as now presented.

J. P. CHAPMAN, *Ex.*

Examiner's room 95.

Serial number, 82014.

To the Commissioner of Patents:

In the matter of the application for letters patent for combined tag and envelope filed 15, 1, 1883. I hereby amend the specification as follows:

Erase the object and statement of invention and substitute:

> "1. The object of the invention is to form an envelope with an end flap covering its side as hereinafter described."

With above amendments, the case is respectfully —, for further action.

J. T. DUNHAM,
Per MUNN & CO., *Attorneys.*

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Serial No., 82014.

DEPARTMENT OF THE INTERIOR,
U. S. PATENT OFFICE,
WASHINGTON, D. C., *Ap'l* 14, 1883.

Joseph T. Dunham, care Munn & Co., city.

SIR: Your application for a patent for an improvement in combined tag and envelope, filed January 15, 1883, has been examined and allowed.

The final fee, twenty dollars, must be paid, and the letters patent bear date as of a day not later than six months from the time of the present notice of allowance.

If the final fee is not paid within that period the patent will be withheld, and your only relief will be by a renewal of the application, with additional fees, under the provisions of section 4897, Revised Statutes. The office aims to deliver patents upon the day of their date, and on which their term begins to run; but to do this properly applicants will be expected to pay their final fees at least twenty days prior to the conclusion of the six months allowed them by law. The printing, photolithographing and engrossing of the several patent parts, preparatory to final signing and seating, will consume the intervening time, and such work will not be done until after payment of the necessary fees.

When you send the final fee you will also send, distinctly and plainly written, the name of the inventor and
182 title of invention as above given, date of allowance (which is the date of this circular), date of filing, and, if assigned, the names of the assignees.

If you desire to have the patent issue to assignees, an assignment containing a request to that effect, together with the fee for recording the same, must be filed in this office on or before the date of payment of final fee.

Additional copies of specifications and drawings will be charged for at the following rates: Single copies, uncertified, 25 cents; twenty copies or more, 10 cents each.

The money should accompany the order.

Very respectfully, E. M. MARBLE,
Commissioner of Patents.

Printed across the face: In remitting the final fee give the serial number at the head of this notice.

The within title is that given by the examiner in charge, as most appropriate to your invention. Should you desire a change in the same, satisfactory reasons must be given therefor on or before the payment of the final fee.

Serial No., 82014.
Ex'r's book No. 427–80.
1883.

Patent No. 277,245.
Joseph T. Dunham,
Of Brooklyn,
County of Kings,
State of New York.
Invention: Combined tags and envelope.

Parts of application filed.
Petition, January 15, 1883.
Affidavit, " " "
Specification, " " "
Drawing, " " "
Model, not required.
Specimen, ——.
First fee, cash, $15, January 15, 1883.
First fee cert., ——.
App. filed complete January 15, 1883.
Examined April 11, 1883. Chapman, ex.
Countersigned J. W. Babson,
183 April 14, 1883. For Commissioner.
Notice of allowance, April 14, 1883.
Final fee, cash, $20, April 19, 1883.
Final fee, cert., —— —, 188–.
Patented May 8, 1883.
Att'y or P. O. address, New York, Munn & Co., present.
Written across the face: Reissued June 10, 1884, No. 10488.

1883.
Contents.

Application papers.
1. 1 March 22, 1883.
2. Am'd't, Ap'l 5, '83.
3. 2 " 7, "
4. Am'd't 1, Ap'l 9, 83.
5.
6.
7.
8.
9.
10.
11.
12.
13.
14.
15.
16.
17.
18.
19.
20.

Title: Improvement is combined tag and envelope.
L. M. H. B. R.

Clasps and buckles, tags and tag-fasteners.

char
p184 DEFENDANT'S EXHIBIT FILE-WRAPPER, ETC., DUNHAM'S REISSUED PATENT, 10488. J. A. S., Ex'r.

JOSEPH T. DUNHAM
vs.
THE DENNISON MFG. CO.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the files of this office, of the file-wrapper and contents in the matter of the reissue letters patent granted Joseph T. Dunham, June 10th, 1884, number 10488, for improvement in combined tag and envelope.

In testimony whereof I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office to be affixed this 23rd day of February, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the United States the one hundred and —.

[L. S.]

M. V. MONTGOMERY,
Commissioner.

185 *Petition for Reissue.*

To the Commissioner of Patents:

Your petitioner, Joseph T. Dunham, a citizen of the United States, and a resident of Brooklyn, Kings county, New York, prays that he may be allowed to surrender the letters patent for an improvement in combined tags and envelopes, granted to him May 8, 1883, No. 277,245 whereof he is now the sole owner and that letters patent may be reissued to him for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

Signed at New York city, N. Y., this 14th day of March, 1884.

JOSEPH T. DUNHAM.

Specification.

To all whom it may concern:

Be it known that I, Joseph T. Dunham, of Brooklyn, Kings county, New York, have invented a new and improved combined tag and envelope, of which the following is a full clear and exact description.

My invention consists in a tag provided with means for attaching it to the merchandise, and with an envelope or pocket to receive a bill or invoice of the merchandise.

In order that my invention may be the better understood, reference may be had to the accompanying drawings forming part of this specification wherein I have shown my combined tag and envelope in its preferred form.

Figure 1 is a longitudinal view of my improved combi-
186 tag and envelope, showing it opened. Fig. 2 is a longitudinal view of the same showing it closed; and Fig. 3 is a longitudinal sectional elevation of the same, on the line 33, Fig. 2.

I will now describe my invention as shown in the drawings.

An envelope A, preferably made of strong water-proof paper, is provided with an end flap of sufficient size to substantially cover the side of the envelope. An eyelet hole C, is arranged in the end of the envelope opposite to that at which the flap B, is attached, and the flap B, is provided at its free end with an
May 13, '84. eyelet hole D, which coincides with eyelet hole C, when the flap is folded over on the envelope. The full address of the consignee *is* [may be] written on the inner face of flap B, as shown in Fig. 1. The name, business address, trade-mark, etc., of the consignor or shipper, *are* [may be] printed on the outer face of flap B, and the initials or marks, etc., of the consignee and the destination of the invoice, *are* [may be] written on the outer face of flap B, as shown in Fig. 2. The following or similar information *is* [may be] printed on the outer face of flap B, "express or railroad companies can always find the full name and address of the consignee on the under side of this flap."

The combined tag and envelope is used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over the envelope A and a cord, hook, or other device for holding the tag to the box, barrel, package, &c., is passed through the eyelets C D and is then secured to the package, &c., whereby it will hold the flap closed over the envelope; or the envelope can be tacked to the barrel, box &c., and the free end of the flap is passed under a metal rubber, or oil-cloth strip tacked over that end of the envelope opposite to the one to which the flap is fastened, whereby the flap will be held closed over the envelope, and in either case can easily be opened in case an employee of a railroad or express company wishes to read the address written on the under side of the flap.

187 By using the above-described combined tag and envelope, the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable, as it is desirable that the purchaser be informed in regard to the prices of the merchandise as soon as possible, so that he can sell immediately. Furthermore, the address is concealed, and dealers cannot ascertain the addresses of the customers of their competitors. At the same time the express and railway companies can easily ascertain the addresses by raising the flap B.

If desired, the address &c., shown in Fig. 3, can be printed, or otherwise produced on the back of the envelope, and the flap placed under the envelope, in attaching the name.

By the means for attaching the tag to the merchandise, I refer to the holes C, and D, through which the cord or hook is passed; these, as intimated, are reinforced by eyelets of some suitable material, the cord or hook, employed for securing the tag to the mer-

chandise, also serves, as shown, to close or secure the envelope, and prevent its contents from escaping in transit.

Having thus described my invention, I claim:

Erased May 13, '84.	A tag for marking merchandise provided with an envelope or pocket substantially as set forth.

1. A combined tag and envelope substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise, as set forth.

2. A combined tag and envelope, substantially as described, the flap having an eyelet hole, which, when the said flap is folded down on the envelope, coincides with an eyelet hole in the envelope, whereby the cord or hook for attaching the tag may be passed through both holes, substantially set forth.

188	Erased April 29, '84.	A combined tag and envelope made substantially as herein shown and described, and consisting of an envelope having at one end a flap of sufficient size to substantially cover one side of the envelope, as set forth.

3. "In a combined tag and envelope, the combination with an envelope A, having a flap, B, at one end, of the eyelet D in the free end of the flap, and the eyelet C in that end of the envelope opposite the one to which the flap is attached substantially as herein shown and described and for the purpose set forth."

In witness whereof I have hereunto signed my name in the presence of two subscribing witnesses.

JOSEPH T. DUNHAM.

Witnesses:
SAM. TRO. SMITH.
PHILIP A. BROWN.

Oath.

STATE OF NEW YORK, }
City and County of New York, } ss:

Joseph T. Dunham, the above-named petitioner, being duly sworn deposes and says, that he verily believes that his aforesaid letters patent are inoperative by reason of a defective and insufficient specification, and that the error arose by inadvertence, accident, or mistake without any fraudulent or deceptive intent; that
189 he is the sole owner of said letters patent; and that he verily believes himself to be the first and original inventor of the

[Matter enclosed between rules erased in original.]

improvement set forth and claimed in this amended specification, and does not believe that the same was ever before known or used.

JOSEPH T. DUNHAM.

Sworn to and subscribed before me, this 14th day of March, one thousand eight hundred and eighty-four.

J. HOMER HILDRETH,
[L. S.] *Notary Public, N. Y. Co.*

Statement

Accompanying the affidavit of Joseph T. Dunham for a reissue of his letters patent No. 277,245 of May 8, 1883, for "combined tag and envelope."

STATE OF NEW YORK, }
City and County of New York, } ss:

Joseph T. Dunham, being duly sworn, deposes and says, that he believes his letters patent for "combined tag and envelope" No. 277,245 of May 8, 1883, which he now seeks to reissue, is inoperative for the reason that the language of the specification, and the claims limit him to a combined tag and envelope comprising an envelope having a flap at one end of sufficient size to cover one side of the envelope, with the eyelets or holes by means of which it is attached to the goods at the ends of the envelope opposite that at which the flaps is attached and in the free end of the flap. That this language so restricts the scope of the said patent that any one may readily construct a combined tag and envelope that will
190 fulfil all the essential requirements by so constructing the flap that it will not cover the side of the envelope, and having the holes for attachment at some place other than at the end opposite that to which the flap is attached, and thus evade his patent and render it practically inoperative and worthless as a protection.

Deponent further says that he believes he was the first to construct a marking tag with means for attaching it to merchandise, and provided with a receptacle capable of being closed, and adapted to receive a bill or invoice of the goods to which the tag is attached, and that he is entitled to claim this broadly enough to cover such a device.

Deponent further says that in line 36 of the printed specification of his patent, the words "inner surface," should be "outer surface;" and that this is an error which he desires to correct, and which was inadvertently made, and has escaped his attention until now.

Deponent further says that the firm of Munn & Co., of New York city, were the solicitors who obtained his original patent for him and that one Oscar F. Gunz, who is in the employ of said Munn & Co., prepared his application.

Deponent further says that he is not familiar with the preparation of specifications and claims, never before having made application for a patent or had anything to do with one. That he de-

scribed to said Gunz the nature and purpose of his invention, stating it to be the preparation or construction of a tag to attach to packages of merchandise with an envelope pocket in which the bill or invoice of the contents of the package could be forwarded with the goods, that he also stated to him the advantages that might be derived from writing addresses on the inner side of the flap, covered from view, that he carried with him, and showed to said Gunz a sample the flap of which covered the side of the envelope, that he told said Gunz that he believed he was the said in-
191 ventor of a combined tag and envelope and requested him to apply for and obtain a broad claim for such invention. That said Gunz prepared the specification and claims and sent them to deponent.

That deponent did not know enough about specifications and claims to understand what they did or did not cover, that he asked Gunz, at the same time showing him the sample, whether some other party could not leave off part of the flaps, and in that way avoid his patent, that said Gunz informed him that the claims with the drawings and description of the sample would be broad enough to cover such a form, or any form, whether made to open or attach at either end or either side.

That deponent stated and pointed out to him, that he wanted the claims broad enough to cover the tag if the flap B were cut off short enough and the eyelets C and D were placed at the opposite end from that shown in the drawing, namely, at the open end of the envelope. And that said Gunz told applicant that said claim or claims were broad enough to fully cover the construction suggested or that he would make them broad enough.

Deponent further says that he believes there was a misunderstanding between said Gunz and deponent on this point and that it was from this misunderstanding that the mistake arose which renders his patent inoperative.

Deponent further says that he is not sufficiently skilled in construing patent claims to know with certainty whether the claims in his patent are as broad as he intended them to be, or not; and that he showed them to other parties for their opinion; and that relying on the statements made to him by Gunz, and the opinions of such other parties to the same purport, he supposed them to be broad enough, until he recently submitted the patent to an experienced patent lawyer who pointed out the defects to him.

192 Deponent further says that on being advised of such defects he immediately took steps to have his said patent reissued for the purpose of correcting such defects.

Deponent further says that such defects and errors in his letters patent arose without any fraudulent or deceptive intention on his part.

That he has expended several thousand dollars in introducing the article patented into the market and has as yet received little or no benefit therefrom, but that the sale is now becoming so large as to make protection desirable, and this application is made in

good faith to cover only what deponent supposed was covered by the original claims.

JOSEPH TUCKER DUNHAM.

Subscribed and sworn to before me this 7th day of March, 1884.

J. HOMER HILDRETH,
[L. S.] *Notary Public, N. Y. Co.*

No. 277,245.

THE UNITED STATES OF AMERICA:

To all to whom these presents shall come:

Whereas Joseph T. Dunham, of Brooklyn, has presented to the Commissioners of Patents a petition praying for the grant of letters patent for an alleged new and useful improvement in a combined tag and envelope, a description of which invention is contained in the specification, of which a copy is hereunto annexed
193 and made a part hereof, and has complied with the various requirements of law in such cases made and provided; and

Whereas, upon due examination made the said claimant is adjudged to be justly entitled to a patent under the law:

Now, therefore, these letters patent are to grant unto the said Joseph T. Dunham, his heirs or assigns, for the term of seventeen years from the eighth day of May, one thousand eight hundred and eighty-three, the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of
[L. S.] Washington, this eighth day of May, in the year of our Lord one thousand eight hundred and eighty-three, and of the Independence of the United States of America the one hundred and seventh.

M. L. JOSLYN,
Acting Secretary of the Interior.

Countersigned:
E. M. MARBLE,
Commissioner of Patents.

194 Examiner's Room No. —.

Applicant: Jos. T. Dunham. Invention: Combined tag and envelope. Reissue. Application No. —. Filed M'ch 15, 1884.

Power.

Hon. Com. of Patents.

SIR: In the matter of my application for the reissue of my letters patent for combined tag and envelope, No. 277,245, of May 8, 1883,

I hereby appoint Messrs. Burke, Fraser & Connett (said firm comprising Henry Connett and Arthur C. Fraser as its members), of New York city, N. Y., and Washington, D. C., my attorneys, with full powers of substitution and revocation, to prosecute this said application, to make all necessary alterations and amendments therein, to sign my name to the drawings, to receive the patent, and to transact all business in the Patent Office in connection with said application.

JOSEPH T. DUNHAM.

N. Y., M'ch 19, 1884.

Room No. 95.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 7, 1884.

Reissue. No. 124,722. March 18, 1884.

Joseph T. Dunham, care Burke, Fraser & Connett, present:

Attention is called to lines 19, 23 and 27, page 2, in which
195 "may be" is substituted for "is" or "are" thus furnishing an indefinite in place of a definite description. The same occurs on page 3, line 2. The original language should be restored.

The 1st and 4th claims are refused as untenable. It has long been common to employ an ordinary envelope for a tag to enclose a shipping bill. Also to receive the address of the consignee. Such envelope being secured to the outside of a box or package. Such common use renders the 1st claim unwarranted.

The 4th claim fails to present patentable novelty in view of the fact that it is common to provide envelopes with end flaps sufficiently large to substantially cover one side of the same. Such subject-matter is not of applicant's invention.

J. P. CHAPMAN.

Examiner's room No. 95.

Applicant: Jos. T. Dunham. Invention: Combined tag and envelope. Application No. 124,722. Filed March 18, 1884. (Reissue.)

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Erase claim 4.

Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., Apr. 28, '84.

196 Room No. 95.

Applicant: Jos. T. Dunham. Subject: Combined tag and envelope. (Reissue.) Application No. 124,722. Filed M'ch 18, 1884.

Argument.

To the Commissioner of Patents.

SIR: In the matter of the above-entitled application we desire to call attention to the following:

We herewith submit an amendment in which we have erased claim 4.

The words "may be" were substituted for "is" and "are" for the following reasons. In his original application applicant sought to claim the arrangement of the printed addresses, etc., as shown, and his claim was refused on the ground that such arrangements were matters of choice and taste and not patentable. Consequently as they form no material part of the invention and may be varied at will, the words employed seem to us much more appropriate than the more definite words they supplant. It seemed to us illogical to apply definite and limiting language to features that are not claimable, and subject to choice or fancy. If the original words are to be restored it seems to us that there must be some more cogent reason for it than that given.

We have retained the first claim for the reason that applicant desires a more definite reference. He claims to be well acquainted with the public use of marking tags, and that, so far as he is aware, the ordinary envelope containing shipping bill, etc., has never been used as a tag.

He believed, and now thinks, that he is the first to have provided a marking tag with a pocket to receive a bill or letter.

It may be that, incidentally, some person has tacked an en-
197 velope to a box in order to provide a surface on which to write the address, but not with any view of first enclosing a bill or letter in it.

Applicant would respectfully request a more definite reference, and if such is furnished he will cheerfully erase the claim.

Respectfully submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., Ap. 28, '84.

Room No. 95.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *May 1st*, 1884.

Reissue. No. 124,722. March 18th, 1884.

Joseph T. Dunham, care Burke, Fraser & Connett, present:

Upon further consideration of this matter in connection with amendment of the 30th inst., the 1st claim is again refused for

reasons stated in former letter. The employment of an envelope for the purpose stated, is a matter of personal knowledge to the examiner, and a matter within the experience of almost every shipper of goods in the country. The other criticisms are regarded as well made and are repeated.

J. P. CHAPMAN, *Ex.*

198 Examiner's room No. 95.

Applicant: Jos. T. Dunham. Invention: Tag & envelope. Reissue. Application No. 124,722. Filed M'ch 18th, 1884.

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Specification.

For "may be" read "is" in lines 19, 23 and 27 of page 2: and also in the 2nd line of page 3.

Claims.

Erase claim 1.
Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., May 12th, 1884.

Draftsman's division.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

DEPARTMENT OF THE INTERIOR,
U. S. PATENT OFFICE,
WASHINGTON, D. C., *May 14th*, 1884.

T. J. Dunham, care Burke, Fraser & Connett, city.

SIR: In the matter of your application for letters patent
199 for improvement in comb'd tag and envelope, filed M'ch 15, 1884, and passed by examiner, your drawings, as you were heretofore notified, do not comply with the rules of the office, a corrected drawing is requ'd before the case can issue. See rules, remove address.

If particularly desired the office will — proper — upon receipt of $—.

Very respectfully, BENJ. BUTTERWORTH,
Commissioner of Patents.

NOTE.—No drawing will be returned to the inventor or attorney after the case has passed for issue.

☞Return this circular with drawing or fee.

16—294

Issue division.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

DEPARTMENT OF THE INTERIOR,
U. S. PATENT OFFICE,
WASHINGTON, D. C., *May* 19, 1884.

Joseph T. Dunham, care Burke, Fraser & Connett, city.

SIR: Your application for reissue of patent No. 277,245, for improvement in combined tags and envelopes, has been examined and allowed.

200 The patent will be forwarded to you as soon as practicable, in due order of business.

Very respectfully, BENJ. BUTTERWORTH,
Commissioner of Patents.

Reissue.

Serial No., —.

Memorandum of Incomplete Application of J. T. Dunham.

Invention: Tags, &c.
Petition, ——.
Affidavit, ——.
Specification, ——.
Drawing, inf. P. A. & advertisement therein ret'd M'ch 17, '84, & old pat. &
Abst. of title req'd.
Fees, ——.

201 Serial No, 124,722. Ex'r Book No. 689–25.

1884. Chapman.

Reissue.

No. 10488.
Joseph T. Dunham,
Of Brooklyn,
County of Kings,
State of New York.
Invention—

Parts of application filed.

Combined tags and envelopes.			
Petition,	March	15,	1884.
Affidavit,	"	"	"
Specification,	"	"	"
Drawing,	"	18,	"
Old patent,	"	17,	"
Abstract of title,	"	"	"
Cert. deposit, ——.			
1. Cash, $30,	"	15,	"

2. App. filed complete March 18, '84.
No. and date of original patent, 277,245.

3. May 8th, 1883, ——.
Examined May 14, '84. Chapman, ex.
Countersigned: J. W. Babcon,
May 19, '84. For Commissioner
Notice of allowance, May 19, 1884.
Reissued June 10, 1884.
Att'y or P. O. address: Burke, Fraser & Connett, present.

202 Class ——.

1884.

Contents.

Application papers.

1.	Power att.,	Mar. 21, '84.
2.	1	Apr. 7, "
3.	Am'd't and arg'm't,	Ap'l 29, "
4.	1	May 1, "
5.	Am'd't,	May 13, "
6.		
7.		
8.		
9.	24. Clasps and buckles.	
10.	Tags and tag fasteners.	
11.		
12.		
13.		
14.		
15.		
16.		
17.		
18.		
19.		
20.		

Title: Improvement in combined tags and envelope.
Ex'd: G. W. and A. R.

203 DEFENDANT'S EXHIBIT FILE-WRAPPER, ETC., DUNHAM PATENT, 331,118. J. A. S., Ex'r.

JOSEPH T. DUNHAM
vs.
THE DENNISON MFG. CO.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the files of this office, of the file-wrapper and contents, in the matter of the letters patent granted Joseph T. Dunham, November 24th, 1885, Number 331,118. For improvement in envelopes.

In testimony whereof, I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office to be [L. S.] affixed this 23rd day of February, in the year of our Lord, one thousand eight hundred and eighty-seven, and of the Independence of the United States, the one hundred and eleventh.

M. V. MONTGOMERY,
Commissioner.

204 *Petition.*

With power of attorney.

To the Commissioner of Patents:

Your petitioner, Joseph T. Dunham, a citizen of the United States residing in Brooklyn, Kings county, New York, prays that letters patent of the United States be granted to him for the improvements in envelopes set forth in the annexed specification.

And he hereby appoints Burke, Fraser & Connett, (the said firm comprising Henry Connett and Arthur C. Fraser as its members,) of the city, county and State of New York, and of the city of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign his name to the drawings, to receive the letters patent when issued, and to transact all business in the Patent Office connected therewith.

Signed at New York, this 22nd day of January, 1885.

JOSEPH T. DUNHAM.

Specification.

To all whom it may concern:

Be it known that I, Joseph T. Dunham, a citizen of the United States, and a resident of Brooklyn, Kings county, New York, have invented certain improvements in envelopes, of which the following is a specification.

205 My invention relates to an envelope, designed primarily for use as an envelope for mailing samples, and other like matter, and for use as a tag for marking goods to be shipped.

An envelope for mailing samples must, in order to be subject only to postage rates as third-class matter, be left unsealed; and it has been customary to provide envelopes of this character with a sealing flap at one end, and a flap secured by a string or paper-fastener at the other end. But in order to get at the contents of the envelope for examination it has been necessary to untie the string, or remove the fastener, both of which must be carefully replaced. My invention obviates these difficulties by rendering the removal of the fastenings unnecessary by reason of the peculiar construction of the envelope.

In a former patent of mine reissued June 10, 1884, and numbered 10488, I showed an envelope combined with a tag for marking merchandise. The object of this combination is to enable the shipper to enclose in the envelope tag a bill of the merchandise; and in order to avoid conflict with the postal laws this envelope is left unsealed, or at least only partially sealed. Moreover it is not desirable to rely upon sealing a tag envelope of this character, as it is liable to get wet and this will often unseal it and allow the bill or invoice to escape. My present invention is designed to so secure the flaps that dampness, or even wetting, will not affect their fastenings.

Cancelled Oct. 10, 1885.

Where eyelets have been employed heretofore for envelopes, they have generally been used to secure the flaps in place, and have extended through and through the envelope. I herein employ them mainly to reinforce the holes, and may employ the ordinary metal eyelet, or a reinforce of tough paper, such for example, as that on ordinary marking tags.

In the drawings which serve to illustrate my invention:

206 Figure 1 is a back view of my improved envelope as I prefer to make it for use as a mailing envelope for samples.

Figure 2 is a longitudinal midsection of same, but showing the flaps folded down.

Figure 3 is a similar section to figure 2, showing the top flap secured by a paper-fastener and the envelopes partly opened for examining the contents.

Figure 4 is a view similar to figure 3, but showing a string employed for securing the top flap in lieu of a paper-fastener.

Fig. 5 shows metallic eyelets in lieu of the disk or washer reinforcing eyelets shown in the previous figures.

Fig. 6 shows my improved envelope as I prefer to construct it for use as a tag and envelope, the bottom flap in this case being secured by a metallic eyelet.

Fig. 7 shows the flaps constructed alike, provided with reinforcing washers on the face of the envelope, and metal eyelets in the flaps. The bottom is designed to be secured by a paper-fastener, and the top flap by a string or wire that secures the envelope tag to the parcel.

Cancelled July 3, '85.

Referring to Figs. 1, 2 and 3, A is the body of an envelope, of any desired size and proportions, and made from any suitable material, but usually of some tough kind of paper. This body has two "plies" or thicknesses, one forming the front, *a*, and the other the back, *b*. In Fig. 1, a triangular portion of the front *a*, is seen

[Matter enclosed between rules erased in original.]

at each end of the back *b*. B is what I call the "bottom flap," and C is what I call the "top flap."

In closing the envelope, these flaps are folded on the dotted lines *x x* as will be well understood.

The bottom flap B, is, or may be, provided with a coat of gum, *y*, to make it "self-sealing."

The front *a*, of the envelope has a hole *c*, punched in it quite close to the end of the back *b*, as seen at the left in Fig. 1,
207 and this hole is reinforced by a washer *d*, gummed to the face of the envelope. The flap C, has also a hole c^1, punched in it in a position to register with the hole *c*, when the flap C, is folded down, (as in Fig. 2,) and this hole is reinforced by a washer d^1.

The envelope may be furnished to the trade with the flap C, turned down and secured by a paper-fastener *e*, as in Fig. 3, or any other suitable fastening. The flap B, is left unsealed, and the user inserts the material to be mailed at the bottom and seals down flap B, in order to close the filling aperture.

The flap *c*, and the washer *d*, d^1, overlap the end of the back *b*, and thus secure this end of the envelope from being accidentally opened and the contents lost; but the examining official at the post office may, with very little trouble, open the envelope at this end by bending back the flap C, and the washer thereon, far enough to enable him to draw out the end of back *b*, (as in Fig. 3,) and thus gain access to the interior. After examination the parts may be returned to their normal position.

Fig. 5, shows metal eyelets as substitutes for the washers *d*, d^1. Where these are used I usually make the flap C, longer, so as to lap over further on the envelope back *b*, as these eyelets do not provide such an extent of clamping surface as the washers. The washers *d*, d^1, are usually made from thick, tough paper, and cemented to the envelope with a water-proof cement. These may be replaced by metallic washers secured by clinched clips.

Where the flap C is secured by a readily applied fastening, the bottom flap B, might be sealed down in the manufacture, thus leaving the other end open for the insertion of the matter to be mailed, the flap C to be secured by the user after filling the envelope.

The flap C might be conveniently secured by a string e^1
208 as indicated in Fig. 4; and where the envelope is to be used as a tag for marking goods to be shipped, this string may serve to attach the envelope tag to the goods.

I may sometimes gum the flap C to the exposed portion of the inner face of the front *a*, but this I do not consider necessary; and I may also, where the envelope is to be used as a tag, and is liable to rough usage in handling, gum the corners of flap C lightly to the back, *b*, to prevent its being too easily bent back; but this sealing, if used, should be of such a character as to be readily broken by the insertion of the finger under flap C.

In Fig. 6 I show the envelope as I prefer to construct it for use as a tag. In this construction the bottom flap B is permanently secured by an eyelet *f* that passes through, and is clinched. This is

better than sealing with the ordinary gum, as the flap will not be freed by dampness. The bill or invoice is to be inserted at the other end, and the flap C secured by the string or wire, whereby the tag is attached to the goods.

Erase & insert C, July 31, 1885.

Fig. 7 shows both ends of the envelope constructed alike and provided only with reinforced holes-metal eyelets d^1 d^1 are used in the flaps B and C, and the flap, reinforce washers, *d d*, on the face *a*. A paper fastener *f* is used to fasten the bottom flap, and a string or wire *e* to fasten the flap C. Insert A, May 29, 1885.

Having thus described my invention, I do not claim the use of the washers *d* broadly, as these have long been used on tags; nor do I claim the fastening together of envelopes by means of clinched eyelets in lieu of gum, as this is not new. As I have before stated, mailing envelopes have been used having one flap tied or fastened down in some similar way, and the other flap sealed, but in these the fastening device must be removed to get at the contents. In my former patent, also, I showed a combined tag and envelope, and this I make no claim to herein:

209 But what I claim as new is:

1. An envelope having a flap *c* provided with a reinforced hole c_1, and having a similar hole *c* in the front ply of its body and the said holes constructed to register or coincide when the flap is folded down whereby the end of the back ply *b* of the envelope body [which extends entirely across the latter] is clamped and [removably] secured, substantially as shown and described.

May 29, 1885. July 31, 1885.

Erase & insert D, July 31, 1885.

An envelope having a flap C provided with a reinforced hole c^1, and having a similar hole C in the front ply of its body, the said hole constructed to register or coincide when the flap C is folded down, substantially as described, and the envelope having also a] [bottom flap B, left unsealed in the process of manufacture, all substantially as and for the purposes set forth.

2. A mailing and tag envelope, having a flap C, folded over on and secured down to the inner face of the front ply of the body, and said flap being also constructed to take over the free end of the back ply of the body, as shown, whereby the mouth of the envelope covered by said flap C is secured against accidental opening, substantially as and for the purposes set forth.

Insert B, May 26, 1885.

[Matter enclosed between rules erased in original.]

In witness whereof I have hereunto signed my name in the presence of two subscribing witnesses.

JOSEPH T. DUNHAM.

Witnesses:
HENRY CONNETT.
ARTHUR C. FRASER.

210 *Oath.*

STATE OF NEW YORK, }
County of New York, } ss:

Joseph T. Dunham, the above-named petitioner, a citizen of the United States and resident of Brooklyn, Kings county, New York, being duly sworn deposes and says, that he verily believes himself to be the original, first and sole inventor of the improvements in

Envelopes

described and claimed in the foregoing specification, that he does not know and does not believe that the same was ever known or used before his invention thereof; that to the best of his knowledge and belief the same has not been in public use or on sale in the United States for more than nineteen months, prior to this date; and that no patent on said invention has been granted to him or to any other person or persons with his knowledge or consent in any country.

JOSEPH T. DUNHAM.

Sworn to and subscribed before me this 22nd day of January, 1885.

[L. S.] ARTHUR C. FRASER,
Notary Public, Kings County, N. Y.

Certificate filed in New York Co.

211 DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *May* 22, 1885.

Mailed May 22, 1885.

"Envelopes." Filed Jan. 26, 1885. No. 153,971.

Joseph T. Dunham, care Burke, Fraser & Connett, Washington, D. C.:

This application has been examined.

The description of figure 7 is imperfect in that in that figure the "string or wire" is shown as passing not only through the face and flaps of the envelope, but also through the back.

Claim 2 is substantially anticipated in English patent 1771 of 1864, envelopes.

In view of English patent above cited, the word "removably" should be inserted after "is," line 9, claim 1.

Claim 2 is rejected.

L. M. E. COOKE, *Examiner.*

D. B. NEWTON.

Examiner's room No. 25.

Applicant: Jos. T. Dunham. Invention: Envelopes. Application No. 153,971. Filed Jan. 26, 1885.

Argument.

To the Commissioner of Patents.

SIR: In the matter of the above-entitled application, we desire to call attention to the following:

We herewith submit an amendment setting forth the distinction between the Eng. pat. No. 1771, '64, and the construction of applicant. We have also amended claims 1 and 2.

212 The reference is merely a marking tag and is not in any proper sense a protecting envelope. In this tag the sides and ends are merely folded over, but the flaps at the sides do not meet to form a back ply corresponding to applicant's back ply *b*. This is what is lacking to constitute an envelope, and any card or paper that may be secured under the side folds would not only be exposed to the weather, but could be removed without the necessity of untying the string or removing the flaps from under the end flap.

We think, as amended, the claims are tenable.

Very resp'y, BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., May 28, 1885.

Examiner's room No. 25.

Applicant: Jos. T. Dunham. Invention: Envelopes. Application No. 153,971. Filed Jan. 26, 1885.

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Page 9, line 12, next after "flap C" insert:

* * * which string or wire passes through the flap and both plies of the envelope.

A. Cancelled July 3, '85.

It will be observed that in my construction the two flaps forming the back *b*, are overlapped and gummed together so that, when the end flaps are closed down a complete envelope is formed, as distinguished

213 from that class of marking tags which have merely flaps at the sides as well as at the ends, these side flaps not meeting to form an envelope properly so called.

[Matter enclosed between rules erased in original.]

Claim 1, line 9, next after "body," insert:

B cancelled for amend't D July 31, 1885.

[* * * which extends entirely across the latter.]*

Claim 2, line 9, next after "also *a*," insert:

[* * * back ply, *b*, that extends entirely across the latter and *a*.]*

Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., May 28, 1885.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *June* 27, 1885.

Mailed June 29, 1885.

"Envelopes." Filed Jan. 26, 1885. No. 153,971.

Joseph T. Dunham, care Burke, Fraser & Connett, Washington, D. C.:

This application, as amended, has been examined.

Claims 1 and 2 are anticipated in patent 81962, S. Ullman, Sept. 8, 1868, envelopes, and are therefore rejected.

L. M. E. COOKE, *Examiner.*

D. B. N.

214 Examiner's room No. 25.

Applicant: Jos. T. Dunham. Invention: Envelope. Application No. 153,971. Filed Jan. 26, 1885.

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Drawings.

Erase Fig. 7.

Specification.

Page 4, erase the paragraph on lines 13 to 21, inclusive.

Page 9, erase the paragraph on lines 3 to 12, inclusive and substitute.

It will be observed that in my construction the two flaps forming the back *b*, are overlapped and gummed together so that when the end flaps are closed down a complete envelope is formed, as distinguished from that class of marking tags which have

[* Matter enclosed in brackets erased in original.]
[Matter enclosed between rules erased in original.]

merely narrow flaps at the sides as well as at the ends, these side flaps not meeting to form an envelope properly so called.

It will be observed also that the means I employ for reinforcing the holes whether metallic eyelets, or tough washers, are entirely independent of the fastening device at the mouth of the envelope, and they may also be independent of the fastening device at the bottom of the envelope when the latter is designed to be used as a tag, as in Fig. 6. I am aware that the flaps of an envelope have been secured to the body by an ordinary clinched eyelet which passes through all the plies, and that the eyelets for making the fastening, have been attached to the flap so as to be sold with it ready for use. This I do not claim.

C. Cancelled Oct. 10, 1885.

215 Erase the amendatory clause inserted on page 9, line 12, per amendment, dated May 28th, 1885.

Claims.

Claim 1, line 9; between "and" and "secured" insert; removably.

Erase claim 2, and substitute

An envelope having a closing flap C, provided with a hole *c*, that registers, when the flap is folded down with a hole *c*, in the front ply *a*, the body of the envelope, and said holes provided each with a reinforce, substantially as shown, which is entirely independent of the means for fastening the flap *c* in place, when folded down, substantially as set forth.

D. Cancelled Sept. 7, 1885.

Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., July 30, 1885.

Examiner's room No. 25.

Applicant: Jos. T. Dunham. Invention: Envelope. Application No. 153,971. Filed Jan. 26, 1885.

Argument.

To the Commissioner of Patents.

SIR: In the matter of the above-entitled application, we desire to call attention to the following:

We herewith submit an amendment.

[Matter enclosed between rules erased in original.]

Claim 1, has been amended to include the word "removably," which certainly removes it from the sphere of the reference. We think applicant is fully entitled to this claim as now presented.

We have substituted a new claim 2, laid to the rein-
216 forcing of the holes independently of the fastening device.

Fig. 7 was originally designed to illustrate this feature of the invention as applied to any envelope of this general character, but as it seemed to mislead we have erased the figure. We still think applicant should be permitted to retain this figure, or to reinstate it, and if deemed by the examiner consistent with the case as a hole, in view of the present claim 2, we will reinstate it.

The reference Ullman merely shows what applicant clearly disclaims, namely, an envelope in which the flaps are secured by an ordinary eyelet or hollow rivet which passes through all the plies and is clinched at both ends like any other eyelet. There is no reinforcing of the holes independently of the fastening device, and the fastening device is of such a character that, practically, the envelope must be cut or torn to open it.

Applicant's invention has two features of novelty or supposed novelty. First, the construction whereby the back ply, *b*, is removably secured by flap C. Second, the reinforcing of the holes in the flap and ply by reinforcing devices *d* d^1 which are wholly independent of the fastening device, which may be a string, a wire, or a paper-pastener.

An early reconsideration is requested.

Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y., July 30, 1885.

217 DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *August* 31, 1885.

Mailed Sep. 2, 1885.

"Envelope." Filed Jan. 26, 1885. No. 153,971.

Joseph T. Dunham, care Burke, Frazer & Connett, Washington, D. C.:

This application, as amended, has been examined.

Claim 2, is substantially anticipated in reissue patent 10488. J. T. Dunham, June 10, 1884, tags, tag-fasteners, and is therefore rejected.

L. M. E. COOKE, *Examiner.*

D. B. N.

THE DENNISON MANUFACTURING CO.

Examiner's room No. 215.

Applicant: Joseph T. Dunham. Invention: Envelopes. Application No. 153,971. Filed January 26, 1885.

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Erase the second claim.

Respectfully, BURKE, FRASER & CONNETT,
Attorneys for Jos. T. Dunham.

New York, September 5, 1885.

218 DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *October* 5, 1885.

Mailed October 7, 1885.

"Envelopes." Filed January 26.

Jos. T. Dunham, care Burke, Fraser & Connett, Washington, D. C.:

This application, as amended, has been examined.

The matter from line 10 page 2 to line 13, page 3 and matter inserted on page 9, in place of lines 3–12 must be erased because it has no patentable relation to the invention.

L. M. E. COOKE, *Examiner.*

D. B. N.

Examiner's room No. 215.

Applicant: Jos. T. Dunham. Invention: Envelopes. Application No. 153,971. Filed Jan. 26, 1885.

Amendment.

To the Commissioner of Patents.

SIR: We hereby amend the above-entitled application as follows:

Page 2: Erase the last 19 lines on this page and the first 13 lines on page 3.

Erase the amendatory clause inserted on page 9 lines 3–12 by amendment dated July 30, 1885.

Resp'y submitted.

BURKE, FRASER & CONNETT,
Att'ys for Dunham.

N. Y.

219 Oct. 9, 1885.

Memorandum of fee paid at U. S. Patent Office.

Serial No., 153,971, 1885.

Inventor: Joseph T. Dunham.

Patent to be issued to as per record.
Name of invention, as allowed: Envelopes.
Date of payment Nov., 1885.
Fee twenty dollars.
Solicitor-, Burke, Fraser & Connett.
Date of filing, January 26, 1885.
Date of circular of allowance, October 30, 1885.
Send patent to Burke, Fraser & Connett, solicitors of Patents, 121–122 Temple court, New York.

Serial No., 153,971. Ex'r Book No. 110–62.

1885. Cooke.

Patent No. 334,118.

Joseph T. Dunham,
Of Brooklyn,
County of Kings,
State of New York.
Invention: Envelopes.

Part- of application filed.
Petition, Jan. 26, 1885.
Affidavit, " "
Specification, " "
Drawing, " "
Model, not required.
Specimen, " "
First fee, cash, $15, Jan. 26, 1885.
1. " " cert., ——.
App. filed complete, Jan. 26, '85.
2. Examined Oct. 27, 1885. W. W. Townsend, assistant in charge.
Countersigned: J. W. Babson,
Oct. 29, '83. For Commissioner.
220 Notice of allowance, Oct. 30, 1885.
Final fee, cash, $20, No. 5, 1885.
Final fee cert., —— —, 188–.
2. Patented Nov. 24, 1885.
Att'y or P. O. address, Burke, Fraser & Connett, present.

1885.

Contents.

1. Application, 1 paper.
1. May 22, 1885, rejection.
2. May 29, 1885, amend't- A, B.
3. June 27, 1885, rejection.
4. July 31, 1885, amend't- C, D.
5. " " " argument.
6. Aug. 31, 1885, rejection.
7. Sept. 7, 1885, amend't.
8. Oct. 5, 1885, letter.
9. Oct. 10, 1885, amend't.

10.
11.
12.
13. 93. Paper manufactures.
14. Envelopes.
15.
16.
17.
18.
19.
20.

Title: Improvement in envelopes.
M. F. M., ex. L. L.

221 DEFENDANT'S EXHIBIT DUNHAM AFFIDAVIT. J. A. S., Ex'r.

United States Circuit Court, Southern District of New York.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

STATE OF NEW YORK,
Southern District of New York, City and County of New York, } ss:

Joseph T. Dunham, being duly sworn, says that he is the complainant in the above-entitled cause, and the inventor and patentee named in letters patent No. 277,245 and 331,118, and reissued letters patent No. 10488; that previous to the year 1883, he was engaged in the wholesale fish business in the city of New York, and in such business had occasion to ship packages and invoices of fish to various parts of New York and adjoining cities, and also to distant cities and towns throughout the country. That such packages were usually sent in barrels or boxes and marked by a tag in the shape of a card which was affixed to the package by means of a string or by means of tacks driven through the card into the surface of the barrel or box. That when the package was shipped, it was the
222 practice of deponent's firm to enclose in an envelope the letter announcing the shipment, and also an invoice of the goods sent. That most of the goods were shipped by express, and frequently arrived at their destination before the mail which carried the invoice, which was often a great source of annoyance, and sometimes of damage to both shipper and receiver, particularly in regard to fish and all perishable goods—consigned goods in such cases having to be held until the arrival of the invoice to enable the receiver to know the current prices.

In consequence of this inconvenience, deponent, previous to 1880, conceived the idea of an envelope tag to contain the invoice, and after turning it over in his mind for a year or two commenced experimenting on the subject, continuing his experiments until he decided on what he considered the most desirable form in which to construct a combined tag and envelope that would meet the want

felt by shippers. Many of these experimental devices have been preserved, and the exhibits hereto annexed marked respectively, Exhibits E, F^1, F^2, F^3, F^4, F^5, F^6, F^7 and F^8 are specimens of such preserved experimental devices, and were all designed and constructed by deponent previous to his application for a patent on January 15th, 1883.

Deponent further says that his first application for a patent as such invention was made on the 15th day of January, 1883, and that previous to that time he had never seen or heard of such a thing as a combined tag and envelope, or any device of a similar character, and that, as far as he knows and believes, it was the universal practice to mark packages, on the packages themselves, or on a simple card or tag such as were made and sold by defendant and affixed thereto, and to send the bill or invoice by mail in an ordinary sealed and stamped envelope.

223 Deponent further says that his letters patent No. 277,245 were issued May 8th, 1883, and that deponent having had no previous experience in patents, and having shown his solicitor's assistant various models, including those with short flaps like Exhibits F^7 and F^8, and told him to cover everything, and being informed, as he understood it, that the long flap covered everything, supposed that the letters patent No. 277,245, covered his invention as it had been made by him, and described to his solicitor's assistant, viz: the device described and named in his specification and claims, as a "combined tag and envelope" as well as the improvements he had made in envelopes in different forms, as illustrated by the above-named Experimental Exhibits F^7 and F^8. That deponent was subsequently informed by his solicitor's assistant, that he did not understand deponent to say he desired to cover anything but the long-flap envelope, or to secure the invention shown in the above-named Experimental Exhibits F^7 and F^8.

Deponent further says that immediately on the allowance of his said letters patent, he commenced to manufacture the combined tag and envelope, preparatory to putting it on the market, as will appear by Exhibit L 29 hereto annexed, which is a bill for the knife with which the combined tags and envelopes were cut out. That immediately after the issuing of said letters patent, deponent commenced to put them on the market, and used the utmost diligence possible with the means at his command, and expended much labor, and was at great expense and trouble, in establishing agencies and making sales throughout the United States, from Maine to Oregon, Texas and California, as will appear by Exhibits L, L 1, L 3, L 4, *l*, L 5, L 6, *l* 1, L 21, L 22, L 23. L 30, L 31; these being a few of the thousands of vouchers in the hands of deponent showing the early history of the growth of his business in combination tags and envelopes: the letter, L^4, also showing some of the obstacles in the way, and the desire to evade the patent on the part of some shippers.

224 L 5 is the poster used by one of my agents in New Hampshire; and L 6 an advertisement inserted in 20 newspapers in 1883. See Exhibit L 6½. Deponent further says that at the time when he introduced the combined tag and envelope into the

market, the defendant corporation was in existence, carrying on an extensive business in the manufacture of tags, and aiming to monopolize that class of business; that it had been organized under the laws of Massachusetts in 1878, and had extensive branches in New York, Philadelphia, Chicago, Cincinnati and St. Louis; that it manufactured and sold shipping tags, and advertised them extensively throughout the United States, making the word "tags" the most prominent feature of their advertisements; but, as deponent is informed and believes, had never made, sold or advertised anything like a combined "tag and envelope," or an envelope designed to be used for carrying an invoice with means of attachment to a package of goods, until after deponent's patented device was put upon the market.

Deponent has procured and attaches hereto, an advertisement of the defendant corporation, published in the Providence directory for 1883, marked Exhibit L 32, also a similar one from the Indiana State Gazetteer, published in and for 1882 and 1883, marked Exhibit L 33, also a similar one from the Philadelphia directory for 1882, marked Exhibit L 34, also a similar one from the Boston directory for 1885, marked Exhibit L 35, and deponent further says that he has made diligent search in advertisements of the defendant corporation during the years 1882 and 1883, and has been unable to find any allusion to a combined tag and envelope, or a "tag envelope" or anything in any way resembling the patented device of deponent, in any advertisement previous to the time when deponent's device was first put upon the market.

Deponent further says that when his combined tag and en-
225 velope was first put upon the market it met with general favor wherever it was introduced, particularly among shippers of perishable articles, and was recognized at once as a new and valuable improvement, and met with a ready sale at remunerative prices, his first sales being in New York and Eastern cities, selling in Boston, on his first introduction of them, 20,000 or 30,000 in one day. That deponent's patents and his rights thereunder were generally acquiesced in by the trade and by the public, and deponent was induced by the growing demand and brilliant prospects to give up his business as a wholesale fish dealer, and devote his time and attention to manufacturing the "combined tag and envelope," and supplying the public therewith, which he did.

Deponent further says that soon after he put the article into the market, he ascertained that defendant was manufacturing and selling a combined tag and envelope, substantially like the one described and shown in complainant's letters patent.

Deponent further says that Exhibit G hereto attached is one of such combined tag and envelope brought to the notice of deponent in the latter part of the summer or in the fall of 1883, and is the first one of which he had knowledge.

Deponent further says that as the only difference between the article Exhibit G and deponent's patented device is that defendant has shortened one of the flaps, and made the attaching eyelet at the other end to co-operate with the shortened flaps, and accomplish

the same purpose, and as the very form used by defendant was one of the forms invented by deponent, but not shown in his patent, because he supposed and was informed by his solicitor, that one covered the other, deponent considered it a direct infringement of his patent, and consulted counsel in relation to it, and was advised by his counsel, as the letters patent were new, and did not cover all his invention clearly, to surrender his patent, and obtain a reissue.

226 That deponent did so surrender letters patent No. 277,245, and on the 10th day of June, 1884, obtain reissued letters patent, No. 10488; but on account of the narrowness of the specification and drawings, such reissue could not be made to include all of deponent's invention; whereupon by advice of counsel he made a new application, and on the 24th of November, 1885, obtained letters patent No. 331,118, covering the improvement in mailing and shipping envelopes shown in Experimental Exhibits F^1, F^2, F^6 and F^7, and in Exhibit F^9 made under said last-mentioned letters patent.

Deponent further says that after the issue of his said letters patent No. 331,118 he ascertained that the defendant was manufacturing and selling large quantities of tag envelopes and combined tags and envelopes, like or substantially like those covered by deponent's letters patent reissue No. 10488 and No. 331,118.

Deponent further says that after the issuing of reissued letters patent No. 10488, he caused the defendant to be notified that it was infringing his rights under said letters patent, and warned to desist therefrom and to settle for past infringement, by Sam. Tro. Smith Esquire, his counsel; and further that after the issue of letters patent, No. 331,118, he again caused said defendant to be notified of said infringement; and further says that notwithstanding such notification defendant not only continued such infringement but issued a circular and sent it to its customers throughout the country, stating that the defendant would protect them in the use of its "tag envelope" and pay the costs of the defense in any suit brought against them for infringement, referring especially to deponent's reissued patent No. 10488; a copy of which circular is hereto annexed marked Exhibit H.

Deponent further says that he received in February last, from S. R. and J. C. Mott, Bouckville, Madison Co., N. Y., the exhibit
227 marked G G, covering two circulars and a postal card in their business, attached by a string to a sample bottle of their "sparkling golden russet cider" and at the same time another similar one hereto attached marked Exhibit G^9 which was handed to deponent by the messenger who delivered the package; that Exhibit G^9, remains unopened as it was received; that deponent immediately notified said S. R. & J. C. Mott, that they were infringing deponent's patent and received their letter in reply, accompanied by a circular purporting to have been received from defendant, which was the Circular Exhibit H hereto attached.

Deponent further says that he himself secured through the mail, one of said circulars enclosed in an envelope, having printed thereon

the name and address of defendant, being one of its regular business envelopes.

Deponent further says that from about the month of July, 1883, the defendant has persistently put into the market and sold the infringing articles hereinbefore described and referred to in direct competition with this deponent, first under letters patent No. 277,245; then under reissued letters patent No. 10488, and later under letters patent No. 331,118, selling the same at a lower price than deponent, and as deponent believes with the direct object of underselling and injuring deponent, and evading his patent and competing with his combined tag and envelope; avoiding in most instances the exact construction, and exact name of deponent's article, but using substantially the same construction and name.

Deponent further says that E. W. Dennison obtained a patent in 1863, on a tag with a reinforced eyelet-hole, which was put upon the market by defendant; on the reinforcing washer of which, around the eyelet-hole, was placed the patent mark, "Dennison's pat'd '63, '74." That said patent of 1863 expired in 1880,
228 some two years after the organization of the defendant corporation; that as no month or day of the month is given on said patent mark, it is not easy to ascertain what patent is referred to, if any; that deponent has made diligent search himself, and employed others to do the same, and has applied at the Patent Office, and has been unable to find any patent in 1874 or in any other year that has any possible application to the tag in question.

Deponent further says that defendant continues to put said mark "Pat'd '63, '74," on his tag envelopes, thus holding out to the public that it has one or more patents on said tag envelope, and is therefore entitled to sell them notwithstanding the patent of this deponent of a later date, thereby deceiving the public; that such deception is made more effectual by the failure of defendant to give the date of the patents by which reference could be made to the words and easily ascertain.

Deponent further says that the continued infringements of the defendant, and the acts and doings of its officers and agents in selling tag envelopes and sending out its circulars has seriously injured and is seriously injuring the business of deponent and depriving him of his just profits.

Deponent further says that Exhibits L [8] [9] [11] [12] [13] [14] [15] [16] [17] [18] [19] [20] [24] [25] [26] and [27] are a few of the thousand proofs that deponent can produce to show that the public and the trade generally acquiesce in his rights, and acknowledge the value and genuineness of his invention as secured to him by his said letters patent; that they are mostly letters received by him in the course of his business, and are selected because of their brevity and the range of dates from the early history of the invention to the present time.

Deponent further says that one especial reason why he makes and urges this motion for a preliminary injunction is, that
229 the continuous infringements of defendant, and its persistent efforts by circulars and representations, to introduce its tag envelopes in place of deponent's patented device, is ruining the

business of deponent, and the expense of making proof of damages, in such cases, is so great that the remedy by legal proceedings, if defendant is allowed to continue, is entirely inadequate to remunerate him for his losses.

Deponent further says that exhibit marked L^7 is in the handwriting of John Elsey, and was given by him to deponent in November, 1883, and that he is the same John Elsey for whom defendant's tag envelope marked G^{10} was made.

Deponent further says that the Exhibit G^{11} hereto annexed is one sent by S. R. & J. C. Mott to Messrs. Hardy & Hall, and concerning which deponent wrote the letter to S. R. & J. C. Mott, and that Exhibit L^{10} is the answer received from Mott & Mott thereto, and refers to the Circular Exhibit H.

Deponent further says that Exhibit A is a copy of the specification, claims, and drawings of his original letters patent No. 277,245; Exhibit B, is a copy of the specification, claims and drawings, of his reissued letters patent No. 10488; Exhibit C is a copy of his letters patent No. 331,118.

Deponent further says that on the 23rd day of December, 1886, he procured a package of 100 tag envelopes from Louis S. Bergen, who stated that he purchased them from the Dennison Manufacturing Company at 198 Broadway, New York city, by order of Walter C. Burr; that on the corner of several of said envelopes, said Burr and Bergen placed their initials, at deponent's request; that deponent placed said packages of envelopes in the hands of his counsel, Sam. Tro. Smith, with whom they have remained to the present time. Deponent further says that Exhibit G^{12} attached to these papers is one of said envelopes so handed to deponent by said Bergen, and by said deponent to said Smith.

230 Deponent further says that unless the defendant is enjoined and restrained from infringing the complainant's letters patent, reissue No. 10488, and No. 331,118, complainant will not receive such compensation for the benefit and advantage his invention thereby secured gives to the public as is contemplated by the patent laws, that patentees should receive for such benefit and advantage to the public.

Deponent further says that he is still the sole owner of his said letters patent, and the reason of the letters and bills hereto attached as exhibits being addressed to J. T. Dunham & Co. is that he has had often parties associated with him in his business under the firm name of J. T. Dunham & Co., and that all such letters have reference to the letters patent and invention of deponent described and set forth in the bill of complaint hereto attached.

JOSEPH T. DUNHAM.

Sworn to before me this 24th day of January, 1887.

J. HOMER HILDRETH,
Notary Public, N. Y. Co.

Fig. 1.

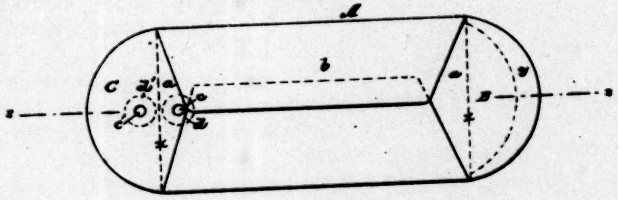


Fig. 2.

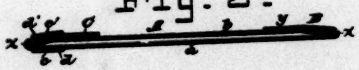
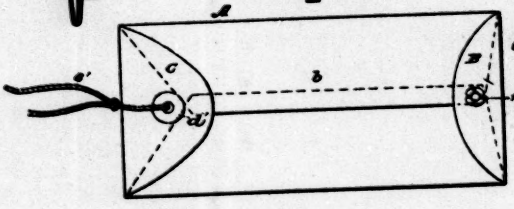


Fig. 3.

Fig. 4.

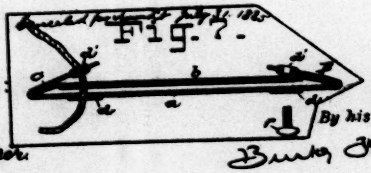
Fig. 5.

Fig. 6.



No. 294 Dunham p. 232 U.S. Mfg. Co.

Fig. 7.



WITNESSES:

E.R. Betts

Geo. H. Graves

INVENTOR:

James S. Dunham

By his Attorneys,

Burby Shaw & Dennis

231 DEFENDANT'S EXHIBIT TRACING DRAWING PATENT 331,118.
J. A. S., Ex'r.

JOSEPH DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the files of this office of the tracing of the drawing filed January 26, 1885, in the matter of the letters patent granted Joseph T. Dunham, November 24, 1885, number 331,118, for improvement in envelope.

In testimony whereof I, Benton J. Hall, Commissioner of Patents, have caused the seal of the Patent Office to be affixed this [L. S.] 3d day of December, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the United States the one hundred and twelfth.

BENTON J. HALL,
Commissioner.

(Here follows diagram marked p. 232.)

233 NEW YORK, *December 29th*, 1887—11 a. m.

Met pursuant to notice.

Present: Samuel T. Smith, Esq., counsel for complainant, and W. W. Swan, Esq., of counsel for the defendant.

Counsel for defendant puts in evidence a Patent Office copy of letters patent to Joseph T. Dunham, dated May 8th, 1883, No. 277,245 for combined tag and envelope, and the same is marked Exhibit Dunham's Original Patent, December 29th, 1887, J. A. S., ex'r, and it is agreed that the same may be used at the hearing with the same effect as if it was certified.

Mr. HENRY B. RENWICK, having been duly sworn as a witness in behalf of defendant, testified as follows:

Direct examination by Mr. SWAN:

Q. 1. What is your name, age, residence and occupation?

A. Henry B. Renwick, age 70, I reside in the city of New York, and am by profession a civil and mechanical engineer, and for the last 40 years have been much occupied with matters relating to patents and patented inventions, and for nearly 20 years during that time almost exclusively so occupied.

234 Q. 2. Have you read a Patent Office copy of the letters patent No. 277,245 dated May 8th, 1883, to the complainant for a combined tag and envelope. If you have, will you state what the invention is that is described in the specification and referred to in the claims thereof.

A. I have frequently examined the patent named in the question. It describes a well-known form of envelope known to me long before the application for the patent, and used for sending around wedding cards etc., in which the flap of the envelope is of substantially the same size as the whole body of the envelope. The patent goes on to describe that this envelope is to be punched with two holes passing one through the end of the flap at the furthest point from its attachment to the envelope, and the other through the thicknesses of paper at the end or bottom of the envelope, these two holes coinciding with each other when the flap is bent down over the envelope. These holes may be provided with any proper kind of re-enforcement, such as eyelets or washers of stiff paper or leather forming what is known to sailors as a grummet around the hole. This envelope described in the patent is substantially represented by the one I now produce, on the face of which I have written my initials, and also by complainant's exhibit reissue specimen. It is intended that this envelope when in use shall be furnished with a string such as on the one I have marked H. B. R., or with a wire hook or hook and ring serving the same purpose by means of either of which the envelope can be secured to "a box, barrel or package."

The statements of the advantages of the use of this contrivance in the patent, are, first, that the bill for the goods can be put
235 in the envelope and not be liable for letter postage, because it is unsealed and because the contents can be ascertained by bending the envelope and flap so as to form a circle and withdraw the bill. Second, that the name of the consignor can be printed on the outside of the flap or envelope as in envelope H. B. R. and third, that the address of the consignee can be written on the inner surface of the flap and concealed from casual inspection, or until the envelope is bent into a circle so that it can be read, or if the ring formed by tying the string is long enough, then the flap can be lifted from the envelope proper and the writing on its inside read.

Now, I have said before that the envelope itself is an old one, and the first claim of the patent is to the envelope itself without the eyelet holes in it. That is an envelope distinguished from ordinary envelopes by having the surface of the flap of the same amount of superficies and the same shape as the body of the envelope. The second claim is, as I understand it, to this same envelope when provided with the eyelet holes I have before described, not arranged in any manner so as to secure the envelope to a package, but arranged in the special manner described in the patent and set forth in the claim, namely one eyelet D, in the free end of the flap, and the other eyelet C. I quote from the claim " in that end of the envelope opposite to the end to which the flap is attached substantially as herein shown and described, and for the purpose set forth."

Now I have already set forth the purposes, and those purposes are doubtless secured by the use of this large flap envelope provided with eyelet holes, made in the envelope and flap in the positions with reference to the envelope described in the patent and referred in the second claim.

236 Q. 3. In the 51st and 52nd lines of the specification in the original patent are these words: "Or the envelope can be tacked to the barrel or box and so forth." In giving your last answer did you take this passage into consideration?

A. No, I did not, neither did I take into consideration the following words "and the free end of the flap is passed under a metal, rubber or oil-cloth strip tacked transversely over that end of the envelope opposite to the one to which the flap is fastened, whereby the flap will be held closed over the envelope, and in either case can be easily opened in case an employé of a railroad or express company wishes to read the address written on the under side of the flap."

I did not refer to these words, because they have no bearing, in my opinion, upon the second claim, although they do show that the envelope to be used in this manner in connection with the strap must be provided with a long flap substantially such as is provided in the patent.

Q. 4. Have you read the reissued letters patent No. 10488, dated June 10th, 1884, to Joseph T. Dunham, for combined tag and envelope; and if you have, will you state what the invention is that is described in the specification and referred to in the claims of that reissue; and will you state whether you find any difference between the original patent, No. 277,245, and the reissue No. 10488, in respect to the invention as set forth in the specifications and the claims?

A. I have frequently read the reissue referred to in the question. It describes precisely the same large flap envelope, the same way of arranging the eyelets with reference to the envelope, and the objects to be secured by this structure which are set forth in the original patent.

237 The first claim of the original patent, namely, to the peculiar form of the envelope described without the eyelet holes, is omitted in the reissue.

The third claim of the reissue is the same as the second claim of the original patent.

I do not think that by any loose use of language a claim can be so enlarged as to cover something substantially different from the article described in the description, or something which will not secure the advantages set forth in the description, and the court may therefore construe the first claim of the reissue, and also the second, to be substantially the same as the third claim (the second of the original patent), or they may consider the first and second claims to cover any kind of envelope, whether that specially described or some other, when said envelope is provided with eyelet holes placed one in the flap, and the other in any other part of the envelope, so long as it is so placed that a string may be passed through both to fasten the end of the flap to the envelope proper so as to close the envelope when the string is tied. I do not think this latter can be the construction intended for the claims, because to my own knowledge legal envelopes having an eyelet in the flap and two eyelets in that part of the envelope upon which the flap rests when the envelope is shut were known previous to the date of the

patent. Such envelopes were secured by a spring, and were something, although not exactly like that described in "Defendant's Exhibit Schultz 1879 Patent," where the same string which ties down the flap could be used for securing the envelope as a tag to a package of merchandise.

Q. 5. Will you read the first paragraph of the affidavit of
238 the complainant accompanying his application for a reissue of his original letters patent (see page 48, Complainant's Record), and state whether or not you agree with the complainant in the views therein expressed in regard to the specification and claims of his original patent?

A. I do fully, believing that the language of both the specification and claims of the original patent limit him, as set forth in the paragraph to which I have been referred, which is as follows:

"Joseph T. Dunham, being duly sworn, deposes and says that he believes his letters patent for combined tag and envelope No. 277,245, of May 8th, 1883, which he now seeks to reissue, is inoperative, for the reason that the language of the specification and the claim limit him to a combined tag and envelope, comprising an envelope having a flap at one end of sufficient size to cover one side of the envelope with the eyelets or holes, by means of which it is attached to the goods at the ends of the envelope, opposite that to which the flap is attached, and in the free end of the flap. That this language so restricts the scope of the said patent that any one may readily construct a combined tag and envelope that will fulfill all the essential requirements by so constructing the flap that it will not cover the side of the envelope, and having the holes for attachment at some place other than at the end opposite that to which the flap is attached and thus evade his patent and render it practically inoperate and worthless as a protection."

Q 6. In this affidavit of the complainant, filed with his application for reissue and just referred to, he says (page 49) (Defendant's Record): "Deponent further says that he believes he
239 was the first to construct a marking tag with means for attaching it to merchandize, and provided with a receptacle capable of being closed, and adapted to receive a bill or invoice of the goods to which the tag is attached, and that he is entitled to claim this broadly enough to cover such a device."

In another affidavit in the case sworn to by the complainant, January 24th, 1887, he says (page 82) Defendant's Record):

"Deponent further says that his first application for a patent for such invention was made on the 15th day of January, 1883, and that previous to that time, he had never seen or heard of such a thing as a combined tag and envelope, or any device of a similar character, and that as far as he knows and believes, it was the universal practice to mark packages on the packages themselves, or on a simple card or tag, such as were made and sold by defendant and affixed thereto, and to send the bill or invoice by mail, in an ordinary sealed and stamped envelope."

You are, I believe, familiar with the evidence in this case. State

whether you find anything therein contradictory to these statements or either of them, of the complainant?

A. I have nothing to contradict the complainant's belief, because he may not have known of the facts which I know of; but the patent to Ullman for an envelope, Defendant's Exhibit Ullman 1868 Patent clearly shows an envelope which might be tied to a package with a string passing through holes in the envelope, and the other end of the envelope might be sealed or unsealed at the pleasure of the sender; substantially the same device is shown in the Exhibit Schultz 1879 Patent, and also in Defendant's Exhibit Pultz and Walkley Tag Envelope, and all these were known prior to the date of the plaintiff's patent. So also, to my knowl-
240 edge, was a leather tag which would probably come within the meaning of those words quoted, which are, "any device of a similar character." This leather tag was a sort of a pocket made of two quadrangular pieces of leather stitched together along three of their sides. One of the sides of the pocket had a large hole cut in it, and both sides at the ends where they were not secured together had coincident holes. Now, an address card could be shoved down into this pocket through the open end, and other writing might have been shoved behind it, although I do not know that this latter has been done. When, after the card had been so slipped in, a string or leather thong was passed through both the holes, and the tag was by such cord or thong attached to the package, such as a trunk or traveling bag. The address card could not be removed until the string was untied, and any one by untying the string could inspect the whole contents of the pocket.

Complainant's counsel objects to all of the foregoing answer after the words, "So also to my knowledge," as volunteer testimony not called for in the question, and as wholly immaterial and an attempt on the part of the defendant to introduce evidence of an anticipatory device under the guise of expert testimony, which device has not been produced in evidence, and gives notice that he will move at the hearing to have such testimony stricken out.

Adjourned to to-morrow at 11 a. m., December 30th, 1887.

241 NEW YORK, *December 30th*, 1887—11 a. m.

Met pursuant to adjournment, parties appearing as before.

Direct examination of Mr. RENWICK continued by Mr. SWAN:

Q. 7. Will you make or cause to be made models of the envelopes described and shown in the Ullman & Schultz patents that have been referred to?

A. I will have such envelopes made and send them to the examiner, marked with the name of the patent with my signature.

Q. 8. Will you compare the envelope described in the reissued patent in suit and set forth in the claims thereof, with the envelopes of the Ullman & Schultz patents and also of the Connecticut envelope which is marked Defendant's Exhibit Pultz & Walkley Tag Envelope, J. A. S., examiner, and state wherein you find the reissue

envelope to be essentially like the three other envelopes, and wherein it is essentially different from them?

A. All the old envelopes named in the questions are different from that described in the reissue, in the fact that they have not the long flap of the envelope of the reissue, namely, a flap of the same superficies as the envelope.

Second. They, none of them, have a hole in the envelope itself at the end thereof opposite the end to which the flap is attached; consequently none of them could have the consignee's address printed on the under side of the flap and concealed from casual inspection while at the same time after the string had been put in the flap and the envelope could be bent into a circle so as to read the address of the consignee.

242 The Connecticut envelope, Defendant's Exhibit Pultz & Walkley Tag Envelope, is furnished with holes passing through the envelope and an eyelet so that it can be used as a tag, and in that respect it is like the envelope of the reissue. Further, in this envelope the bill could be put in the envelope and the flap turned down inside as is the common usage in sending circulars, so as to hold the bill in, and then there would be no letter postage upon them.

The Schultz envelope is like the envelope of the reissue in the fact that the flaps can be tied down by a string passing through a hole therein, and a hole in the envelope proper, and this same string could be used to attach the envelope as a tag to merchandise, and a bill put in it not subject to letter postage. Moreover, by tying the string with a long loop, the bill could be got out and replaced without disturbing the string or injuring the envelope, but this envelope has not, as before said, the long flap of the envelope of the reissue, nor has it the holes in the same location with reference to the envelope.

In making these statements I have ignored the question of the re-enforcement of the holes either by an eyelet or washer of thick paper gummed on, etc., because such re-enforcements were well-known devices before the date of any of these patents, and no person could have a patent for applying them to a known kind of envelope to perform their usual duty. But lest this statement should mislead, I will say further that the hole in the Connecticut envelope is re-enforced by a sort of eyelet or grummet, and that the holes in the Schultz envelope are re-enforced by paper, there being three thicknesses of paper in one of the holes in the Schultz envelope and more in the others.

243 The envelope patented to Ullman is an envelope in which the flaps at each end thereof are secured by an eyelet which passes through the flap and both sides of the envelope. This envelope can be used as a tag envelope by passing a string through one of the eyelets, and can receive an invoice, but the invoice cannot be got out of the envelope after both eyelets are fastened unless one eyelet is unfastened or the envelope is cut open.

In addition to the eyelets the flaps are also gummed so that they may be sealed down in the ordinary way.

Now, it is evident that none of these envelopes contain the invention referred to in the third claim of the reissue, neither do they contain the invention of the first and second claims if the latter be construed by the court to be limited to the large flapped envelope described in the patent which is provided with a hole at that end of the envelope opposite to the one to which the flap is attached.

But if the first and second claims be considered broadly, I find the invention referred to in both of them in the patent to Schultz wherein the flap is fastened down by a cord by means of which cord it could be secured to a package, and wherein the hole in the flap substantially coincides with a hole in the body of the envelope.

Q. 9. Will you draw a further comparison between the reissue envelope and the Ullman envelope, having more especial reference to the number of eyelets employed in the construction and use of each?

A. They both use two eyelets, but when the Ullman envelope is finally closed the two eyelets are at opposite ends of the envelope, whereas in the envelope of the Dunham reissue the two eyelets are at the same end of the envelope, so that the same string can be passed through both of them when the envelope is closed.

Q. 10. In the Ullman patent occurs this passage: "In
244 putting up the envelope for sale, the eyelet of the flap c is riveted and said flap gummed down." State whether you find in the description of the reissue provision for a similar construction.

A. The reissue states that "an eyelet hole *c* is arranged in the end of the envelope opposite to that to which the flap B is attached." This eyelet hole corresponds in position with that in the Ullman envelope and the two ends of the envelope are the same, because if I understand the description of the Dunham patent, this eyelet hole is to be made through the pasted-down flap of an ordinary envelope.

Q. 11. I quote further from the Ullman patent: "Eyelet holes F^1 being made through the end of the eyelet so that all the purchaser or user is required to do in order to seal the envelope, is to moisten the inner side of the flap C^1, turn it over and pass the eyelets through the holes F^1," etc. Will you state whether this construction requires that there be coinciding holes in the free flap, and in the body of the envelope, and whether or not this construction has been followed to any extent, in carrying out the invention of the reissued patent?

A. It does require that there should be such coinciding holes in the flap and in the body, as set forth in the second claim of the Dunham reissue, and if that claim be construed broadly and without limitation to the special construction of the envelope described in the Dunham reissue, then this description of the Ullman patent would invalidate this second claim.

Q. 12. Will you examine the exhibits marked respectively, "Complainant's Exhibit Dennison Patent Tag Envelope," and "Complainant's Exhibit Bergen's Specimen Dennison Tag Envelope No. 2," these being the tag envelopes introduced in the case as man-

ufactured by the defendant, and state whether or not you find
245 embodied in the exhibits the invention described in the reissued patent and referred to in the claims thereof, referring, if you please, to the state of the art as shown by exhibits in the case?

A. I have frequently examined the defendant's two envelopes referred to in the question. They are ordinary envelopes with an eyelet rivet passed through one end thereof. This eyelet passes through not only the flap, but through both the back and front of the envelope proper, and securely fastens that end of the envelope, so that it cannot be opened to take out any of the contents of the envelope, or examine them. By examining the envelope, this fact will be perceived, and it results from the way in which the paper is cut, so that the side of the body which has the seam in it reaches a long distance under the flap, and nearly to the end of the envelope.

Secondly, from the fact that the eyelet passes in part of its circumference through the two folds of paper which make the seam, and,

Third, because the eyelet is provided on each side thereof with broad and tolerably stiff reinforcing disks, and in the Exhibit Dennison Tag Envelope.

Fifth, in that the flap is like an ordinary envelope gummed down.

Now, the whole structure of the whole flap which I have just described is the same as that of the flap *c*, at the left end of Fig. 2, of the Ullman envelope as shown in the drawings. The other end of the defendant's envelopes is exactly like that of an ordinary gummed envelope, and these defendant's envelopes do not differ substantially as a whole from the Connecticut envelope (Pultz & Walkley tag sample), because both of them have holes and an eyelet passing through the envelope proper whereby they may be attached to a package by a string, and both of them have common gum flaps for sealing the envelope after the bill or other document has been enclosed in it.

246 The defendant's envelopes as a whole moreover are substantially like at both ends to the Ullman envelope, because that end of the envelope into which the letter or invoice is put is gummed like an ordinary envelope. It is true that the Ullman envelope has at this end the further security of an eyelet, but this is only an additional means of closing, which Ullman says was well known prior to the date of his invention.

It is obvious that the defendant's envelope has not the long flap of the plaintiff's envelope, nor has it an eyelet in the opposite end of the envelope, to that where the flap is secured, and that in the defendant's envelope when fastened to merchandise, the invoice cannot be examined, except by unsealing it, and further, that in the defendant's envelope, the address of the consignee could not be printed on the inside of the flap, and concealed from casual inspection, while at the same time it could be read by bending the flap and envelope into a cylinder or circle; the defendant's envelopes being, as I have said before, a very ordinary kind of envelope with

an eyelet driven through one end of it, so as to strengthen the joints at that end and serve as a means for attaching a string like the structure shown in the Ullman patent.

It needs no demonstration to show that the defendant's envelope does not contain the invention referred to in the third claim of the Dunham reissue, and if the first and second claims be construed by the court to be limited to the peculiar envelope and the peculiar arrangement of eyelet holes whereby the objects of the Dunham invention may be secured, it is equally clear that the defendant does not use the invention referred to in the first and second claims of the Dunham reissue.

But if the court shall construe the claims so broadly as to
247 hold the defendant to infringe, then those claims are bad, for want of novelty, in view of the Ullmans and Schultz patents.

Q. 13. In the paragraph beginning "hitherto" in the Ullman patent, reference is made to an envelope that was old at the date of that patent, 1868. Will you read the paragraph and describe the old envelope therein referred to?

Objected to by complainant's counsel unless a specimen of such old envelope made previous to January 15th, 1881, be produced.

A. The paragraph is as follows: "Hitherto envelopes which have been sealed with eyelets have been sold separately from the latter, and the purchasers or users were required to purchase two different articles, envelopes and eyelets, which causes considerable difficulty and embarassment, and therefore they have not come into general use." I understand from this paragraph and from the claim of the patent that the old envelope was the same when sealed up and riveted as the one described in the Ullman patent. Before it was sealed it differed in this: in the old one before Ullman the user had to take the eyelet out of his pocket or off the table and put it through the holes and rivet it. In Ullman's he bought the envelope with the eyelet stuck into the hole in the flap and held therein by pasting a piece of paper down over its flange so that all he had to do in sealing the envelope was to bend the flap and eyelet together over and pass the eyelet through the envelope proper and clinch the eyelet.

Complainant's counsel objects to the answer, the same as to the question, also as immaterial, secondary and hearsay evidence, it not appearing that the witness ever saw one of the envelopes or knows
anything about them, except as he reads the statement made
248 by Ullman in his specification, and notice is given that a motion will be made at the hearing to strike out the answer.

Q. 14. State whether or not you are familiar with the second Dunham patent in suit No. 331,118, and if you are, will you state what the invention is that is described in the specification and referred to in the claims of that patent and state also whether you find any such invention embodied in the defendant's envelopes?

A. I am familiar with the second Dunham patent referred to in the question, No. 331,118, and like the other it describes a tag envelope, and he states that his invention, "by reason of the peculiar construction of the envelope" removes certain difficulties incident to the use of old envelopes, stating that it has been customary in old envelopes "to provide" them "with a sealing flap at one end and a flap secured by a string or paper fastener at the other end," referring, I suppose substantially to the Ullman envelope before described, because in that envelope one flap is an ordinary sealing flap and the other is secured by a paper fastener; eyelets having been used for paper fasteners for 30 years or more, to my knowledge. He states that in these old envelopes it was necessary to remove the fastener before the contents could be got at. That is the case with the Ullman envelope. He then goes on to describe an envelope which can be opened and the contents examined by untying a string which has been passed through the eyelets, or if the loop in the string be long enough, by merely bending back the flap. In making this envelope he takes an ordinary envelope with that side thereof which contains the seam cut away so as to leave a vacant triangular space or, in other words, to leave the other side or front of the envelope exposed over a triangular space as shown at the right end of figure 1, of the patented drawing and in
249 dotted lines at the left end of figure 6, of the drawing. (I am speaking now only of that end of the envelope which is the subject of the claims.) He then secures a washer to this uncovered portion of the front of the envelope, (by front I mean that part of the envelope where the address is usually written,) and next secures another washer to the flap; the two holes in the paper, that is, in the flap and in the front of the envelope coinciding when the flap is turned down so as to enclose the contents of the envelope. The construction thus described will produce an envelope like Complainant's Exhibit Dunham's Second Patent Specimen, but the patent says that the paper re-enforcing washers may be replaced by metallic washers, but it must be noted that if the washers are so replaced by metallic washers then there must be two metallic washers, one in the flap and one in the front of the envelope, and not one eyelet passing through both the flap and front, and clinched, because this latter supposed construction would secure the flap in place permanently, and defeat the main object of the invention, which is to permit the flap to be lifted on the string so as to examine the contents of the envelope. In fact, the whole object of the invention is to construct a tag envelope which can be opened at will on a string so as to examine the contents thereof.

It is stated in the patent that a paper fastener may be used instead of a string to hold the flap down in place upon the envelope. But it is evident that by the words "paper fastener in this place," he means a paper fastener such as shown in figure 3, namely, one with two legs bent over to make the fastening, and not a tightly clinched eyelet, because the latter would, if used, prevent the easy removal of the contents of the envelope for inspection; this re-

moval being one of the objects or the greatest object which it is designed to secure by the construction of the envelope.

250 Now, in this patent the re-enforcement of the holes is a mere re-enforcing such as has been used for many years prior to the grant of the patent, and the invention would be substantially the same if the envelope had holes in the same position not re-enforced, the difference being one of degree, residing in the fact that the string would more easily tear the holes in one case than in the other.

The first claim refers to the envelope thus constructed when provided with a string or some equivalent of a string passing through both holes by means of which the back ply of the envelope is "removably secured," as shown and described.

Now, I have marked on the two Exhibits Dunham Second Patent Specimen, the letter b, on what the patent calls the back ply, and I understand the claim to mean that this back ply is "secured removably," because the flap can be opened on the string, and the back ply then moved from the front ply, so as to pull out the contents of the envelope.

Now, this construction calls for a hole in the flap and a hole in the front of the envelope not united by the same eyelet, and a back ply not permanently and rigidly secured to the front ply, because in that case the back ply would not be removable so as to get at the contents. Now, there is no such construction as this in the defendant's envelope. In that, the same and but one eyelet is used, as in Ullman, and this eyelet goes through the flap through a portion of the back ply, and through the front ply, and is clinched, and the back ply of the defendant's is not removably secured, so that the contents of the envelope may be examined. The defendant's envelope is like Ullman's and unlike that of Dunham's second patent.

Now, if the second claim be construed to cover the defendant's contrivance, it must be construed also to cover the Ullman

251 contrivance, and is therefore bad. But if the court should hold that the word-, "secured against accidental opening" means that the flap is to be secured to the front of the envelope by means of a string or its equivalent passing through the holes therein so that while secured by the string against accidental opening it may nevertheless be intentionally opened without unclinching an eyelet or untying the string, then the defendants do not use the invention contained in this claim, because by reason of their use of a single eyelet, their envelope cannot be intentionally opened without unclinching the eyelet or tearing the envelope.

It may perhaps be well to state further although it has been stated before, that the holes in Ullman's flap, and in the body of his envelope, register or coincide when the flap is folded down, and it would require no invention to re-enforce those holes either by metal or paper washers, and that the holes in the flap and in the body of the envelope in Shultz's envelope also coincide when the flap is folded down, and the holes of the Ullman envelope are re-enforced.

The object of the invention of the Dunham second patent is to secure a flap removably so that the contents of the envelope may be inspected without breaking the fastenings or tearing the envelope. The defendant's envelopes on the contrary secure the flap permanently and irremovably so that its contents cannot be got at until the fastening is broken or the envelope torn.

Adjourned to Saturday morning, at 11 a. m., December 31st, 1887.

252 NEW YORK, *December* 31*st*, 1887—11 a. m.

Met pursuant to adjournment.
Parties appearing as before.

Cross-examination of Mr. RENWICK by MR. SMITH :

X Q. 15. Are you or have you ever been in commercial trade where the use of shipping tags was necessary or proper?

A. I was for some years once employed in a wholesale house in New York, but that was before the day of expresses, ending in 1835 or 1837.

X Q. 16. What, if any, practical experience have you had in the use of shipping tags and tag envelopes?

A. None that I remember in the use of tag envelopes. I have used the ordinary tags.

X Q. 17. Have utility and practicability anything to do with the patentability of an invention?

A. An invention must be useful, but that has been construed to be not hurtful, and it must be practical so far that it can be built from the specification and will work more or less well, as a condition prior to the grant of a patent.

X Q. 18. When did you first see the patents in suit, concerning which you have testified, that is, Nos. 10488 and 331,118?

A. Some time in the early summer of 1887, I think in June of this year.

X Q. 19. When did you first see a Dennison tag envelope like those concerning which you have testified?

A. I think early in October.

X Q. —. When did you first see the Dunham tag envelopes themselves?

A. About the same time I think.

253 X Q. 21. When did you first see an article called a tag envelope?

A. I don't remember.

X Q. 22. When did you first see the exhibit in this case, called the Pulz & Walkley tag envelope?

A. I can't tell exactly; since Mr. Tucker's testimony was taken; sometime within a month.

X Q. 23. In your second answer you say, "the statements of the advantages of the use of this contrivance in the patent, is, first, that the bills for the goods can be put into the envelope and not be liable

for letter postage, &c. Will you point out in patent No. 277,245 the place where you find such statement?

A. The patent says: The bill or statement is placed in the envelope A, and the flap is folded over the envelope." A cord or hook is passed through the eyelet which will hold the "flap closed over the envelope." "By using the above-described tag or envelope the bill or invoices can be sent with the goods." Now, this is proof that the bills can be put into the envelope, as I stated. It is true that they can be put into an ordinary tag envelope and sealed up as they were. In that case, if sent by mail, letter postage will be charged, but by the use of the Dunham tag envelope where the flap is held down by a string, letter postage would not be charged under the same use of the envelope. If the fact of leaving the envelope either sealed or tied made no difference in respect to postage, Dunham's envelope might be sealed up, instead of being closed by a string, as like the Connecticut envelope in evidence.

X Q. 24. Then what you said in relation to the statement of advantages as to liability for letter postage, was an inference drawn by yourself, and not an actual statement made in the patent, was it not?

A. The patent describes a construction by the use of which the invoice can be safely carried without the envelopes being
254 sealed, and from what I know of post-office regulations I drew the conclusion that the saving of postage was one of the advantages arising from the use of such envelope.

X Q. 25. Are you an expert in postal law?

A. I am not, but I send all sorts of articles through the mail and know something about the rates of postage and the rules which govern it.

X Q. 26. Do you find the liability for letter postage referred to anywhere in the patent?

A. I do not, and I may have been influenced in making the statement, by confounding or joining the statements of the two patents in suit, namely, the Dunham reissue and the patent 331,118, in which latter an envelope is described that has the capacity for enclosing the invoice without sealing it, and in which there is a paragraph concerning the liability of sealed tag envelopes to letter postage.

X Q. 27. I also find in the same connection as another advantage the words, "because the contents can be ascertained by bending the envelope and flap so as to form a circle and withdraw the bill." Will you point out the clause in the patent to which you refer in that statement?

A. I cannot quote any special words to that effect. The whole construction of the envelope is such that the bill can be withdrawn in the manner stated in the question, and that certainly is an advantage resulting from the use of the envelope.

X Q. 28. I find also in the same answer in the same connection these words, "or if the ring formed by tying the string is long enough then the flap can be lifted from the envelope proper and the writing on its inside read." Will you point out in the patent

the place referring to the ring by tying the string or anything else of the same character?

A. The patent states that the cord or hook employed for
255 securing the tag to the merchandise also serves to secure the envelope, and prevents its contents from escaping, etc. The patent also says at the same time, "the express and railway companies can easily obtain the addresses by raising the flap B." Now, the drawing figure 2, shows a long ring in the hook which passes through the two eyelets of the envelope; by turning this hook the flap can be lifted as described in the patent, and if the cord were equally tied with a long loop in it, considerably longer than that on the envelope marked H. B. R., but no longer than that shown in the drawings, the flap could be lifted as stated by me, and as described in the patent.

X Q. 29. But the drawing figure 2, also figure 3, show the envelope with a string or wire loose at both ends, and not attached to anything, does it not?

A. No, it does not. It shows a wire, not a cord. You could not well make points on a cord like those shown in the drawing, and the wire is attached to the envelope by passing it through both eyelets thereof, and then bending the wire into an irregular ellipse.

X Q. 30. But supposing it to be a wire, the two ends of the wire are still loose, and ready to be attached to a package, but not so attached, are they not?

A. The wires are not shown as attached to anything in the drawing, and the ends would be rather short for that purpose, as shown in the drawing.

X Q. 31. I find in the same answer the following, "And the first claim of the patent is to the envelope itself without the eyelet holes in it." I read from the claim "a combined tag and envelope made substantially as herein shown and described." Does not this language include the eyelet holes as well as the envelope?

A. You have not read the whole of the claim, but stopped at a
comma. The claim goes on to specify what that tag and
256 envelope consists of, namely, an envelope having at one end a flap of sufficient size to cover one side of the envelope, and not saying that the envelope consists of one having eyelets in it. Further the patent describes in the following words, "Or the envelope can be tacked to the barrel or box, etc., and the free end of the flap is passed under a metal, rubber or oil-cloth strip, etc." The use of this envelope without any eyelets being inserted in either the flap or the body of the envelope, and this claim will cover, in my opinion, the envelope so used without any eyelet, and was intended to do so.

X Q. 32. In construing the claim of a patent, is not the description of the device set forth in the specification to be taken into consideration with the claim?

A. Certainly, but the claims may cover only parts of the whole thing described.

X Q. 33. Will you point out in the patent under consideration, any description of an envelope which does not contain the eyelet holes as well as the form of the envelope?

A. Only that which I have before quoted.

X Q. 34. Is that a description of an envelope?

A. I understand it, taken in connection with the rest of the patent, to be a description of an envelope without any eyelets. The first describes how it can be held attached by mean- of the eyelets, and then how it can be held and closed without using the eyelets.

X Q. 35. Then you wish to be understood that although the description of the tag envelope contained in lines from 20 to 28, includes the eyelet holes, that the words "or envelope can be tacked to the barrel, box, &c.," refer to another envelope which is not described anywhere in the specifications, do you?

A. No, I do not mean any such thing. I think that the words "or the envelope can be tacked, &c.," refer to the same long-
257 flapped envelope that is described in lines 20 to 28 before the eyelets are put in it, and I now, in further support of my understanding of the first claim of the original Dunham patent, quote these words from the preamble."

"The object of the invention is to form an envelope with an N flap covering its sides as hereinafter described." I don't find in this paragraph any statement about eyelets, and as I said before, that envelope which is the object of the invention is the one referred to in the first claim."

X Q. 36. But you do find in the "hereinafter-described" envelope in line 20 to 28, the eyelets C in the end of the envelope and the eyelet D in the flap B, do you not?

A. I find that the eyelets C, and D, in that description are to be inserted in the described envelope, the envelope being the same with or without the eyelets and I also find in the description of the use of the envelope one way of using it without eyelets.

X Q. 37. In the same answer I find the following: "The second claim is as I understand it, to this same envelope when provided with the eyelet holes I have before described, not arranged in any manner so as to secure the envelope to the package, but arranged in the special manner described in the patent and set forth in the claim namely, one eyelet D in the free end of the flap, and the other eyelet C in that end of the envelope opposite to the one to which the flap is attached." Is not that arrangement thus described the proper arrangement for securing the envelope to the package?

A. It is the proper one for that long-flapped envelope described in the patent, and is the only arrangement there described when eyelets are to be secured.

Time for taking testimony extended by consent to March 1st, 1888.

Adjourned to Monday, the 9th of January, 1888, at 11 a. m.

258 NEW YORK, *January 9th*, 1888—11 a. m.

Met pursuant to adjournment.
Parties appearing as before.

Cross-examination of HENRY B. RENWICK, Esq., continued by SAMUEL TRO SMITH, Esq.:

X Q. 38. You say in your third answer in reference to tacking the envelope to a barrel or package: "Although they do show that the envelope to be used in this manner in connection with the strip must be provided with a long flap substantially such as is provided in the patent."

Would not the width of the strip mentioned determine how long the flap must necessarily be and might not the width of the strip be so great as to suffice to hold down an ordinary envelope flap?

A. The word "strip" implies a narrow piece of stuff, not a wide one, and the direction is, the strip is to be tacked over that end of the envelope opposite to the one to which the flap is fastened, therefore the flap must be a long one extending to the end of the envelope where the strip is tacked so as to go under it. The patent also says in this relation, that in substance the flap can easily be opened in case one wishes to read the address on the under side of the flap. Now, this address according to the patent and drawing, is to be written on the under side or in the face of the flap B which is a long flap. Now, it is doubtless true that you might take a piece of oil-cloth as wide as the envelope is long so as to reach from that end opposite the flap where the patent directs the strip to be tacked to the other end of the envelope and you could then secure the flap of an ordinary envelope under it. In my
259 opinion such a contrivance would not be the one described in the passage referred to in my third answer.

X Q. 39. In your fourth answer, you refer to legal envelopes within your own knowledge. Were the flaps of such envelopes on the end or sides thereof?

A. They were on the longest dimension of the quadrangle of the envelope.

X Q. 40. Would the Schultz envelope, which you have referred to in your testimony, be a practical, useful tag for commercial use to be sent with barrels, boxes, and packages?

A. I don't know exactly what commercial use requires, but I could tie the Schultz envelope to the string surrounding the box, barrel, or package, as the plaintiff's is, and one would probably go as safe as the other.

X Q. 41. Can you produce a leather tag such as you have described in your 6th answer, which was made prior to January 15th, 1881?

A. I cannot at present, and don't know whether or not I could find one made as early as that.

X Q. 42. Have the holes in the envelope, "Defendant's Exhibit Pultz & Walkley Tag Envelope," in the end or sides where the flap is attached, or in the opposite end or sides?

A. No, in neither; they are in what sometimes is called one of the ends of the envelope, the shorter sides of the quadrangle.

X Q. 43. In this respect, are the envelopes, Defendant's Exhibit Pultz & Walkley Tag Envelope, like or unlike Complainant's Patented Tag Envelope?

A. Unlike in the position of the holes as I think I have already stated.

X Q. 44. Does the complainant's patent 10488 reissue specify whether the flap is an end flap or a side flap?

260 A. Yes, it does, it says it is an end flap.

X Q. 45. Does the eyelet hole described and shown in said patent extend through one or both plies of the envelope?

A. One of the eyelet holes C extends through both plies of the envelope and through the flap at that end, but it might extend only through one ply and the flap; either construction would be within the patent.

X Q. 46. In the Pultz & Walkley envelope, does the eyelet hole extend through the flap and envelope?

A. Yes, through the closed flap just the same as it does in the plaintiff's.

X Q. 47. In the Schultz patent does the eyelet hole extend through both or one of the plies of the envelope?

A. The hole in the Schultz envelope does not extend though the front ply of the envelope, I mean that on which the address is usually written, as is the case in the plaintiff's envelope.

X Q. 48. In this respect, is the Schultz envelope like or unlike complainant's patented envelope?

A. Unlike.

X Q. 49. Are you willing to swear as an expert that turning the flap of a tag envelope inside is the equivalent of fastening it down with eyelets, and a string or wire with which said envelope is attached to the package?

A. No.

X Q. 50. At the close of answer 8, you used these words in reference to the Schultz patent, "wherein the hole in the flap substantially coincides with the hole in the body of the envelope."

Is the hole to which you refer at the end of the envelope, and does it extend through both plies of the envelope as in complainant's device as described in his reissue patent, or through the front ply as in his second patent 331,118?

261 A. It is near the end of the envelope, although it extends through several thicknesses does not extend through the front ply.

X Q. 51. In answer 9, referring to the complainant's reissue, and the Ullman envelope, you say "They both used two eyelets"? Do you mean to be understood that the two eyelets used in the Ullman envelopes are the equivalents of the two eyelets in complainant's reissue device?

A. No; and if you will read the whole of my 9th answer you will see that I describe the difference in operation of the eyelets in Ullman and in complainant's reissue.

X Q. 52. Do you mean to be understood by your 11th answer, that if complainant's reissue claim be construed broadly, the description of Ullman's claim for a device exclusively for sealing and mailing envelopes not practical for any other purpose would invalidate complainant's claim for a practical device for closing without sealing a tag envelope?

A. I think my 11th answer is clear enough, and it is, that if the second claim be construed to cover broadly coinciding holes through which a string could be passed without reference to the special limitations, in the Dunham description, then Ullman's patent would be an answer to that second claim.

X Q. 53. You say in answer 14, referring to complainant's patent 331,118, "He then goes on to describe an envelope which can be opened, and the contents examined by untying a string which has been passed through the eyelets, or if the loop be long enough, by merely bending back the flap." Will you point out the place in the patent where the length of loop is referred to?

A. I was describing what Dunham's envelope will do, and by reference to figures 4, 5 and 6, it will be seen that the flap can be bent back if the string is long enough so that the contents
262 can be examined. Reference to the Complainant's Exhibits Dunham 2nd Patent Specimen show this clearly. If the string be tied very tight it would be impossible to examine the contents although the ply B can be pushed back a little way after the flap had been bent.

X Q. 54. In this connection you use the phrase, "Merely bending back the flap." Does not the patent read, by bending back the flap C, and the washer thereon?

A. Yes, the patent does use that language, but the washer is glued on the flap and is part thereof, and if you bend back the flap you bend back the washer.

X Q. 55. In the same answer 14 you use these words "And defeat the main object of the invention which is to permit the flap to be lifted on the string so as to examine, &c." Will you point out in the patent the language authorizing such statement?

A. Sufficient quotation has hardly been made to give an idea even of my conclusion which has been quoted.

The statement in the patent is "My invention obviates these difficulties by rendering the removal of the fastening unnecessary."

And by reference to the preceding paragraph it will be seen that the word "unnecessary" referred to the getting at of the contents of the envelope for examination, and that is not only the main, but the whole object stated in the patent; now if an envelope like Dunham's be made with the holes through the flap and the front ply as described and shown by him, and a single eyelet be passed through both holes and clinched, then the envelope cannot be opened without the removal of the fastener in order to get at its contents.

(S'g'd) HENRY B. RENWICK.

Attest: JOHN A. SHIELDS, *Examiner.*

263 Defendant's counsel puts in evidence the Patent Office copy of letters patent No. 227,077 dated April 27th, 1880, to Kilburn Tompkins for improvements in envelopes, and it is agreed that the same may be used at the hearing with the same effect as if duly certified, and the patent is marked (Exh. Kilburn Patent Jan. 9th, 1888, J. A. S., ex'r.)

Adjourned subject to notice.

JANUARY 10, 1888.

Present: Counsel for the respective parties.

LUCIUS V. WALKLEY, called and sworn as a witness on the part of the defendant, deposes and says as follows:

Q. 1. What is your name, age, residence and occupation?

A. Lucius V. Walkley, age 44, reside at Plantsville, Connecticut, occupation, manager of the Pultz & Walkley Company. I am also vice-president of same company.

Q. 2. Mr. George E. Tucker has testified in substance that the Pultz & Walkley Company has, during the past few years engaged, among other business, in the manufacture and sale of tag envelopes. State whether you yourself have any knowledge of such manufacture and sale.

Objected to by complainant's counsel unless the tag envelopes referred to are produced and are similar in construction to
264 those described in complainant's patent and shown to have been manufactured and in use prior to January 15th, 1881.

A. Yes, we have been engaged in the manufacture of tag envelopes some ten or twelve years.

Answer objected to as above by complainant's counsel, and as immaterial.

Q. 3. Will you produce a tag envelope of your manufacture to be marked as as exhibit in this case, and will you state how long your company have made and sold tag envelopes substantially like the exhibit?

Same objection as to question 2.

A. I produce a tag envelope made at our factory, and to the best of my recollection we made and sold on the market as early as 1875, substantially the same thing, the only difference, perhaps, being the envelope itself. We bought those of different manufacturers at different times and then re-enforced them by pulling a piece of card-board in at one end and inserted our patent eyelet, substantially the same as in the exhibit.

Complainant's counsel objects to the answer the same as the answer to question 2.

Q. 4. You say "to the best of your recollection;" how far back can you say with certainty that you manufactured and sold tag envelopes like the exhibit?

The same objection.

A. 1875; I might qualify that and say that I looked over the books recently and find that there were sales of these goods made in 1875. I could not say to-day from memory.

265. Cross-examination by complainant's counsel *de bene esse*, without waiving any objection heretofore taken:

X Q. 5. How are you enabled to remember that you manufactured tag envelopes as early as 1875?

A. In 1872 we obtained a patent on tags, and within two or three years after that the idea occurred to me that an envelope might be utilized for the purpose of sending invoices, &c., with express packages, and I am very positive that I applied for a patent for the same in 1874. I am able to place the date in 1875, by examining our books where I found entries of the sale of these goods.

X Q. 6. In what book did you find such entries?

A. In our journal of that year.

X Q. 7. In whose handwriting were the entries?

A. In our book-keeper's.

X Q. 8. Give his name, please?

A. My recollection is that Mr. Pultz kept our books for a part of that year, and Mr. Wood for a part of the same year, so that the entries upon our journal are in both handwritings.

X Q. 9. Do you mean the Mr. Pultz who is now dead?

A. Yes.

X Q. 10. Did you find any such entries in your own handwriting?

A. I did not. I don't think I ever made an entry on our books.

X. Q. 11. Did you personally make any sales of such tag envelopes?

A. Yes.

X Q. 12. To whom?

A. Yes, H. K. W. Hall of Boston, I remember also Brooks, Bancroft & Co., of the same place.

X Q. 13. When were those sales made?

A. In 1875.

X Q. 14. In what month?

A. I can't tell without referring to the books, and transcript of the same.

266 X Q. 15. Please state what induced you to examine your books with a view of ascertaining about these sales?

A. I am in business here in New York, and I received a letter from our book-keeper enclosing a letter from Messrs. Dennison & Co., asking us if we would kindly give them the date that we had sold these tag envelopes. On my next visit to our factory I examined our books to ascertain the date.

X Q. 16. When did this occur?

A. I should say three months ago, I couldn't state definitely.

X Q. 17. Did you have any conversation at that time with your book-keeper and Mr. Tucker, or either of them, about such tag envelopes?

A. My recollection is that I asked our book-keeper to show me the books—that I dictated an answer to Messrs. Dennison.

X Q. 18. Was anything said about finding a tag envelope or circular made about the time of those entries?

A. There was not.

X Q. 19. Did you obtain a patent for such tag envelope?

A. I did not.

X Q. 20. Why not?

A. I couldn't state, but I think that we were referred to our own patent tag. I did not think there was enough in it to pursue it further.

X Q. 21. Do you mean to be understood that your application at the Patent Office was rejected and the reference given on such rejection was your own patent tag?

A. That was my impression, but I think it had more reference to the eyelet, but still I am unable to say.

X Q. 22. Through what solicitor did you make such application?

267 A. My impression is that it was James Sheppard who then resided in Bristol, Connecticut, he now resides in New Britain.

X Q. 23. Are you not certain that he was your solicitor?

A. I am not certain, but very positive.

X Q. 24. What other solicitor, if any, did you employ to make applications for patents about that time?

A. I don't recollect of ever having made an application except through Sheppard, although I have sometimes consulted with other attorneys.

X Q. 25. Defendant's Exhibit Pultz & Walkley Tag Envelope shown witness. Will you state whether you ever saw that envelope before?

A. I have.

X Q. 26. When?

A. About half an hour ago when Mr. Swan showed it to me.

X Q. 27. Do you know whose manufacture that envelope is, I mean the envelope itself?

A. I think it is the Plympton Manufacturing Company of Hartford, Connecticut, or Berlin & Jones of New York.

X Q. 28. Did you purchase envelopes of these two firms about the date of the making of such entries?

A. I cannot say positively. I remember purchasing envelopes of the Plympton Manufacturing Company at various times, but I could not state positively the date without referring to our invoices or books.

X Q. 29. Previous to the fire in 1875?

A. I don't remember the occurrence of the fire in 1875. Our factory was burned down in 1876. I couldn't state positively whether I bought envelopes of Plympton & Co. previous to the fire, but I have no doubt of it.

X Q. 30. Can you state definitely when that fire occurred?

268 A. My impression is that it occurred the last Sunday in October, 1876.

X Q. 31. This envelope "Pultz & Walkley Tag Envelope" has a peculiar formation of the end flaps, can you not tell by that formation of whose manufacture it is?

A. I cannot.

X Q. 32. Will you produce your journal in which the entries to which you refer were made?

A. I have no objection particularly but should prefer not, provided a copy of the different entries would answer the purpose. I will furnish such copies with an affidavit as to their correctness rather than send the books.

X Q. 33. Are you not aware that such copy would be secondary evidence and not admissible in this or any other court?

A. I am not.

X Q. 34. Is the journal in which these entries are said to be made one which you now use to make entries in in your business?

A. Certainly not.

X Q. 35. Does your book-keeper have free access to such journal?

A. Yes.

X Q. 36. Does Mr. George E. Tucker have free access to that journal?

A. He does not.

X Q. 37. You say you never saw the envelope "Pultz & Walkley envelope" until to-day. When did you first hear of it?

A. I don't think I ever said that I never saw it until to-day, I have no recollection of it. This particular envelope, I have no recollection of ever having my attention called to it before to-day.

X Q. 38. Then you never heard of this particular envelope
269 being found at your factory by your book-keeper and by him and George E. Tucker identified as one having been made by your company as early as October 31st, 1876?

A. As far as this particular envelope is concerned. No; Mr. Tucker stated to me in substance that they found an envelope and a circular which were printed before the fire, and stated that he was sure of it on account of a font of type being destroyed in that fire which was used to print the circular and envelope. This, Mr. Tucker told me after his examination here.

X Q. 39. What position does Mr. Tucker hold in your establishment?

A. He is foreman of the printing and tag department.

X Q. 40. And has been how long?

A. Since we was organized in 1870, I think, most of the time.

X Q. 41. Who is your engineer?

A. Just at present, Mr. Tucker is attending to it.

X Q. 42. Does he hold any other position than foreman of the printing and tag department and engineer?

A. Those are the only two things of which he had exclusive control. He is one of those peculiar kind of men that is willing to do anything at any time that we require of him.

X Q. 43. Then you did not know of Exhibits "Pultz & Walkley Tag Envelope," and "Pultz & Walkley Circular" had been fur-

nished to the defendant's solicitor or agents until after that had been done, did you?

A. I think not.

X Q. 44. Was this Exhibit Pultz & Walkley Tag Envelope ever used as a tag envelope, or was it used as your advertisement. I mean this particular envelope with the printing on it?

A. I should judge there being no address on it, it had not been used.

X Q. 45. Does not the printing on both sides of it indi-
270 cate or show that it was intended as an advertisement for the Pultz & Walkley Company?

A. We used them both as an advertisement and for putting them on packages when we were shipping goods in small lots, with the invoice inside.

Counsel for complainant objects to all of the answer after the word advertisement, as volunteered testimony not in response to the question, and gives notice that he shall move at the proper time to strike it out.

X Q. 46. Question repeated.

A. Not necessarily for the one purpose, the advertisement exclusively, we used them for both purposes.

Answer after the word "necessarily" objected to by complainant's counsel, same as last, and—

X Q. 47. Question repeated and witness reminded that the question refers only to this individual envelope, and to what the printing that is on it shows, and witness is requested to answer the question, yes or no?

A. I can't answer it yes or no. I meant to say that we made and printed tag envelopes in that way, for both the purpose of advertising and for use as a tag envelope. I couldn't say what that individual envelope was made for.

The entire answer objected to by complainant's counsel, same as before.

X Q. 48. When was this tag envelope Defendant's Exhibit P. & W. Company Tag Envelope No. 2 made?

A. I have no means of knowing.

X Q. 49. Why is not the same printing on that as is found on the other tag envelope referred to?

271 A. Number 2 is simply a sample of tag envelope No. 30 N, which designated the size, and was sent to our customers upon application for samples, while the first exhibit was used both for an advertisement and for a tag envelope in our business.

The last clause of the answer, after the word "samples" objected to by counsel for complainant; the same as question 45 and same notice given.

X Q. 50. But you have just testified that you should think that "Defendant's Exhibit Pultz & Walkley Tag Envelope" had not been used as a tag envelope. Have you not?

A. I stated there being no address on it, I presumed it had not been used; but as I understood the previous question, it was simply relative to the printing on the two envelopes.

X Q. 51. How many tag envelopes did you sell to H. K. W. Hall?

A. I think the first sale was one thousand.

X Q. 52. Did those envelopes have the same printing on which Defendant's Exhibit Pultz & Walkley Exhibit has?

A. I don't think they were printed at all.

X Q. 53. What induces you to think so; have you a distinct recollection of the fact, or, if not, what other reason have you for so thinking?

A. I have no recollection as to whether those were printed or plain; we furnished them to the trade and customers both ways.

Complainant's counsel objects to all of the answer after the word "plain," the same as to answer 45, and reminds the witness
272 that he has not given his reasons for thinking the envelopes sold to Hall were plain.

X Q. 54. Question repeated.

A. I have no particular reason except my knowledge of the man; his business habits would lead me to think that he would not use them printed, being of an economical turn of mind.

X Q. 55. Did you charge more for those printed like Exhibit Pultz & Walkley Tag Envelope than for plain ones?

A. My impression is that it was one dollar a thousand and extra.

X Q. 56. Did you ever find a customer who was willing to pay one dollar a thousand for printing Pultz and Walkley's advertisements on their tags?

A. No, in such cases we generally printed their advertisements as well as ours.

X Q. 57. Did you make the manufacture and sale of this article profitable?

A. That in connection with our other business we made profitable, we kept no separate account of our profits in these particular goods.

X Q. 58. What did envelopes like Defendant's Exhibit "Pultz & Walkley Tag Envelope" cost your company in 1875?

A. I could not state definitely without examining our books.

X Q. 59. What did the re-enforcing metallic eyelets cost your company in that year. I mean your patent eyelet used in this envelope?

A. My impression is, it was thirty-eight cents a thousand, I wouldn't be positive that we bought them at that rate.

X Q. 60. What was the cost of putting in the card-board, re-enforcement and the eyelet?

A. I couldn't state.

X Q. 61. Would your books show these things concerning which I have asked you?

273 A. I don't think they would.

X Q. 62. Would they not show the cost of the envelope?

A. Our invoices would.

Answer objected to by complainant's counsel, as irresponsive, and—

X Q. 63. Question repeated?

A. I don't think our books would show it.

X Q. 64. Have you no invoice book?

A. Properly speaking, not.

X Q. 65. What do you mean by properly speaking?

A. An invoice book, as I understand it, is a book in which all invoices are copied. We have no such book.

X Q. 66. How do you preserve your invoices?

A. File them away.

X Q. 67. Have you no book in which entries of purchases are made?

A. Yes.

X Q. 68. Have you no book in which entries of expenses are made?

A. All entries are made in our common journal.

Complainant's counsel requests the witness to produce the journal of the company, and such books and invoices as would throw light upon the questions involved in his examination, and gives notice to defendant's counsel, that unless such books are produced in presence of the witness for further cross-examination, he shall move, on the hearing, to strike out all of the witness' testimony, and asks that the examination may be adjourned to a subsequent day for such purpose.

274 Counsel for defendant thereupon says that he will not trouble the witness to bring the books to New York, but repeats the offer made at an earlier stage of the reference, to allow the complainant and his counsel to make such examination of the books of the Pultz & Walkley Company, at the works of the said corporation at Plantsville, Connecticut, as they shall deem necessary to be made for the purposes of this case.

L. WALKLEY.

Sworn before me—

JOHN A. SHIELDS,
Examiner, &c.

Adjourned subject to call.

275 DEFENDANT'S EXHIBIT TRANSCRIPT FROM P. & W. CO.'S BOOKS.
J. A. S., Ex'r.

Office of the Pultz & Walkley Co., Glen mills, Westfield, Mass.

PLANTSVILLE, CONN., *Nov.* 29, 1887.

All communications to Plantsville, Conn.

Journal D (1875), page 225.

Feb., 1875.

175 22 H. K. W. Hall, Boston, Mass.
" 1 M No. 20 tag envelopes.....3
" 1 bundle ex. 25 per cent..... 75—2 25

E. A. Wood's writing.

Journal D, page 229.

Feb., 1875.

378	26	Brooks, Bancroft & Co., Mass.			
"		2 M No. 1 pat. tags	2 50	5	
"		5 M No. 3	3 50	17	50
"		10 M No. 4	3 75	37	50
"		10 M No. 5	4	40	
				100	00
		40 & 10 per cent		46	00
				54	00
276		1 M No. 25 tag envelopes	3 50		
		1 case No. 205, ¼ per cent	87—2	63—56	63

E. A. Wood's writing.

Journal D, page 246.

M'ch 3, 1875. Geo. E. Selleck, Brattleboro', Vt.

593	1 M No. 20 tag envelopes	3	
"	1 M No. 25 " "	3	50

E. A. Wood's writing.

Journal D, page 257.

M'ch 16, 1875. W. J. Glover & Co., Prov., R. I.

535	1 M No. 30 M tag envelopes	4	

E. A. Wood's writing.

Journal D (1875), page 334.

May 1, 1875.

229		N. Y. office, No. 74 Duane St.		
"	1 M No. 20 tag envelopes		3	
"	5 M No. 25	3 50	17	50
"	4½ M No. 30	4	18	
			38	50
	40 per cent		15	40—23 10

E. A. Wood's writing.

277 Journal E (1876), page 55.

M'ch, 1876.

392	9	H. K. W. Hall.			
"		2 M No. 2 Eagle tags	88	1	76
"		1 M No. 25 tag envelopes	3 50	3	50
				5	26
		1 bdl. ex. 25 per cent		1	31— 3 95

J. P. Pultz' writing.

Journal E, page 62.

M'ch, 1876.

518 17 White, Perry & Dexter, Worcester, Mass.
1 M No. 25 tag envelopes printed for..... 3 50

J. P. Pultz' writing.

GEO. E. TUCKER.

278 Circuit Court of the United States, Southern District of New York.

JOSEPH T. DUNHAM
vs.
DENNISON MANUFACTURING COMPANY. } In Equity.

Defendant's record continued.

BOSTON, *January 26th*, 1888.

Met by agreement.

Present: W. W. Swan, Esq., of counsel for defendant. Sam. Tro. Smith, Esq., of counsel for complainant.

HENRY K. W. HALL, a witness called by the defendant, being duly sworn, testifies as follows:

Q. 1. State your name, age, residence, and occupation?

A. Henry K. W. Hall. I am 49 years old, I live in Boston, and am a paper dealer.

Q. 2. State whether or not you have ever used an article known as a tag envelope, and if you have, will you describe the article and state how much you have used such tag envelopes, during what time, and for what purpose?

279 A. I have used them at intervals the last fifteen years. It is made as an ordinary envelope with a flap having an eyelet in the end, with a string attached to affix them to packages and merchandise. I have used them for the purpose of enclosing invoices. I used them only in very limited amounts.

(Answer objected to by complainant's counsel as immaterial, it not appearing that the tag envelope referred to, was in any way like that described in complainant's patent.)

Q. 3. When did you obtain the tag envelope you have referred to in your last answer?

Objected to as immaterial unless such tag envelope is produced; and shown to have been used previous to January 15th, 1881.

A. I obtained them from Pultz & Walkley, Plantsville, Connecticut.

Q. 4. If you have with you a tag envelope of the kind that you have used during the period spoken of in your second answer, will you produce it to be marked as an exhibit in this case?

A. That is the style. We used them in a larger size generally.

Objected to by complainant's counsel as immaterial.

(The tag envelope produced by the witness, is put in evidence, and marked Exhibit Hall Tag Envelope.)

280 Q. 5. How do you fix the time of your early use of these tag envelopes such as you have produced?

A. By reference to my accounts.

Q. 6. What do you find in your accounts that enables you to fix the time of your early use of these envelopes?

Objected to by complainant's counsel as secondary evidence; the accounts themselves being the best evidence of what they contain.

A. Some credits of the same date that they sold me tag envelopes.

Q. 7. Where were you doing business when you began to purchase tag envelopes of Pultz & Walkley, as you have testified?

A. I think at 29 Hawley street. Our business had a great many interruptions in those years by fire and dissolution, and the old books were entirely destroyed that is, the books that were used at 29 Hawley street. The books were burned up in the fire of 1872.

Q. 8. Where are you now doing business?

A. 165 Devonshire street.

Q. 9. Are you able to state with certainty as matter of recollection whether or not you purchased these tag envelopes of Pultz & Walkley and used them in your business before you first occupied your present place of business?

Objected to by complainant's counsel as leading.

A. I feel confident that I did.

Q. 10. When did you first occupy your present place of business?

A. The directory will be the best authority on that. I haven't the lease with me, it is about ten years.

281 Q. 11. Will you refresh your recollection by looking at a file of directories, and state when you moved.

Objected to by complainant's counsel, as an improper method of leading the witness; and the witness having referred to a lease, which he has not with him, as being parol and secondary evidence.

A. I find that the directory of 1879, designates me as at 165 Devonshire St.

Complainant's counsel objects to answer same as above, and as immaterial.

Q. 12. Will you refresh your recollection by looking at some of your old bill-heads, and state whether they enable you to state where you were at certain times?

Objected to by complainant's counsel the same as Int. 11, and as immaterial.

A. I find one of May 1st, 1877, at 31 Hawley St. I find another of August 1st, 1879, 165 Devonshire street.

Q. 13. State whether or not your ledgers shows credits to Pultz & Walkley on or about the 22nd of February, 1875, and on or

about the 9th of March, 1876, and, if they do, will you read such credit entries to the magistrate?

Complainant's counsel objects to the question as secondary evidence unless the book is produced and identified by the witness.

A. Feb'y 22nd, 1875, I find a credit of $2.25. March 9th, 1876, find a credit of $3.96.

282 Answer objected to by complainant's counsel, it not appearing to what such credit refers, and consequently is immaterial.

Counsel for defendant offers the ledgers for the inspection of counsel for complainant.

Q. 14. By what name were these tag envelopes, concerning which you have testified, known when you first began to use them?

A. Simply as tag envelopes.

Q. 15. In my 13th question I asked you to read from your ledger certain questions, wishing for an exact copy on this record. Will you point out the entries to which you referred in your answer in order that the magistrate may copy them on the record?

A. I will, here they are.

Dr.	The Pultz & Walkley Co., Plantsville, Conn.	Cr.
1876.		
M'ch. 9.	By mdse. ac. ex	$3 96
" 15.	Cash, 472	1 30
		$5 26

Dr.	Pultz & Walkley Co., Plantsville, Conn.	Cr.
1875.		
Feb'y 22.	By mdse	$2 25

Q. 16. State who made the entries in your ledger that the magistrate has just copied?

A. They were made by a book-keeper then employed by me.

283 Counsel for the complainant renews the objection, especially as it appears that the entries were not made by the witness.

Cross-examination by Sam. Tro. Smith, Esq., of counsel for complainant:

X Q. 17. Can you state from memory when you removed from Hawley to Devonshire street?

A. About ten years since.

X Q. 18. You spoke of your business being interrupted by fire, when did such fire or fires occur?

A. 9th of November, 1872.

X Q. 19. From November '72 to 1879 where were you located?

A. I was located at 7 Williams court, and 31 Hawley street; those being the intervals before my removal to 165 Devonshire.

X Q. 20. During that seven years were you engaged in the same business?

A. I was.

X Q. 21. Did you keep books during that time?

A. I always kept an account in my business; if that is what you refer to.

X Q. 22. At what place were you located when the entries in your ledger to which you refer in your 15th answer were made?

A. I think at 31 Hawley street.

X Q. 23. Are you sure about it, or is it only a matter of opinion?

A. It can be verified by the directory.

Answer objected to as irresponsive, and question repeated.

X Q. 24. Are you sure about it or is it only a matter of opinion?

A. I don't see that I can give any better answer.

284 X Q. 25. Are the entries to which you refer in answer 15 to be found in any other book in your possession?

A. I can't say.

X Q. 26. Have you made any search or examination to ascertain that fact?

A. I have not.

X Q. 27. You say that you used these tag envelopes, as I understand you, some fifteen years ago. How did you use them?

A. I used them for the purpose of enclosing invoices to be attached to packages of merchandise; but to a very limited extent, and I discarded the use of them as I found they defeated the object they were designed for, as parties would fail to notice that an invoice was attached to the bundle, and were constantly writing for duplicate bills which we had to mail, thus entailing additional expense and annoyance.

All of the answer after the word "merchandise" objected to as volunteered testimony and irresponsive to the question.

X Q. 28. To whom did you send one of these tag envelopes, enclosing an invoice, fifteen years ago?

A. I can't tell.

X Q. 29. What is the earliest date which you can name, on which you sent one of these tag envelopes attached to a package of goods and enclosing the invoice, to any person whose name and address you can give?

A. I am unable to settle on any dates or address.

X. Q. 30. Have you any copy of order which you sent to Pultz & Walkley for such tag envelopes.

A. I don't think that I have. I rarely copy my orders or letters.

X Q. 31. Is the fact that these tag envelopes did not answer

285 the purpose for which they were designed, the real cause of your discontinuing their use?

A. It was the only reason.

X Q. 32. About what time did you discontinue said use?

A. I should think four or five years since.

X Q. 33. Have you not stated to the parties different reasons for discontinuing their use?

A. I may or may not; I don't remember.

X Q. 34. Did you not state to a gentleman who called on you for a tag envelope about the 22d or 23d of December last, that you discontinued the use of the tag envelope because of litigation between the Pultz & Walkley Company and the Dennison Company?

A. I don't know.

X Q. 35. Do you remember about that time, of being called on for a tag envelope to send to the State of Maine, and saying that you had discontinued the sale of them?

A. I have a vague remembrance of such, but my original reason for discontinuing the use of them was as I have stated before.

X Q. 36. Did you not at that time go out and procure a Dennison tag envelope for this gentleman?

A. I think a man employed by me did, and I think that the conversation was with him mainly.

X Q. 37. Did you not at that time state, as I have formerly asked you, about the litigation between the two parties?

A. I don't remember.

X Q. 38. Did you ever know of a litigation between the Pultz & Walkley Co., and the Dennison Co., concerning tag envelopes?

A. I heard rumors of somebody's infringement, but knew nothing of the details or merits.

X Q. 39. If Mr. Walkley, of Pultz & Walkley and persons
286 in his employ have fixed the earliest date at which they can testify of the manufacture of such envelopes by them at thirteen years ago, would you still believe that you bought such tag envelopes of them, and used them, fifteen years ago?

A. I gave my answer from memory as near as I could.

X Q. 40. When did you first see Exhibit Hall Tag Envelope, introduced by you in your testimony?

A. I can't say whether I ever saw that one before. I have been familiar with them ever since I first saw them; whether I ever saw that identical one before, I can't say.

X Q. 41. By "before," do you mean before this was handed to you by defendant's counsel at the time it was introduced?

A. I do, before this morning.

X Q. 42. Can you say whether this is in all respects like the first ones you purchased of Pultz and Walkley?

A. I should think it was, with the exception that I generally used them of a larger size.

X Q. 43. Were those which you say you so purchased plain, or did you have your address printed on them?

A. I think we used them plain, but were in the habit of writing the word "invoice" in large letters at the top, so that customers would detach and take their invoice from it.

X Q. 44. What did you pay for these envelopes at the time you purchased them?

A. I don't know.

HENRY K. W. HALL.

Attest: CHAS. H. SWAN,
U. S. Commissioner.

Defendant closes.

The time for taking rebutting testimony is extended to May 1, 1888.

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(No Model.)

J. T. DUNHAM.

COMBINED TAG AND ENVELOPE.

No. 277,245. Patented May 8, 1883.

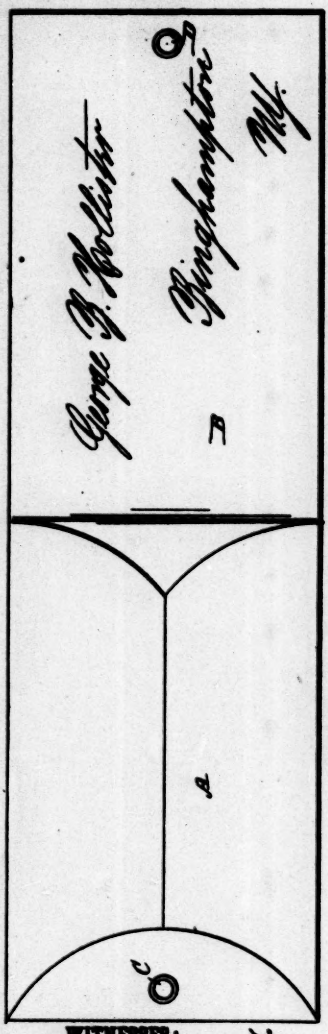

Fig. 1.

No. 294.
Dunham
v.
N. Mfg. Co
} p. 287.

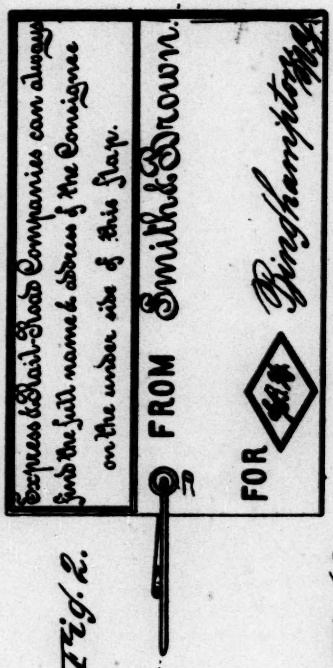

Fig. 2.

Fig. 3.

WITNESSES:
Thos. G. Hostler
A. Bridgwick

INVENTOR:
J. T. Dunham
BY Munn & Co
ATTORNEYS.

JOSEPH T. DUNHAM, of Brooklyn, New York.

Combined Tag and Envelope.

Specification forming part of Letters Patent No. 277,245, dated May 8, 1883. Application filed January 15, 1883. (No model.)

To all whom it may concern:

Be it known that I, Joseph T. Dunham, of Brooklyn, Kings county, New York, have invented a new and improved combined tag and envelope, of which the following is a full, clear, and exact description.

The object of the invention is to form an envelope with an end flap covering its side, as hereinafter described.

Reference is to be had to the accompanying drawings, forming part of this specification, in which similar letters of reference indicate corresponding parts in all the figures.

(Here follows diagram marked p. 287.)

Figure 1 is a longitudinal view of my improved combined tag and envelope, showing it opened. Fig. 2 is a longitudinal view of the same, showing it closed; and Fig. 3 is a longitudinal sectional elevation of the same on the line *x x*, Fig. 2.

An envelope, A, preferably made of strong water-proof paper, is provided with an end flap, B, of sufficient size to cover the entire envelope. An eyelet, C, is secured in that end of the envelope opposite to the one to which the flap B is attached, and the flap B is provided on its free end with an eyelet, D, which, when the flap B is folded over the envelope, rests upon the eyelet C. The full address of the consignee is written on the inner surface of the flap B, as shown in Fig. 1. The name, business address, trade-mark, &c., of the consignor or shipper are printed or otherwise produced on the outer surface of the flap B, and the initials or mark, &c., of the consignee and the destination of the invoice are written, printed, or otherwise produced on the inner surface of the flap B, as shown in Fig. 2. The following or similar information is printed on the outer surface of the flap B, at the top or bottom or ends of the same: "Express or railroad companies can always find the full name and address of the consignee on the under side of this flap."

The combined tag and envelope is used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over the envelope A, and a cord, hook, or other device for holding the tag to the box, barrel, package, &c., is passed through the eyelets C D, and is then secured to the package, &c., whereby it will hold the flap closed over the envelope; or the envelope can be tacked to the barrel, box, &c., and the free end of the flap is passed

under a metal, rubber, or oilcloth strip tacked transversely over that end of the envelope opposite to the one to which the flap is fastened, whereby the flap will be held closed over the envelope, and in either case can be easily opened in case an employé of a railroad or express company wishes to read the address written on the under side of the flap.

By using the above-described combined tag and envelope the bill or invoices can be sent with the goods, which is a matter of great importance, especially if the goods are perishable, as it is desirable that the purchaser is informed in regard to the prices of the merchandise as soon as possible, so that he can sell immediately. Furthermore, the address is concealed, and dealers cannot ascertain the addresses of the customers of their competitors. At the same time the express and railway companies can easily ascertain the addresses by raising the flap B.

If desired, the address, &c., shown in Fig. 3, can be printed or otherwise produced on the back of the envelope, and the flap placed under the envelope in attaching the name.

Having thus described my invention, I claim as new and desire to secure by letters patent—

1. A combined tag and envelope made substantially as herein shown and described, and consisting of an envelope having at one end a flap of sufficient size to cover one side of the envelope as set forth.

2. In a combined tag and envelope, the combination, with an envelope A, having a flap, B, at one end, of the eyelet D in the free end of the flap, and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described, and for the purpose set forth.

JOSEPH T. DUNHAM.

Witnesses:
OSCAR F. GUNZ.
C. SEDGWICK.

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v.
D. Mfg. Co.
} p. 289

S. Ullman,
Envelope.

No. 81.962. Patented Sep. 8. 1868.

Fig. 1.

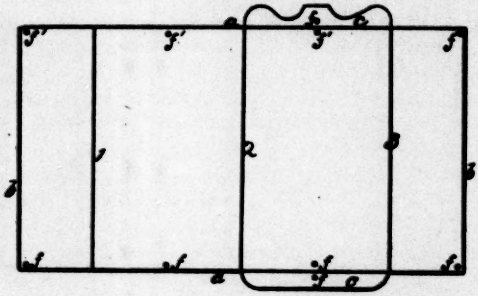


Fig. 3.

Fig. 2.

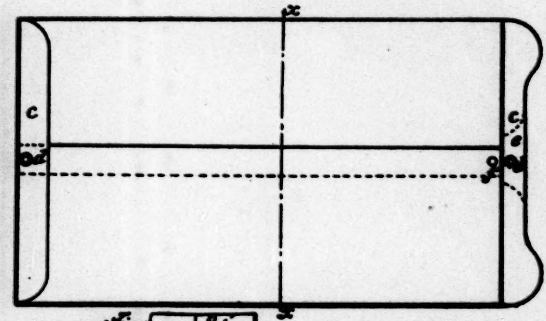


Fig. 4.

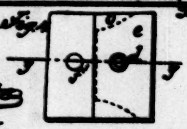


Fig. 5.

Witnesses,
H. C. Aulkettle
Theo Gnoche

Inventor.
S. Ullman
per Munn & Co
attorneys

SIGMUND ULLMAN, of New York, N. Y.

Letters Patent No. 81962, dated September 8, 1868.

Improvement in Envelopes.

The schedule referred to in these letters patent and making part of the same.

To all whom it may concern:

Be it known that I, Sigmund Ullman, of the city, county, and State of New York, have invented a new and improved envelope; and I do hereby declare that the following is a full, clear, and exact description thereof, which will enable others skilled in the art to make and use the same, reference being had to the accompanying drawings, forming a part of this specification.

This invention relates to a new and improved mode of cutting envelopes, whereby the same, when folded and fastened or sealed, will not admit of letters or documents being abstracted without defacing or tearing the envelopes.

The invention further relates to a new and improved application of an eyelet-seal or fastening to the envelope, whereby the former are permanently attached to the latter, so that they may be sold with them, and purchasers or users enabled to seal the envelopes with the greatest facility.

Hitherto, envelopes which have been sealed with eyelets have been sold separately from the latter, and the purchasers or users were required to purchase two different articles, envelopes and eyelets, which causes considerable difficulty and embarrassment, and therefore they have not come into general use.

In the accompanying sheet of drawings—

(Here follows diagram marked p. 289.)

Figure 1 represents a view of an envelope in an open or unfolded state, and cut according to my invention.

Figure 2, an enlarged view of the same in a folded state.

Figure 3, a transverse section of Fig. 2, taken in the line *x x*, Fig. 2.

Figure 4, a view of a portion of the same, in which the seal-eyelet is fitted.

Figure 5, a section of Fig. 4, taken in the line *y y*.

Similar letters of reference indicate corresponding parts.

The main portion or body of the envelope is of rectangular form, or has parallel edges, *a a*, and ends, *b b*, and is folded three times, as indicated by the figures 1, 2, 3, in Fig. 1.

The portion of the envelope included between the folds 2 and 3 has small flaps, *c c'*, at its ends, and these flaps comprise the only

variation the envelope has from a rectangular form. The position of the folds, when the envelope is closed up, is shown clearly in Fig. 3, the letter or document being shown in red.

When the flaps *c c'* are turned over, and one eyelet, *d*, passed through them, every part formed by the three folds, 1, 2, and 3, will have the eyelet passing through them, as indicated by the holes *f f'* in Fig. 1.

In putting up the envelopes for sale, the eyelet of the flap *c* is riveted, and said flap gummed down. The other flap, *c'*, is left open, and its eyelet, *d*, secured in it, by gumming a strip of paper or other suitable material, *e*, over said eyelet, at the outer side of the flap, and over the inner side also, if desired, (see more particularly Fig. 5). By this means the eyelet is secured to envelope, and is put up and sold with them, eyelet-holes, *f'*, being made through the end of the envelope, to receive the eyelet, so that all the purchaser or user is required to do, in order to seal the envelope, is to moisten the inner side of flap *c'*, turn it over, and pass the eyelet through the holes *f'*, press the flap against the body of the envelope, so that it will be gummed thereto, and then rivet the eyelet, which may be done by means of a small punch or other suitable device.

The object in gumming the flaps *c c'* is simply to prevent envelopes catching into each other in their transit through the mail. The gumming adds nothing to security; the eyelets are sufficient for that purpose.

The object in folding the envelope three times in the lines 1, 2, 3, is to produce an increased number of folds for the eyelet to pass through, as each additional fold increases the difficulty of opening the envelope without detection.

Having described my invention, I claim as new, and desire to secure by letters patent—

Securing the eyelet *d* in the open flap *c* of the end, by gumming a strip of paper over said eyelet, at the outer side of the flap, as herein shown and described.

SIGMUND ULLMAN

Witnesses:
WM. F. McNAMARA.
ALEX. F. ROBERTS.

291

A. H. SCHULTZ.
Sample-Envelopes.

No. 219,879. **Patented Sept. 23, 1879.**

No. 294
Dunham
v.
D. Mfg. Co.
p. 291

Fig 1

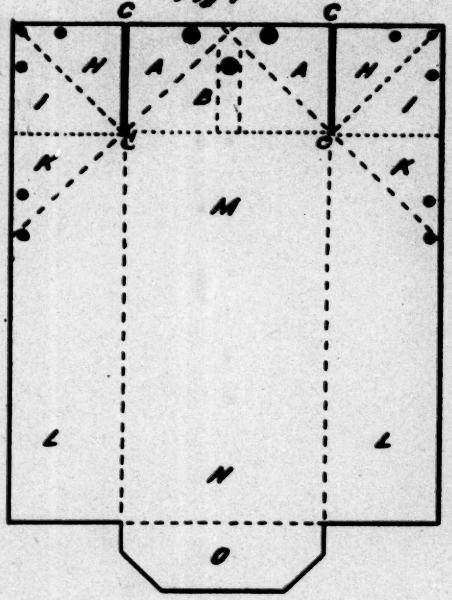
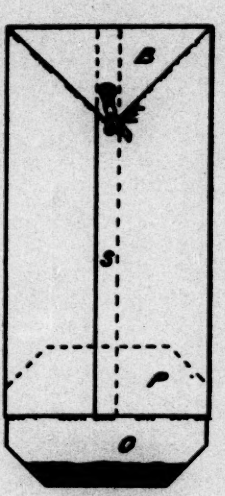


Fig 2



Witnesses -

[illegible]

[illegible]

Inventor.

Abm. H. Schultz

ALEXANDER H. SCHULTZ, of New York, N. Y.

Improvement in Sample-envelopes.

Specification forming part of Letters Patent No. 219,879, dated September 23, 1879; application filed October 4, 1878.

To all whom it may concern:

Be it known that I, Alexander Hamilton Schultz, of the city, county, and State of New York, have invented a new and useful improvement in sample-envelopes for third-class mail-matter; and that the following is a full and exact description thereof, with reference to the accompanying drawings, forming a part of this specification.

My invention consists of an envelope of peculiar construction, closed at the top with tape or other fastening, that can be readily undone by officials of the Post-Office Department for the required examination of third-class mail-matter, as in other packages of that nature. The lower flap of the envelope is left opened and gummed ready for sealing, samples to be sent through the mail being here inserted and the flap sealed securely.

(Here follows diagram marked p. 291.)

In the accompanying drawings, figure 1 represents the envelope cut and creased ready for folding. The corners H H are folded on dotted lines upon I I, and these are again folded down upon K K. The two parts K L and K L are then brought together and pasted along the seam S (shown in Fig. 2) and two eyelet-holes punched, as shown in both figures. The corners A A are turned down upon B, slightly overlapping, and larger eyelet-holes punched, as indicated.

Fig. 2 shows this flap B turned down and tied by tape E, while the lower flap, O, is gummed and left open ready for sealing, which, when sealed, covers dotted lines at P.

The advantages of constructing an envelope on this principle are, that I get three and six thicknesses of paper where tape passing through eyelet-holes would otherwise require extra strengthening by insertion of metallic or other eyelets, and that parties having occasion to send off large quantities of samples or other third-class mail-matter, can do so in a neatly-tied package without the delay of tying tape, strings, &c., when the hurry of business demands their early dispatch.

What I claim, and wish to secure by letters patent, is—

The envelope herein described, consisting of the body M N, having the lower gummed open flap, O, slits C C, and upper flap having its corners A A, turned down upon its central part, B, corner flaps having the parts H thereof folded over the parts I, and both

over the side flap, K L, of the same width, and folded with the corner flaps inwardly, the upper flap, corner flaps, and side flaps being provided with holes passing through several thicknesses of the flaps for the reception of removable tapes securing the upper end of the envelope, substantially as described, and for the purpose set forth.

ALEX'R HAMILTON SCHULTZ.

Witnesses:
N. J. VANDER WEYDE.
WM. S. PURDY.

293

K. TOMPKINS.
Envelope.

No. 227,077. **Patented April 27, 1880.**

Fig. 1.

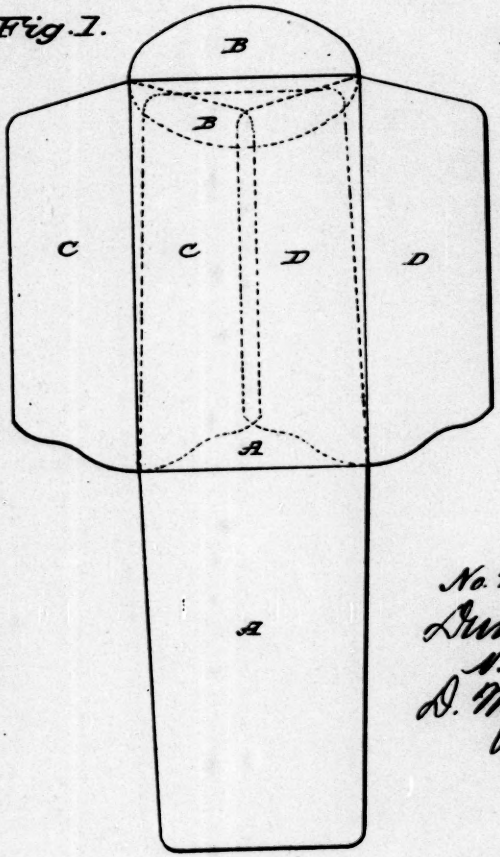


Fig. 2.

No. 294.
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v.
D. Mfg. Co.
p. 293

Witnesses:
Fred. W. Littlefield
T. C. Lewis

Inventor:
Kilbourne Tompkins

KILBOURNE TOMPKINS, of New York, N. Y.

Envelope.

Specification forming part of Letters Patent No. 227,077, dated April 27, 1880. Application filed December 9, 1879.

To all whom it may concern:

Be it known that I, Kilbourne Tompkins, of the city, county, and State of New York, have invented certain improvements in envelopes, of which the following is a specification.

The invention relates to envelopes made of paper or other material to be used in transmitting through the United States mails pieces of muslins, laces, silks, cloths, or other mailable articles, and which may be made of any size or shape.

(Here follows diagram marked p. 293.)

In figure 1 the dark lines show the envelope before folding, the dotted lines representing it after being folded. Fig 2 is a longitudinal sectional view of the completed envelope.

In the drawings, A and B represent the end flaps of the envelope, and C and D represent the side flaps of the envelope.

The invention consists in making the end flap, A, long enough to reach, when folded, nearly or quite to the bottom or opposite end of the envelope, and as near to the full width of the envelope in the other direction as it can be made, and folded inside under the flaps C and D, which are folded over the flap A and pasted (the flaps C and D) one to the other, so as to allow the flap A to be withdrawn from within the envelope without destroying the envelope, so that when mailable articles are placed within the envelope they are securely kept and protected, the flap B being fastened on the outside of the envelope with gum or wax or other sealing material, while the end where the flap A is folded in remains unsealed, in compliance with the regulations of the Post-Office Department for transmitting articles through the mails at the cheaper rates of postage.

My invention is used as follows: When it is desired to fill the envelope it is held in the hand with the flap B upward; then, by squeezing the envelope, the sides are distended and the envelope becomes shaped like a bag, into which the articles to be inclosed are placed through the opening in the end covered by the flap B, under the flap A, which, being folded inside the envelope, forms the bottom of the bag made by distending the sides of the envelope. After the articles are placed within the envelope the flap B may be sealed. The envelope, with its contents, will then be in condition for examination, in compliance with the regulations of the Post-Office Department, which examination can be made by withdrawing the flap

A and removing the contents of the envelope through that end of the envelope. After examining the contents they can be returned to the envelope and the flap A can be replaced, leaving the envelope and its contents in the same condition as before the examination, no seals having been broken.

I am aware that envelopes are now made for the same purpose for which my improvement may be used; but instead of having, like mine, a flap A, folded inside the envelope, they have a flap folded outside and fastened with tape or cord or other similar devices.

Some of the advantages of my improvement are, that the construction of the envelope is more simple, that the examination of the contents can be more easily made, and that the cost of the envelope is less.

What I claim is—

An envelope consisting of the back, the ungummed end flap, A, of substantially the size of the back, the gummed side flaps, C D, and short closing flap B, the whole constituting a sample envelope, as described.

KILBOURNE TOMPKINS.

Witnesses:
GEORGE TOMPKINS.
JAMES DRENNAW.

295 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United States court-rooms, in the city of New York, on Tuesday, the third day of December, in the year of our Lord one thousand eight hundred and eighty-nine.

Present: The Honorable Alfred C. Coxe, judge.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY. } Final Hearing.

The above-entitled cause coming on for final hearing upon the pleadings and proofs—

Walter F. Poor, Esq., is heard in behalf of complainant; W. W. Swan, Esq., is heard in behalf of defendant.

C. A. V.

296 United States Circuit Court, Southern District of New York.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY. } In Equity.

Walter S. Poor, for the complainant; W. W. Swan, for the defendant.

COXE, *J.:*

This is an equity action founded upon two letters patent granted to the complainant. The first, a reissue patent, No. 10488, dated

June 10, 1884, is for a combined tag and envelope, and the reissue, No. 331,118, dated November 24, 1885, is for an improvement in envelopes. The reissued patent will be first considered. The defenses are lack of novelty and invention, non-infringement, and that the reissue is void because of an unwarrantable expansion of its claims. The original patent, No. 277,245, was dated May
297 8, 1883. The application for the reissue was filed March 18, 1884, ten months and ten days thereafter.

The invention of the original was limited, as clearly as the drawings and the language of the description and claims could limit it, to an envelope having at one end a flap of sufficient size to cover one side of the envelope. The inventor says: "The object of the invention is to form an envelope with an end flap covering its side, as hereinafter described. * * * An envelope, A, preferably made of strong water-proof paper, is provided with an end flap, B, of sufficient size to cover the entire envelope. An eyelet, C, is secured in that end of the envelope opposite to the one to which the flap B is attached, and the flap B is provided on its free end with an eyelet, D, which, when the flap B is folded over the envelope, rests upon the eyelet C." He then describes the manner in which the name of the consignee is concealed by writing it on the inside of the flap, so that dealers engaged in the same business cannot ascertain the names of their rivals' customers. The name of
298 the consignor is printed on the outer surface of the flap, where also appears the name of the city or town to which the goods are destined, and a notice to carriers that the full name of the consignee may be found on the inner surface.

It is evident that the patentee considered this peculiar form of flap the main feature of his invention. It is also clear that an envelope which does not include a flap large enough to cover its side does not infringe the claims, which are as follows:

"1. A combined tag and envelope, made substantially as herein shown and described and consisting of an envelope having at one end a flap of sufficient size to cover one side of the envelope, as set forth.

"2. In a combined tag and envelope, the combination, with an envelope, A, having a flap, B, at one end, of the eyelet D in the free end of the flap and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described and for the purpose set forth."

299 The specification is perfectly plain. There is no ambiguity about the description, and the claims, in language equally clear, cover what is said to be the invention and the whole thereof.

Soon after the patent was granted the defendant in the summer of 1883 commenced manufacturing tag envelopes, which the complainant insists are infringements of the reissue, but frankly admits that they do not infringe the original patent, for the reason that they do not have the flap B.

The reason for the reissue is thus stated in the complainant's brief: "Soon after putting the patented article on the market complainant was informed that defendant, a corporation that had for

some time manufactured in Boston and made extensive sales throughout the country of a shipping tag, was manufacturing and selling a tag envelope similar to complainant's. Complainant immediately applied to counsel for the purpose of commencing suit against defendant and was advised by such counsel, after an exam-
300 ination of his letters patent and a statement of his invention and application, that his patent was defective, indefinite, and ambiguous in its claims, so as to render it practically inoperative, and that he had better apply for a reissue."

The patentee himself states that the alleged infringing envelope of the defendant was one of the forms "invented by him, but not shown in his patent," and he therefore sought a reissue which would cover it.

Turning now to the reissue, it is manifest that the effort was to discard the flap B as an element of the invention, and *and* expand the claims sufficiently to cover an envelope no matter what the size or shape of its flap. The invention no longer consists in "an envelope with an end flap covering its side," as in the original, but "in a tag provided with means for attaching it to the merchandize, and with an envelope or pocket to receive a bill or invoice of the merchandise." The drawings are referred to as showing the invention "in its preferred form." The end flap is no longer "of sufficient size to cover the entire envelope," but it must cover it "substantially."

301 The claims of the reissue are as follows:

"1. A combined tag and envelope, substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise, as set forth.

"2. A combined tag and envelope, substantially as described, the flap having an eyelet hole which, when the flap is folded down on the envelope, coincides with an eyelet hole in the envelope, whereby the cord or hook for attaching the tag may be passed through both holes, substantially as set forth.

"3. In a combined tag and envelope, the combination, with an envelope, A, having a flap, B, at one end, of the eyelet D in the free end of the flap and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described and for the purpose set forth."

The third claim of the reissue is the same as the second of the original, but it is not contended that this claim is infringed.

Claims one and two of the reissue are unquestionably broad-
302 ened. They are no longer limited to a flap of sufficient size to cover the entire envelope.

Should the court hold that they are so limited it is admitted that they are not infringed.

It is thought that these expanded claims cannot escape the force of the repeated decisions of the Supreme Court relating to reissued patents.

The patentee made no move until the defendant had produced its envelope, which could be sold without infringing the original

patent. If he had been the first inventor of this new and improved form he might have described and claimed it in the original patent. He did neither. He now seeks by the reissue to include structures and improvements which were neither described nor claimed in the original. This he cannot do.

The defendant has acquired valuable rights which cannot be trampled upon in this manner. The law upon this subject is too well settled to require a citation of authorities, but the case of Coon *v.* Wilson, 113 U. S., 268, seems peculiarly applicable and controlling. By substituting the nomenclature pertaining to envel-
303 opes for that relating to collars the opinion in Coon and Wilson is as applicable to this controversy as if written for the purposes of this action only. "Although this reissue was applied for a little over ten months after the original patent was granted, the case is one where it is sought merely to enlarge the claim of the original patent by repeating that claim and adding others; where no mistake or inadvertence is shown, so far as the extended flap is concerned; where the patentee waited until the defendant produced its short-flapped envelope and then applied for such enlarged claims as to embrace the defendant's envelope, which was not covered by the claim of the original patent, and where it is apparent, from a comparison of the two patents, that the reissue was made to enlarge the scope of the original. As the rule is expressed in the recent case of Mahn *vs.* Harwood, 112 U. S., 354, a patent cannot be lawfully reissued for the mere purpose of enlarging the claim unless there has been a clear mistake, inadvertently committed, in the wording of the claim, and the application
304 for a reissue is made within a reasonably short period after the original patent was granted; but a clear mistake, inadvertently committed, in the wording of the claim is necessary without reference to the length of time. In the present case there was no mistake in the wording of the claim of the original patent. The description warranted no other claim. It did not warrant any claim covering 'an envelope not provided with the flap B.'"

The second patent in controversy, No. 331,118, dated November 24, 1885, is for an improvement in envelopes intended for mailing samples and similar matter and for use as tags for marking goods to be shipped.

The defenses are abandonment, lack of novelty and invention, and non-infringement.

The principal object of the invention, as stated in the specification, was to obviate the difficulty which existed in prior devices, which were so constructed that in order to get at the contents of the envelope it was necessary to untie the string or remove the
305 fastening which secured the flap. The envelope of the patent is so constructed that the flap can be opened when desired and the contents inspected without tearing the envelope or removing or breaking the fastenings. The claims are as follows:

"1. An envelope having a flap, C, provided with a reinforced hole, *c'*, and having a similar hole, *c*, in the front ply of its body, and the said holes constructed to register or coincide when the flap

C is folded down, whereby the end of the back ply *b* of the envelope body, which extends entirely across the latter, is clamped and removably secured, substantially as shown and described.

"2. A mailing and tag envelope having a flap, C, folded over and secured down to the inner face of the front ply of the body, the said flap being also constructed to take over the free end of the back ply of the body, as shown, whereby the mouth of the envelope covered by the said flap C is secured against accidental opening, substantially as and for the purposes set forth."

In view of what was known when the patent was applied
306 for, a broad construction of these claims is out of the question.

A construction which would include the defendant's envelope would render the claims void for lack of novelty, for the general features of the patented envelope are shown in the patent No. 81962, September 8, 1868, to Sigmund Ullman, and in other prior structures. If the claims are limited to the peculiar construction shown in the specification and drawings, the defendant does not infringe.

In the defendant's envelope one eyelet is used, which aids the gum in fastening the flap down permanently upon the back ply of the envelope.

A large number of exhibits have been introduced since the defendant's envelope. These have been changed and mutilated by the witnesses in illustrating opposing theories. But both sides apparently agree that the envelopes made by the defendant since the date of this patent are constructed with the eyeletted flap securely fastened. The complainant's brief contains this statement: "After defendant put its tag envelope on the market it changed the construction several times, until it finally adopted the form in-
307 troduced in evidence as the infringing specimen. See Complainant's "Exhibit Taylor and Mayo," which was received in 1883, and also has the eyelet-holes, with washers only; also Complainant's "Exhibit John S. Smith," which was received in 1884, and has the washers reinforced with a short metallic eyelet, with the eyeletted end tightly gummed down; also "Exhibit Alonzo B. Smith," received in 1886, with printed advertisement on front, which had the eyeletted end tightly gummed, with washers reinforced by short metallic eyelets."

Evidently it is not intended that the defendant's envelope shall be opened and the contents removed at the end thus securely fastened. The bill or invoice is inserted at the opposite end; the flap at that end is then fastened down in the well-known manner by moistening the gum by which it is provided, or the flap may be tucked in between the plies; in other words, the defendant takes an ordinary envelope with the opening at one end, and at the other end, which is never intended to be opened, he puts an eyelet reinforced by washers through the front ply, a portion of the back ply,
308 and the flap of the envelope. The sole object of the eyelet is to provide a suitable hole into which the cord or hook which fastens the envelope to the merchandise may be introduced. The effect of the eyelet and washers is to prevent the back ply from be-

ing left free at this end. The defendant has not the object of the patent in view and does not adopt the patented device.

In complainant's envelope, according to the theory of his expert witness, "the leading idea or principle of the invention is the holding down of the back ply of the envelope by the overlapping of the flap thereon and the omission of any permanent or secure attachment of the flap to said back ply. * * * The claims are limited to this end of the back ply being left free."

This feature is entirely wanting in defendant's envelope. Instead of omitting the secure attachment he has added the metallic eyelet and washers to the gum of the ordinary envelope.

The claims must be restricted to the form and description of the patent, and thus construed they are not infringed.

It is unnecessary to examine the other defenses presented. The bill is dismissed.

309 (Endorsed:) United States circuit court, southern district of New York. Joseph T. Dunham *v.* The Dennison Manufacturing Company. Decision. Coxe, J.

(File-mark:) U. S. circuit court. Filed Dec. 20, 1889. John A. Shields, clerk.

310 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United States court-rooms, in the city of New York, on Friday, the 9th day of May, in the year of our Lord one thousand eight hundred and ninety.

Present: The Honorable Alfred C. Coxe, judge.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY. } In Equity. No. 4054.

This cause having come on for final hearing upon the pleadings and proofs, and after hearing Mr. Sam. Tro. Smith, of counsel for the complainant, and Mr. W. W. Swan, of counsel for the defendant, and due deliberation having been had, it is, on motion of W. W. Swan, complainant's solicitor—

Ordered, adjudged, and decreed that the bill of complaint herein be, and the same is hereby, dismissed with costs to the defendant, taxed at three hundred eighty-one $\frac{35}{100}$ dollars, and that he have execution therefor.

ALFRED C. COXE.

Approved as to form.

DUFFY & SMITH,
Att'ys for Complainant.

311 (Endorsed:) Circuit court of the United States for the southern district of New York. Joseph T. Dunham *vs.* The Dennison Manufacturing Company. Final decree. U. S. circuit court. Filed May 10th, 1890. John A. Shields, clerk.

312 Circuit Court of the United States, Southern District of New York.

JOSEPH T. DUNHAM, Complainant and Appellant,
vs.
THE DENNISON MANUFACTURING COMPANY, Defendant and Respondent.

The above-named complainant, Joseph T. Dunham, conceiving himself aggrieved by the decree entered on the 10th day of May, 1890, in the above-entitled proceeding, doth hereby appeal from said decree to the Supreme Court of the United States, and he prays that this his appeal may be allowed, and that the transcript of the record, proceedings, and papers upon which said decree was made, duly authenticated, may be sent to the Supreme Court of the United States.

Dated New York, May 21st, 1890.

(Signed) DUFFY & SMITH,
Solicitors for Complainant and Appellant, Joseph T. Dunham.

313 132 Nassau street, New York, N. Y.

And now, to wit, on May 23rd, 1890, it is ordered that the appeal be allowed as prayed for.

(S'g'd.) ADDISON BROWN.
U. S. Dist. Judge.

(Endorsed:) U. S. circuit court, so. dist. of New York. Joseph T. Dunham, complainant and appellant, against The Dennison Manufacturing Company, defendant and respondent. Appeal and allowance. Due service of the within appeal and allowance is hereby admitted this 27 day of May, 1890. (S'g'd) Wm. W. Swan, def't's att'y.

(File-mark:) U. S. circuit court. Filed July 14, 1890. John A. Shields, clerk.

314 Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

JOSEPH T. DUNHAM
vs.
THE DENNISON MANUFACTURING COMPANY. } Bond for Damages and Costs.

Know all men by these presents that we, Joseph T. Dunham, George H. Babcock, of 30 Courtland street, New York city, and Plainfield, New Jersey, and William P. Raynor, of 115 William street, N. Y., and New Brighton, S. I., New York, are held and firmly bound unto the above-named The Dennison Manufacturing Company in the sum of seven hundred and seventy dollars, to be paid to the said Dennison Manufacturing Company; for the payment of which, well and truly to be made, we bind ourselves and each of us, our and each of our heirs, executors, and administrators, jointly and severally, firmly by these presents.

Sealed with our seals and dated the twentieth day of May, in the year of our Lord one thousand eight hundred and ninety.

Whereas the above-named Joseph T. Dunham has prosecuted an appeal to the Supreme Court of the United States to reverse the judgment rendered in the above-entitled suit, by the judge of the circuit court of the United States for the southern district of New York:

Now, therefore, the condition of this obligation is such that if the above-named Joseph T. Dunham shall prosecute said appeal to effect and answer all damages and costs if he shall fail to make his appeal good, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

JOSEPH T. DUNHAM. [L. S.]
GEORGE H. BABCOCK. [L. S.]
WM. P. RAYNOR. [L. S.]

Sealed and delivered and taken and acknowledged this twentieth day of May, 1890, before me—

GARDINER MERRITT,
Notary Public, N. Y. Co.

315 [Endorsed:] U. S. circuit court, southern district of New York. Joseph T. Dunham *vs.* The Dennison Manufacturing Company. Bond for costs on appeal to U. S. Supreme Court. Duffy & Smith, att'ys for plaintiff and appellant, 132 Nassau St., N. Y. city. The within bond is approved as to form, amount, and sufficiency of the sureties. Dated N. Y., May 23, 1890. Addison Brown, judge. U. S. circuit court. Filed May 23, 1890. John A. Shields, clerk.

UNITED STATES OF AMERICA, }
Southern District of New York, } *ss:*

George H. Babcock and William P. Raynor, being severally duly sworn, each deposes and says that he is worth the sum of fifteen hundred and forty ($1,540.00) dollars over and above all his just debts and liabilities.

GEORGE H. BABCOCK.
WM. P. RAYNOR.

Sworn to this twentieth day of May, A. D. 1890, before me—
[SEAL.] GARDINER MERRITT,
Notary Public, N. Y. Co.

316 UNITED STATES OF AMERICA, *ss:*

To the Dennison Manufacturing Company, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October, 1890, pursuant to an appeal filed in the clerk's office of the circuit court of the United States of the

southern district of New York, wherein Joseph T. Dunham is appellant and The Dennison Manufacturing Company is respondent, to show cause, if any there be, why the decree in the said appeal mentioned should not be corrected and speedy justice should not be done to the parties on that behalf.

Witness the Hon. Melville W. Fuller, Chief Justice of the United States, this 23d day of May, in the year of our Lord one thousand eight hundred and ninety.

ADDISON BROWN.
Dist. Judge.

317 (Endorsed:) U. S. circuit court, so. dist. of New York. Joseph T. Dunham, plaintiff, against The Dennison Manufacturing Company, defendant. Citation on appeal. Duffy & Smith, attorneys for pl't'ff & appellant. Walter S. Poor, counsel, 132 Nassau street, New York city. Due service of the within citation on appeal is hereby admitted this 27 day of May, 1890. William W. Swan, def't's att'y. U. S. circuit court. Filed Jul- 14, 1890. John A. Shields, clerk.

318 UNITED STATES OF AMERICA, } ss:
Southern District of New York, }

I, John A. Shields, clerk of the circuit court of the United States of America for the southern district of New York, in the second circuit, do hereby certify that the foregoing pages, numbered from one to 317, inclusive, contain a true and complete transcript of the record and proceedings had in said court in the case of Joseph T. Dunham, complainant & appellant, against The Dennison Manufacturing Company, defendant and appellee, as the same remain of record and on file in said office.

Seal of U. S. Circuit Court, South. Dist. New York.

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the city of New York, in the southern district of New York, in the second circuit, this 16th day of October, in the year of our Lord one thousand eight hundred and ninety, and of the Independence of the United States the one hundred and fifteenth.

JOHN A. SHIELDS, *Clerk.*

Endorsed on cover: Case No. 14,335. S. New York C. C. U. S. No. 294. Joseph T. Dunham, appellant, *vs.* The Dennison Manufacturing Company. Filed October 18, 1890.

FILED.
MAR 12 1894
JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States.

OCTOBER TERM, 1893.

No. 294.

JOSEPH T. DUNHAM, APPELLANT,

vs.

THE DENNISON MANUFACTURING COMPANY,
APPELLEE.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

BRIEF FOR APPELLANT.

ARTHUR S. BROWNE,
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Counsel.

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Supreme Court

OF THE UNITED STATES.

OCTOBER TERM, 1893.

JOSEPH T. DUNHAM, Appellant, vs. THE DENNISON MANUFACTURING COMPANY, Appellee.	No. 294.

BRIEF FOR APPELLANT.

I.

General Statement.

This is an appeal from a decree in equity made on the 9th day of May, 1890, dismissing complainants' bill. The case is reported in 40 Federal Reporter, p. 668.

The Bill of Complaint, so dismissed, charged the defendant, the Dennison Manufacturing Company, with infringing reissued letters patent of the United States, No. 10,488, granted to the complainant on the 10th day of June, 1884, the said patent being a reissue of the original letters patent No. 277,245, granted to the complainant on the 8th day of May, 1883.

The reissue was applied for on the 18th of March, 1884, ten months and ten days after the grant of the said original patent.

The said reissued patent was for a combined tag and envelope.

The bill of complaint further charged the defendant with infringement of letters patent No. 331,188, granted to the complainant on November 24th, 1885, being also for a tag envelope and involving subsidiary improvements. The bill was dismissed in the Court below on the ground that the reissued patent No. 10,488 was invalid generally under the decisions of the Court relating to reissues, and especially because the reissue patent had enlarged claims.

The bill was dismissed as to the second patent, No. 331,118, on the ground that on the evidence disclosed by the record the defendant did not infringe. The opinion of the Circuit Court and its specific reasons for its decisions, are to be found at p. 180 of the record.

In both of these holdings it is respectfully submitted that the Circuit Court erred.

This brief takes up, in the first place, the validity of the reissue, but before doing so, it is advisable to describe what the Dunham invention is, how it arose, and the state of the art prior to said invention.

The reissue patent is found at page 87 of the record, the original patent at page 85, and the remaining Dunham letters patent at page 89 of the record.

II.

The Dunham Invention of the Original and Reissue Patent.

Fortunately for the appellant, the defendant for purposes of its own, offered in evidence an affidavit made by Mr. Dunham, on a motion for preliminary injunction (p. 135–140), which affidavit gives a clear and connected statement of the state of the art prior to the invention, how it arose, its immediate success and rapid growth and the extent and value of its usefulness.

His affidavit, together with the testimony in the suit, shows plainly the following statement of facts. Previous to 1883, the date of the Dunham invention, goods to be shipped were marked by the marking pot and brush, by written directions on the box or package itself, or on a paper or card attached to the box or package, or by the use of a shipping tag, like the Dennison shipping tag, manufactured and sold by the Defendant Corporation, which tag was an oblong card of stout paper, having a hole at one end for the attaching string, which hole and string constituted a "tag" instead of a card.

p. 34, folios 61–62.
p. 40, folio 71.
p. 41, folios 72–73.
p. 145, folios 221–222.
p. 137, folio 224.

With all these methods, the invoice had to be sent by mail, throwing an extra duty on the shipping clerk, and an extra expense for postage and envelope, and frequently delaying the arrival of the invoice until after the receipt of the goods, to the annoyance and damage of shipper and receiver. This was especially the case with perishable goods, and shippers of such goods had tried many ways to overcome this difficulty.

p. 34, folio 61.
p. 135, folio 222.

Of course, these sales do not include the millions of tag envelopes sold by the Dennison Manufacturing Company and other infringers.

It is clear, therefore, that the invention was not a transient fashion, for the day only, depending on mere push and advertising for success. It has taken its place on its merits among the articles of lasting value and usefulness sold throughout the country.

III.

Validity of Dunham Reissue Patent.

The Circuit Court decides that the reissue is invalid.

1. Because the First and Second claims of the reissue are broadened, and in view of repeated decisions of the Supreme Court relating to reissues, such claims are, therefore, invalid.

2. Because the facts relating to such reissue are so analogous to those of *Coon* vs. *Wilson* (113 U. S. Reports, p. 268), that, as the reissue in that case was declared invalid, the reissue in the present case must also be invalid. In both of these holdings, we think it can be clearly shown that the Circuit Court erred.

The case was decided by the Circuit Court in 1889, three years before the decision of the Supreme Court in suit of *Topliff* vs. *Topliff*, (145 U. S., p. 156), which states as follows in regard to reissued or broadened claims:

"To hold that a patent can never be reissued for "an enlarged claim would be not only to override "the obvious intent of the statute, but would oper- "ate in many cases with great hardship upon the "patentee."

The Court further states the principles by which the question of validity or non-validity of a reissue are to be determined, substantially as follows:

1. The invention of the reissue patent must be the same as that of the original.

2. There must be due diligence used in discovering the mistake, two years delay being generally fatal.

3. The Commissioner of Patents is to determine the question of inadvertence, accident or mistake, and his decision will not be reviewed by the Court unless the matter is manifest error from the Record.

The reissue decisions of the Supreme Court since the Topliff case, have not, as we understand, varied the rules then laid down.

In case of the Boyle reissue, *Huber* vs. *Nelson Manufacturing Company* (148 U. S., p. 270), it was specifically decided on the facts of that special case, that the reissue was for a *different* invention from that of the original patent.

In case of *National Meter Co.* vs. *Yonkers* (149 U. S. Reports, p. 48), it is expressly stated that the case is decided simply on the question of non-infringement.

In case of *Corbin Cabinet Lock Co.* vs. *Eagle Lock Co.* (150 U. S., p. 38), the application for reissue was not only made some three years after the grant of the original patent, but the claim in controversy was shown substantially to have been rejected in the application for original patent on references as cited by examiner.

In the very recent case of *Wollensak* vs. *Sargent & Company*, decided January 8, 1893 (66 O. G., p. 1007) the application for reissue was made years after the grant of the original patent. As we understand, therefore, the principles laid down in the Topliff case still apply.

Taking up the question of inadvertence, accident or mistake, the statement of the applicant for reissue found at page 116 of the Record, shows good and substantial grounds for his application for reissue.

His reasons so stated convinced the Commissioner of Patents that there had been a genuine mistake made, that by reason thereof, the patent was so inoperative as to deprive the patentee of the full benefit of his invention, and that such mistake had arisen from inadvertence and accident, and no fraudulent or deceptive intention on the patentee's part. There is nothing manifest in the record to show that the statement made by patentee on the question of inadvertence, accident or mistake, is not a truthful statement, and therefore we submit this question under its ruling in the Topliff case will not be reviewed.

The explanation of the reasons for the application for reissue are fully set forth in the patentee's statement accompanying such application found at pages 116 and 117 of the Record.

The failure of the original patent to protect the invention is thus stated. The language of the claims so restricts the scope of the patent, "that "anyone may readily construct a combined tag and "envelope that will fulfill all the essential require- "ments, by so constructing the flap that it will not "cover the side of the envelope, and having the "holes for attachment at some place other than the "end opposite that to which the flap is attached, "and thus evade the patent and render it practi- "cally inoperative and worthless as a protection."

In other words, the claims of the original patent made the whole invention hang on the length of the flap. By simply shortening the flap and placing the holes for attaching the tag envelope at another place, the spirit of the invention is fully appropriated without infringing the claims.

How this mistake occurred is amply shown in the statement. The appellant was entirely ignorant of

patent matters. He went to a firm of New York solicitors of wide reputation, and they referred him to one of their subordinates or assistants. He fully explained the invention to such assistant, impressing upon him his wish to obtain broad claims, and especially explaining to him that he desired the patent so drawn that the claims should cover a short flap as well as a long one, and should protect the placing of the attachment holes at either end of the envelope.

In some way the assistant misunderstood, and the original patent was taken out with the limited claims.

After the grant of the patent, the patentee not knowing anything about patents, supposed he was protected, as he was told so by the assistant or subordinate of the firm who obtained the patent and by others to whom he was referred, on whose statements he thought he could rely. On taking the patent to an experienced patent lawyer, he at once found out his mistake, and took immediate steps to rectify the error. From the time of the grant of the original patent to the application for reissue, only a little over ten months time elapsed. We have then all the necessary requisites for obtaining a reissue under the Statute. A clear mistake, a reasonable excuse, and not a unreasonable delay. That the delay of ten months in this case is not unreasonable, is, we think clearly held by the latest case in this Court, *Wollensak* vs. *Sargent & Co.*, reported in Official Gazette, Vol. 66, p. 1009, where the rule of law as to delay and diligence in obtaining reissues is thus laid down:

"While no invariable rule can be laid down as to "what is reasonable time in which the patentee "should seek for the correction of a claim which he "considers too narrow, a delay of two years, by "analogy to the law of public use, before an ap- "plication for a patent, should be construed equally "favorably to the public, *and that excuse for any* "further delay than that should be made manifest

" by the *especial circumstances of the case.*" The italics are ours and we emphasize the language, because it is clear to our minds, that, where, as in the present case, a clear mistake is shown arising from misunderstanding, a delay of ten months in applying for the patent is not unreasonable, and does not require any special circumstances to explain it. In this Wollensak case, the blame of the delay was thrown on the solicitor, but there was so many years delay in applying for the reissue, that the Court decided that whatever rights the patentee had originally, had been lost by the four years or more delay.

Here is then the case of the claims of a patent failing to protect, through a clear mistake, a satisfactory explanatiom of such mistake, which explanation commended itself to the Commissioner of Patents, whose ruling on that point is conclusive, a delay, which under the Topliff and the Wollensak cases, above referred to, cannot be held to be unreasonable.

But the Circuit Court found another obstacle to the reissue which is best stated in its own language:

" The reason for the reissue is thus stated in the " complainant's brief: 'Soon after putting the " patent article on the market, complainant was " informed that defendant, a corporation that had " for some time manufactured in Boston, and made " extensive sales throughout the country of a ship- " ping tag, was manufacturing and selling a tag " envelope similar to complainant's. Complainant " immediately applied to counsel for the purpose of " commencing suit against defendant and was " advised by such counsel, after an examination of " his letters patent and a statement of his invention " and application, that his patent was defective, " indefinite, and ambiguous in its claims, so as to " render it practically inoperative, and that he had " better apply for a reissue.' " Record, p. 181.

And again the Court says:

"The patentee made no move until the defendant "had produced its envelope which could be sold "without infringing the original patent."

If, by this language the Circuit Court means to say that the patentee was attempting under the guise of a reissue to blanket *another and different invention*, which had, after the grant of the original patent been put upon the market, then we totally dissent. If, on the other hand, it is only intended to say that the sale by the defendant some six months after the grant of an original patent of an article which successfully evaded the limited claims of such patent, was the occasion of the discovery of the patentee by his mistake, then we say that is the truth. When the patentee found that the defendant was selling what he knew to be his invention, he took immediate steps to have the supposed infringement stopped, and when he found he could not succeed in so doing because of the defectiveness of his patent, he saw the practical consequences of his mistake, and took steps to have it rectified by applying for the reissue. But according to the reasoning of the Circuit Court, the whole operativeness of the reissue statute is made to depend upon accidental circumstances. No matter how genuine the mistake, no matter how satisfactory the explanation of how the mistake arose, no matter how reasonable the delay, if between the grant of the original patent and the application for reissue, anyone has commenced to sell an article which successfully evades the limited claims of the original patent and the real rights the patentee is entitled to, he has no relief by way of reissue. If, on the contrary, under precisely the same circumstances, it does not so happen that any such articles are sold, then his right to a reissue is undoubted. This is not and cannot be the law, for if it was, it would make the relief intended to be afforded by the statute, dependent on chance and accident and not on principle.

That this is not the law is clearly laid down by this Court in the case of *White* vs. *Dunbar*, (119 U. S. Reports, p. 52), as follows:

"The circumstance that other improvements and "inventions made after the issue of a patent, are "often sought to be suppressed or appropriated by "an unauthorized reissue, has sometimes been re-"ferred to for the purpose of illustrating the evil "consequences of granting such reissues; but it "adds nothing to their illegality. That is deducted "from the principles of law as applied to the Stat-"utes authorizing reissues and affecting the rights "of the government and the public."

It is also to be remarked that the reissue statute itself is notice to infringers, that the original patent which they are seeking to evade, may be inadvertently limited, and if so the patentee has the right to remedy the defect by reissue.

The statute itself being thus notice to the world of the latent rights of the patentee, the public cannot complain if the patentee cures a defect in his original patent by reissue, so long as the reissue is applied for within a reasonable time.

It is only necessary to add on this point, that the testimony shows that the appellee and defendant corporation was prior to the Dunham invention a large dealer in paper specialties, extensively engaged in the manufacture and sale of shipping tags. Its officials at once recognized the utility of the invention and its value to them in their business. They also saw the weakness of the original patent owing to the limited scope of its claims, and deliberately appropriated the invention to their own use. They were willful infringers, starting in to manufacture and sell with their eyes wide open, and trusting to technical defenses and luck for a successful outcome. They, therefore, cannot pose as an innocent public, and to do them justice, they made no such attempt. It is the Circuit Court that assumes, against, as we believe, all the evidence, to place them in this position.

There remains to consider the first point, whether or not the claims of the reissue are justified by the original patent.

The defendant has produced in evidence on its own part the file wrapper and contents of the Dunham Original Patent No. 277,245, and it is found from page 106 to 113 of the record.

The file wrapper taken in connection with the original patent as issued, shows the complete history of the invention in the Patent Office, and the mistakes made by the Solicitor.

As we have seen, the patent was really prosecuted by a mere assistant or subordinate of the firm through which Dunham applied for his patent. This subordinate had the complete and entire charge of obtaining the patent, and the application, the file wrapper, and the original patent show clearly a continual course of carelessness, hasty action, inattention and blundering.

Taking up the application, the specification as originally drawn thus states the objects of the invention at page 106:

"The object of my invention is to provide a new " and improved combined tag and envelope which " is adapted for attachment to packages, and which " is also adapted to receive the bills or the invoices, " so that the consignees will receive the bill, or the " invoice, with the goods."

This is well put and fairly describes the main object and also states plainly the real essence of the invention.

Then follows a statement of another object of the invention, the language of such a statement, especially by the use of the word "further," clearly showing that such object is subordinate to the main object, and that this portion of the invention is subsidiary and incidental.

Then follows the statement of invention, which is very carelessly drawn, as can be seen by the language, the statement as a whole being ambiguous,

uncertain and indefinite. Surely the words, "an envelope provided at one end with flaps," shows great negligence of description. How can there be more than one flap at one end of an envelope?

The specification then proceeds to a specific description by letters referring to the drawing. The description and drawing taken together show an operative device, but the drawing only shows the preferred form of invention, as it only shows figures with the long flap, while it is evident that the main object of a tag envelope adapted for use both as a tag and invoice holding envelope can be subserved by an envelope with a short as well as a long flap.

The specification then (p. 108) proceeds to describe the use of the invention, and here again it is made clear that the use of the long flap is subordinate and incidental to the main use, namely, the use of the envelope to serve the purposes of a tag and invoice envelope.

Notwithstanding the blundering manifest throughout the whole application, it is clear that the real invention is a tag invoice holding envelope, which carries out all the purposes of the invention whether the flaps are short or long, and whether the holes through which the cord or hook for attaching the envelope to the goods, are at either end.

Coming now to the claims, it is clear that the first claim is entirely nondescript. What sense is there in a claim which in view of the invention set forth only covers a flap of such dimensions as to cover the whole envelope?

The remaining claims are strictly limited to the specific device as shown by the lettered drawing.

The application was filed January 15, 1883, and on March 22, 1883, the Examiner took action. (See p. 109). He regarded the specific 3rd and 4th claims as untenable because merely involving various forms of address. The first claim he says should be amended as indicated in pencil, the pencil emenda-

tion being the insertion of the words "one side of" in the claim.

On April 5th the Solicitor's surbordinate accedes to the request of the examiner.

On April 7th the examiner (p. 110), writes as follows:

"The statement of invention should be modified "to correspond with the clauses of claims, as now "presented."

On April 9th (see p. 106), only two days after the date of this letter of the Examiner, this Solicitor's surbordinate without any time for consideration, and without opportunity to consult the applicant, strikes out not only the statement of invention, but also the statement of the object of invention, and writes the following:

"Erase the object and statement of invention and "substitute:

"The object of the invention is to form an envelope with an end flap covering its side as hereinafter described." (p. 10)

The application was then allowed. The correspondence shows an eager anxiety on the part of the Solicitor's assistant to obtain a patent of some sort without reference to the interests of the applicant, and a perfect willingness for this purpose, to be twisted and turned in any way at the whim or caprice of the examiner.

Turning now to the reissue patent, found at p. 87 of the record, we find that no really new matter is interpolated, and the changes in form of the description are amply justified by the original patent.

A clear and definite statement of invention is inserted. The form of the device shown in the drawing is referred to as the preferred form, which it really is, and a few other phrases are arranged or inserted in the specification to make the description of the invention more clear and definite. With regard to the reissue claims, Mr. Connett, the Solicitor, who had charge of the reissue application, says as follows:

"I consider the original patent inoperative within "the meaning of the Statute, for the reason that it "did not fully protect him in the exclusive right "to make, use and sell his invention, which is the "purpose and function of a patent. The claim, "while fairly covering the particular form of tag "envelope illustrated in the patent and which I "understood to be the preferred form, could be "evaded by a very slight change in the shape and "size of the flap and envelope." * * * * *

"I saw no necessity for limiting him to making "the flap large enough to cover the flap of the "envelope. This use of a flap merely provided an "extended surface on which to write directions or "other matter, and this latter formed no part of "the invention claimed. Furthermore, I did not "consider the first claim of the original patent as "being expressed in clear and distinct terms. "There was also some defects in the language of "the specification, which I thought required cor- "recting. I do not now recollect distinctly what "these were."

In order to give the patentee the rights to which he was entitled the first claim of the reissue was drawn up.

The second claim is especially designed to render the patent operative by covering a short as well as a long flap and to prevent the real invention from being evaded by not limiting the eyelet holes through which the attaching string or cord is passed, as to location.

By this claim, would-be infringers are prevented from evading the patent by merely shortening one of the flaps of the envelope and placing the eyelet holes through which the attaching string passes in the other flap and other end of the envelope. The third claim is the same as the second claim of the original patent, covering the specific form shown in the drawing of the patent.

The appellee's and defendant's counsel produced in evidence a copy of the file wrapper of the appli-

cation for the reissue patent, and the same is found in the Record from pages 118 to 123. It appears that in the specification of the application as filed, the applicant referred to the preferred form of construction shown in the drawing by permissive words, such as "may be," instead of the words "is" or "are." These the examiner criticized as not sufficiently definite words of description. The applicant's solicitor replied to this criticism in the letter set forth at page 120 of the Record. The reasons the solicitor gives for the form of words criticized, appear to us just and sound, but as the examiner still persisted in his objection, and the form of construction was referred to in the specification as the preferred form, the solicitor evidently thought it would be of no special importance to persist in the matter, and therefore having made the record perfectly clear as to his reasons for the permissive words, acceded to the examiner's criticisms in this regard, and returned to the original form of words. That is all there is in this point of defendant's counsel. The file-wrapper further shows that claims 1 and 4 were made in the application, which were refused by the examiner, and on his rejection withdrawn. The defendant's counsel, therefore, claims abandonment, as one of the claims (the first) was for substantially a tag envelope with a pocket. This claim was very broad, and was withdrawn on that account. But the whole matter is entirely irrelevant and immaterial as to the issues in this case, for the reason that while this claim was withdrawn, another claim or other claims were *retained*, which were amply justified, and which the defendant corporation infringes. It certainly is not the law that where an application for patent is made with several claims, some of which are withdrawn and others retained, that an infringer of the retained claims can escape, because other claims which he might equally infringe, had they been retained, are withdrawn.

There remains to consider the other matters insisted by the Circuit Court as invalidating the reissue.

The Circuit Court says in its opinion at page 182 as follows:

"The patentee himself states that the alleged in-
"fringing envelope of the defendant was one of the
"forms "invented by him, but not shown in his
"patent,' and he therefore sought a reissue which
"would cover it.'"

The words "invented by him are not shown in his patent," are taken from the affidavit made by appellant above referred to, on motion for preliminary injunction. This portion of his affidavit from which the quotation of the Circuit Court is taken, is found at pp. 137-138 of the Record, folio 225. Mr. Dunham is referring to the specific difference in construction between defendant's envelope and his own, and states that all the defendant has done is to shorten one of the flaps and make attaching eyelets at the other end co-operate with the shortened flap, and then adds, that this very form is one of the forms "invented by deponent, but not shown in the patent." The remaining context shows clearly that all Dunham meant to say was, that the specific form of his invention used by the defendant was not shown in the *drawing* of the patent. His affidavit was sworn to in 1887, (see folio 230) and nearly three years before Dunham had clearly stated his position in regard to the original patent and the mistakes in taking it out, in his statement to the Commissioner of Patents accompanying his petition for reissue.

For the Circuit Court to quote this isolated phrase, (evidently referring only to the drawing) and wrested from its context, against the appellant, as a virtual admission by him that the reissue is not warranted in any way by the original patent, is, we think, hardly fair under the circumstances.

The remaining point relates to the analogy attempted to be drawn between the case of Coon *vs.*

Wilson and the present suit. (See opinion, p. 188.) The Court, forgetting as we think, that illustration is not argument, draws an elaborate parallel between the two cases. But we cannot see the analogy.

The case of *Coon* vs. *Wilson* was a very conspicuous instance, nearly as flagrant as that of *Miller* vs. *Brass Co.*, of the abuse of reissues. Although the application for the reissue in controversy in the case of *Coon* vs. *Wilson* was made only about three months after the grant of the original patent, and therefore no point could be made as to delay in applying for the reissue, this Court did not hesitate to invalidate the reissue, and did so, because it was perfectly apparent that the appellant had attempted by the interpolation of entirely new matter in the description, to change the invention from that of the original patent to another invention, not only different from, but sharply contrasted with that of the original patent. In the original patent, the invention was for a collar with short or sectional bands, while the specification of the reissue was so worded as to change the invention from a collar with short or sectional bands to one with continuous long bands, and this change was made in the face of the clause in the original description, "the use of "the short or sectional band produces a saving of "material compared with the old style of continu- "ous band," which language clearly shows that originally the patentee not only made the short or sectional band the very essence of his invention, but also expressly recognized that the continuous band was an old device.

We have very obscurely stated the history of the Dunham invention and that of the original and reissue patents, if such history has not shown that there is no resemblance between the facts of the Dunham invention and patents, and those set forth in *Coon* vs. *Wilson*.

There are two cases, however, which may well be referred to as closely applicable in their principles

decided, and facts set forth, to the facts of the present case. These cases are those of *Eames* vs. *Andrews*, 122 U. S. Reports, p. 40, and *Lockwood* vs. *Morey*, 8 Wallace, 230.

The case of *Eames* vs. *Andrews*, is the well-known driven well case.

In that case the statement of invention, the drawing, the description of the device shown in the drawing, and the claim, were found to cover only the driving of the hole for the well-tube by a pointed rod, and then removing the rod and inserting the well-tube. It was found in practice, that the well-tube itself could in many cases be used as the driving instrument, and that, as the original patent was drawn, infringers could evade its claim and yet enjoy the invention, by using the well-tube itself to effect the drive.

The patent was therefore reissued in order to give the inventor the full protection intended to be afforded by the statute to the actual meritorious invention.

In the reissue patent, the drawing, showing only specific forms of specific rod and tube was not altered, just as in the Dunham reissue. the drawing remains the same. In the driven well reissue. the form shown in the drawing was referred to as the preferred form, as in the Dunham reissue. This drawing was described in the same language as in the original description, as is the case in the Dunham reissue. The statement of invention, and the claim, was, however, changed so as to cover the invention, whether a separate rod was first used to effect the drive, or the well-tube itself was made the driving instrument.

In the same way, all that has been done in the Dunham reissue is to make a clear statement of invention, and to insert corresponding claims, so as to prevent infringers from evading the patent by simply shortening the flap and changing the location of the holes through which the string or tag fastening is inserted. It is thus seen that the

analogy between the changes made in the original and reissue patents in both cases is very similar.

With regard to the principles by which the Court was guided in justifying the changes of description from the original to the reissue driven well patent, the Court says: "There is nothing in these addi-"tions and amendments which either was not virtu-"ally contained by reasonable implication in the "original description, or, if new, amounted to more "than specific and exact directions to supplement "those contained in the original. The invention is "not differently described, and is not described so "as to be a different invention, nor is the claim "enlarged."

Eames vs. *Andrews*, 122 U. S. Reports, p. 63.

The Court in *Eames* vs. *Andrews*, refers to the case of *Lockwood* vs. *Morey*, 8 Wallace, page 230, in which a reissue was sustained. In that case, in which the invention was for an improvement in syringes, the reissue was upheld, because the inventor was led into the limitation of his claims by the mistake of the Commissioner of Patents, as seen from the letter of the commissioner among the correspondence when the patent was originally granted.

Lockwood vs. *Morey*, 8 Wallace, page 240.

The Court says in this regard:

"The amendment was very material as the lan-"guage of the original claim tied the patentee down "to a syringe consisting of the parts mentioned, to "an instrument which was arranged in an axial, or "straight line; tying them down to a mere form of "construction, regardless of the substance and legal "import of the invention."

"While the original specification and claims re-"mained, it was competent for anyone to evade the "patent, and enjoy the substance of the improve-"ment by a change in the mere form of construc-"tion; that is by the arrangement of the several parts

"in any form, if not in an axial or straight line; and "this is what the defendants are endeavoring to ac- "complish and would have accomplished if the a- "mendment of the claim had not been allowed."

Same p. 241.

We are aware that in a subsequent driven well case, the invention was declared to be public property, because of a proved prior public use, but we do not understand that this fact lessened the value of the invention, as an invention, or overthrew the principles laid down by the Supreme Court in *Eames* vs. *Andrews* as to the reissue.

In both the driven well and the syringe reissue cases, the reissues were justified because the Court considered them to be for the same inventions as the original patent.

In both cases, also, the test by which it was determined that the reissue patents were justified, is, we believe in substance as follows:

That anyone, knowing the real object of the invention and its essence, and having the original patent before him, could without invention and by a mere variation, carry out the invention and yet escape infringement, because the original claims did not cover such variation.

Apply this principle to the facts of the driven well, syringe and Dunham reissues.

In the driven well case, it is plain that anyone with the original patent before him, could see that the invention could be carried out by making the well-tube itself the driving instrument. Yet, if this was done, the invention would be fully appropriated and the infringement of the original patent escaped.

In the syringe case (*Lockwood* vs. *Morey*) it is equally plain that anyone could see at a glance that the real purpose of the invention could be accomplished by merely deviating from a straight line in the arrangement of the parts of the syringe. Yet, in this way, infringement of the original patent would be evaded.

In the Dunham case, also, it is quite plain that anyone having the essential object in view which Dunham sought to achieve with the Dunham original patent before him, could see, on a mere cursory inspection of such patent, that the advantages and merits of Dunham's invention could be accomplished by taking scissors and cutting off a portion of the flap and transferring the position of the eyelets accordingly, and yet infringement evaded. If this is within the province of the dullest and most ordinary comprehension, as we think it is, then we contend, that it is clear that the same invention is embodied in the infringing envelopes, as in the Dunham original and reissue patent, and that consequently the reissue patent covers merely the same invention that the original patent disclosed and intended to cover.

It is further to be observed that in many of the cases in which reissues have been declared invalid by the Courts, it has been clearly shown, either by direct proof or by inference so obvious as to be equivalent to direct proof, that the devices used by the defendants had been originated by them, and were first brought to the complainant's attention prior to the application for reissue.

In the present suit the contrary is shown to be the fact.

In complainant's affidavit on injunction motion, offered in evidence by the defendant and hereinbefore referred to, it is clearly shown that tag envelopes, with short flaps, were made by the complainant prior to his application for patent, and shown by him to the attorney's assistant before the application was made.

pp. 135-136, folios 222-223.

There is one other point to which we desire to call the Court's attention before closing this portion of our brief.

The appellee's counsel, as we have seen, introduced the file wrapper and contents of the appel-

lant's original patent, No. 277,245, in evidence. He did this for the purpose of calling the Court's attention to the changes made in the description and claims of this original patent from the application as originally filed, evidently with a view to claiming, as he did, that the appellant having, through his attorney, made changes in the statement of invention and its objects, stricken out some claims, and altered the language of others at the suggestion of the examiner, must be held under the decisions of the Courts to have so abandoned his original application or acquiesced in the changes made, as to be estopped from making further changes or alterations in the reissue. It will be found, however, that the decisions of the Court, with reference to abandonment, acquiescence and estoppel as evidenced by the history of applications in the Patent Office, have always been founded on something, to wit: The claims as originally applied for, were either rejected by the examiner, on prior patents or references claimed by him to anticipate, and in view of the prior references thus cited, the claims were narrowed, or the application itself showed an express disclaimer, or a disclaimer necessarily or obviously implied.

A short summary of the decisions in this regard will, we think, show this clearly.

The genesis of this doctrine of estoppel, abandonment and acquiesence, as now established, is to be found in the case of Leggett *vs.* Avery, 101 U. S. Reports, p. 256. In this case, an extension of a patent had been granted on an express disclaimer of certain features in the original patent by the grantee of the extended term. He afterwards claimed in a reissue the matter which he had so expressly disclaimed. The Court held that this could not be done.

The case of Goodyear Dental Rubber Company *vs.* Davis, 102 U. S. Reports, pp. 222–228, the patentee was held to be estopped from claiming a construction of his invention or features therein which he had disclaimed.

The case of Cartridge *vs.* Cartridge Company, 112 U. S. Reports, pp. 624–644, was also that of a reissue, in which the patentee had obtained an extension of his patent by expressly disclaiming certain features as a condition of obtaining the extension, and had thereafter reclaimed in the reissue the features so expressly disclaimed. The Court declared the reissue patent invalid on the case of Leggett *vs.* Avery.

In case of Sargent *vs.* Hall Safe & Lock Company, 114 U. S. Reports, p. 63, we find that the claims were rejected on prior patents and after rejection narrowed by amendment.

In this case, the Court evidently having in mind the previous cases, where there had been an express disclaimer as the condition for granting an extension of the patent, found an analogy between such an express disclaimer, and the narrowing of broad claims by amendment after their rejection on anticipating references, and looked upon such action of the applicant for patent, "as in the nature of *disclaimers*."

Same case (114 U. S.) p. 86.

In this way the doctrine has arisen, that in cases where the patentee has made broad claims in his application for patent, and in view of *anticipating references* cited by the examiner, has narrowed such claims, he must be held to have either so abandoned them or acquiesced in their rejection, as to be estopped from afterwards attempting to reclaim them, either by way of construction or interpretation of the original patent, or under the guise of a reissue.

But in all the leading cases where this doctrine has been laid down, it will be found that, as we have said, the abandonment, acquiescence or estoppel, has either been founded on an express disclaimer, or an implied disclaimer, evidenced as a general rule by the narrowing of claims after rejection on cited anticipating references. The leading

cases of Shepard *vs.* Carrigan, 116 U. S., p. 593; Roemer *vs.* Peddie, 132 U. S., p. 317; Phœnix Caster Company *vs.* Spiegel, 133 U. S., 361; Yale Lock Manufacturing Company *vs.* Berkshire National Bank, 135 U. S., pp. 343–371; Royal *vs.* Coupe, 146 U. S., p. 522, all are based on the fact that original claims had been rejected on anticipating references, and afterwards narrowed by amendment.

But there is no case which we can find which establishes a precedent for the position which must be taken by the appellee's counsel to make the Dunham file wrapper pertinent evidence, that an estoppel, abandonment or disclaimer can be founded on the mere suggestions of the examiner.

The history of this case shows that the person who prosecuted the application was a mere nose of wax, twisted without rhyme or reason by the mere orders of the examiner, founded, not on cited references or on any valid reasons, but apparently on whim or caprice only.

To sum up the above argument, we think that we have fairly shown that the Dunham reissue is valid:

1.—*Because there was genuine mistake arising from no fault of the patentee but from the misunderstanding of his attorney as to the essential invention of the original patent.*

2.—*That due diligence was used in applying for a reissue, the time, ten months and ten days after the grant of the original patent, being a not unreasonable time under the circumstances in which to so apply.*

3.—*That the invention claimed in the reissue patent is the same as that of the original patent, the amendments in the description and claims of the reissue patent, being only such as were warranted by the express language of the original patent or plainly arose by reasonable implication therefrom.*

4.—*That the claims of the reissue patent were not unwarrantably expanded.*

5.—*That the reissue was therefore valid.*

6.—*That the Circuit Court erred in holding that the claims of the reissue patent were unjustifiable and in its reasons for such holding.*

IV.

Infringement of Reissue Patent.

The remaining defenses may be more briefly noticed.

With regard to these, the Circuit Court, says:

"The defenses are lack of novelty and invention, "non-infringement, and that the reissue is void be- "cause of an unwarrantable expansion of its "claims." (Record p. 181.)

The fact that the Circuit Court only took up the defense of invalidity of reissue, and dismissed the bill as to the reissue on that issue alone, plainly implies that the remaining defenses did not commend themselves to its judgment.

With regard to the infringement defense, the Circuit Court especially says:

"Claims one and two of the reissue are unques- "tionably broadened. They are no longer limited "to a flap a sufficient size to cover the entire en- "velope. *Should the Court hold that they are so "limited it is admitted that they are not in- "fringed.*"

The obvious implication is, that if the claims of the reissue are held to be valid, the defendant infringes.

Nor is this substantially disputed by the defendant in its evidence. Thus the defendant's expert only contends that if the first and second claims of

the reissue are to be construed broadly, they, in his opinion, are shown in prior patents (p. 149), but does not deny infringment, if the said first and second claims are construed broadly.

The complainant caused various purchases of tag envelopes to be made from defendant, and offered specimens of such purchases in evidence. Among these were the Rogers purchase (p. 15), the Bergen purchase (p. 16), and the Burr purchase (p. 18.)

The tag envelopes so purchased, "Complainant's Exhibit Dennison's Patent Tag Envelope" (p. 16), and "Bergen Specimen Dennison Tag-Envelope No. 2," (p. 19), are envelopes so purchased and marked in evidence.

The first and second claims of the reissue, of which as we have seen, the defendant virtually admits infringement, if broadly construed are as follows:

"1. A combined tag and envelope, substantially "as described, wherein the flap which closes the "mouth of the envelope is fastened down by the "cord or other device which secures the tag to the "merchandise, as set forth.

"2. A combined tag and envelope, substantially "as described, the flap having an eyelet-hole, which, "when the said flap is folded down on the envelope, "coincides with an eyelet-hole in the envelope, "whereby the cord or hook for attaching the tag "may be passed through both holes, substantially "as set forth."

The construction of these two claims is thus given by the complainant's expert at p. 62 of the Record:

"The first claim of the reissued patent is generic, "and is broad enough to cover a combined tag and "envelope wherein the device employed for secur- "ing the tag to the merchandise also fastens down "the flap which closes the mouth of the envelope.

"This claim is not limited specifically at all to "the special device employed for holding down the "flap and securing the tag to the merchandise.

"The second claim is limited to the coinciding "eyelet-holes in the flap and envelope, but not to "their special arrangements as illustrated in the "drawing of the patent, and in the exhibit before "referred to.

"They may be placed in any other position, pro- "vided they accomplish the end sought, and which "is clearly set forth in the first claim, namely, to "hold down the flap, so that the invoice cannot "escape from the envelope, and at the same time "serve as means of attaching the tag to the mer- "chandise."

A comparison of the infringing envelopes, "Complainant's Exhibit Dennison's Patent Tag-Envelope," and "Bergen Specimen Dennison Tag-Envelope No. 2," with these two claims shows a clear infringement of both claims.

These envelopes consist of an oblong tag-envelope, with an open gummed flap at one end, and a flap at the other end, formed integrally with the front ply of the envelope body, and closed down on, and overlapping the front end of the back ply of the envelope body. Their are coinciding holes in the closing flap, and the front ply of the body; but there is no hole in the free end of the back ply of the body, unless a *colorable* clipping of the edge be called a hole. On the closing flap and the front ply of the tag-envelope are reinforcing washers, or disks, surrounding the holes. The closing flap is tightly gummed down to the back ply of the envelope body in one specimen, and in the other are slight traces of gum, evidently put there for the purpose of closing it down; but the flap is not gummed down.

The closing flap in both exhibits is held down upon the back ply of the body by a short eyelet passing through coinciding holes in the flap and the front ply.

This construction is clearly covered by the second claim of patent reissue, No. 10,488; as this claim

broadly covers the reinforced holes in the flap and envelope body, through which the string for securing the tag-envelope to the merchandise is passed.

As both the metal reinforces shown in the reissue, and the reinforcing washers of the infringement, are old, the washers would seem to be employed to make a colorable difference, with a view to evade the patent.

This construction also infringes the first claim, in that the attaching string is the real means of holding down the flap.

The testimony of complainant's expert in this regard is found at p. 71 of the Record, folio 119.

V.

Pultz and Walkley Matter.

An attempt was made by defendant to prove lack of novelty by an alleged anticipating device claimed to have been made and sold at Plantsville, Connecticut, more than two years prior to the application for the Dunham original patent, namely: prior to January 15th, 1881.

The evidence relating to this matter is to be found in the testimony of George E. Tucker (p. 91), Lucius V. Walkley (p. 159), and Henry K. W Hall (p. 167).

This evidence falls far short of testimony required to prove prior public use and sale.

Tne use and sale of the Pulz & Walkley device offered in evidence is not authenticated by competent evidence for any purpose.

The evidence offered, neither establishes the defense beyond a reasonable doubt, or by preponderance of evidence. The main witness relied upon to establish this defence, was Tucker, and his testimony, on direct examination, falls far short of competent

proof, and is thoroughly demolished by the cross-examination.

The only claim to identification of the Pultz & Walkley device is by the character of the type on the envelope, which may have been produced at any time since in any well appointed printing office.

Record, p. 100, folio 163.
" p. 101, folios 163-164.

It was never used, but was simply an advertisement.

Record, pp. 99 and 100, folio 162.

It was furnished to the defendant's counsel by the book-keeper and Tucker, without Walkley's knowledge.

Record, p. 162, folio 269.

This witness, Tucker, knows nothing about it personally, not even by memory. It was brought to him by the book-keeper.

Record, p. 98, fol. 160.

The book-keeper, Bond, knows nothing about it. He was a new book-keeper, employed within a few years (as Wood was there from 1870, for about 12 years), and brought the envelope to Tucker for identification.

The book-keeper is not produced to show where he obtained it, and Tucker was not present and does not know.

Record, pp. 98 and 99, answers 60 to 68.

The finding of the circular also, with the strange type brought in for corroboration, is very mysterious.

This was "a find" by the new book-keeper, and brought to Tucker for identification. Tucker, the man "always willing to do anything," never saw it before—was not present when it was found.

Record, p. 103, answers 115 to 128.

If the bookkeeper had been produced it might have appeared that defendant's agent found it, or if the bookkeeper, Wood (who was at Southington), folio 161, had been produced, he might have known all about it.

Why did the defendant not take this testimony at Plantsville, folio 152, where it could have produced both bookkeeper and the books, and avoided the expense of bringing Tucker to New York?

The testimony of Tucker contains so many contradictions as to render it entirely unreliable.

Walkley says, p. 162, answer 41, that he is their engineer, and in answer 42, adds: "He is one of those peculiar kind of men that is willing to do anything that we require of him."

At p. 98, answer 52, Tucker says *he* furnished the envelope—"Exhibit Pultz and Walkley"—to defendant's agent.

In answer 56, he says the *bookkeeper* gave it to him.

In answer 58, he says the bookkeeper *brought the envelope out to Tucker.*

In answer 60, he says that the bookkeeper got it out of a drawer. In the next answer he says he was not present.

In answer 66, p. 99, he says he has told the old bookkeeper, Wood, about it. (Wood, who was bookkeeper, for 10 or 12 years, from 1870, including the time of the fire, and had charge of the office, is not called.)

In answers 78 and 79, p. 99, he says he thinks this envelope was never used, but was made for use.

In answer 81, p. 100, he styles it simply an advertisement.

In answers 99 and 100, p. 101, he says he knows of the defendant making and selling such envelopes.

In subsequent answers, p. 102, he says that he only knows of these sales from seeing the charges in the books.

In answer 105, he says that *is not* the way he obtained his knowledge.

In answer 107, he says that it *is* the way I obtained my knowledge.

The testimony of *Walkley* is confined to answering a few leading questions at page 159 of the Record.

In this testimony, he seems to know nothing positively. He purchased an envelope, which he says was substantially the same thing as the envelopes which he thinks to the best of his recollection he made and sold on the market in 1875. When prodded by his counsel, in question 4, in an endeavor to make his recollection certainty, he frankly says, he can't speak from memory, but has to depend on his books. That is all his direct examination. His cross-examination shows only vague and indefinite recollections. He swears to nothing positively. All his answers are qualified by expressions, such as, "my recollection," "my impression," "I think," or "I could not say positively," or by reference to his books. These books he does not produce, but only statements which he alleges to be copies, and which, of course, are not competent proof.

HENRY K. W. HALL'S testimony (p. 167–172), is offered in an attempt to show a sale of these tag envelope, but he utterly fails to identify any positive date. He produces an envelope which he says is of the style used by them during 15 years, but he says he used a larger size. He says on direct examination, he obtained this envelope (fol. 279), from Pultz & Walkley, but on cross-examination, he answers (fol. 286), that he can't say whether he ever saw it before it was handed to him by the defendant's counsel in the morning he is testifying. When asked in next question, whether it is like the first envelopes he purchased from Pultz & Walkley, all he can say is, "that he should think it was, with the exception that he generally used them of a larger size." As to the time when he first purchased such envelopes, "he thinks that it was at 29 Hawley street, where he was burned out in the year 1872

(fol. 280). This date brings his alleged first purchase years before the time Tucker and Walkley testify they first made tag envelopes. When asked whether he can testify with certainty as to whether he sold the envelopes before occupying present place of business, all he can say is, that he feels "confident he did."

His further answers on direct examination show that he cannot testify from recollection as to anything, but depends for his memory on the Boston directories and on a ledger, the entries in which it appears were not made by him but by a bookkeeper who is not produced or his absence accounted for.

This ledger, of course, is not competent proof, and was duly objected to (p. 169).

On cross-examination he admits that he discontinued the use of the Pultz & Walkley envelopes because they did not answer their purpose, and that was the only reason of his discontinuing their use (folio 285).

He is unable to say whether the entries referred to are made in any other book kept by him. He is unable to settle on any names or addresses of any persons to whom he sent goods with the Pultz & Walkley envelope attached.

He swears to nothing positively, and his examination amounts to nothing in the way of proof.

The evidence of these witnesses is also as remarkable in the way of significant omissions as in lack of positive proof.

As we have seen, Tucker, who produces the envelope and circular got them from the new bookkeeper, Bond, and only knows where he got them by what Bond told him. Bond, although accessible is not produced. The man that should know the most of the envelope matter is Henry A. Atwood, who, according to Tucker, had charge of the tag department at the time they were alleged to be made (folio 157). Yet he is not produced, though it appears that he was then living at Waterbury, Connecticut, and entirely accessible (fol. 158).

Wood, the old bookkeeper, who had charge of the books at the time, is not produced, although it appears that he too was living at Southington and also accessible (fol. 161).

The purported copy (pp. 165–166) from the Pultz & Walkley books, shows entries under the head of tag envelopes of alleged sales, to "Brooks, Bancroft & Co., of Mass.," "George E. Selleck, of Brattleboro, Vermont," "W. F. Glover, Providence, Rhode Island," "White, Perry & Dexter, Worcester, Mass.," yet none of these firms are called on to show sales, although there is no evidence produced to show that their testimony, if desired, could not be obtained. The only man produced in reference to these entries is Hall, and as we have seen his evidence amounts to nothing.

Bnt the most significant thing in the whole matter, and that which brands all with grave suspicion, is the way Tucker endeavored to prove the envelope and circular he produces.

The way he attempts to fix the date of their manufacture, is that they have printing on them produced by a certain kind of type; that Pultz & Walkley were burnt out by a fire, which occurred in 1876, and the peculiar kind of type used in the printing of certain portions of the envelope and circular was not replaced after the fire.

This is sufficiently slender identification testimony in view of Tucker's admission before referred to, that the type was not unusual and could be bought at any of the type foundries, and the printed matter could be set up and printed in any well appointed printing office. But worse remains behind.

He, of course, has got to account for the fact, that while the fire, which burnt Pultz & Walkley out occurred in 1876, the alleged statement from their books is dated in 1875. He does this by swearing that their books and office papers were saved. When asked whether office furniture was saved (fol. 162), he says that no desks were saved, but some desk drawers were saved. The Court is

therefore asked to infer, without any proof whatever, that this circular and envelope was in one of these "saved" drawers, and that by some miraculous and unaccounted for preservation, they remained entirely unknown to the witness himself for the intervening eleven years and were suddenly resuscitated by the new bookkeeper for the purpose of this suit.

Yet such testimony as this, the Court is asked to accept as competent to prove prior public use. Nothing more need be said on this point.

Other Defenses.

The defense of invalidity of the reissue and the alleged prior use and sale of the Pultz and Walkley device, are all the defenses set forth in the answer, as to the Dunham reissue patent, with the exception of the alleged use and sale by the defendant corporation of tag-envelopes substantially the same as those charged to be infringements.

Folios 17 to 21.

Of this last defense it is sufficient to say, that the defendant produced no evidence whatever to support it. No publications or patents were set forth in the answer, as anticipating references.

Neither is the defense of non-invention clearly pleaded, as against the reissue, the only language from which such a defense may be spelled out being at the top of page 10 of the Record, folio 21, and for this defense the defendant appears to rely entirely on prior public use, which was to be proved by the witness, Hall, and others, cited in this portion of the answer. The production of the Ullman, Schultz and Tompkins patents in evidence, is therefore clearly an afterthought. These patents at the time the answer was interposed were evidently not considered of sufficient importance to plead either as anticipations, limitations of the

complainant's patents, or justifications of defendant's infringements.

They were, however, offered in evidence and printed in the Record.

As we have seen, they are not referred to by the Circuit Court as defenses to the reissue, and evidently played no figure in its decision on the reissue question.

An analysis of these patents will show that they have no bearing on the question at issue and that the defendant was perfectly right in not pleading them as defenses in the answer.

VI.

The Ullman Patent.

This patent is to be found at p. 175 of the Record. The patentee's design was to make his envelopes of such a peculiar form, that when fastened, the letters placed in them could not be abstracted without defacing or tearing the envelope.

To accomplish this purpose, the envelopes were cut with three folds, numbered 1, 2, 3, in Fig. 1, of the drawing, thus forming four leaves, the object of so cutting the envelope, being to produce an increased number of folds for the fastening to pass through, each additional fold thus increasing the difficulty of opening the envelope without detection.

Record, p. 176.

The envelopes thus folded were to be secured by fastenings passed through flaps, arranged as shown in Fig. 1, and through the leaves formed by the folds, and this brings the patentee to another statement of a subsidiary improvement, which he claims to have designed.

His statement is substantially, that envelopes have been sealed with eyelets, and that the envelopes and eyelets have been sold separately, so that the purchaser or user has been compelled to buy the envelopes to be sealed and the eyelets for sealing them, separately, and to secure the eyelets to the envelopes himself before sealing.

The patentee's idea is to enable the manufacturer to furnish the Ullman peculiar form of envelope with its intended security against abstraction of contents, to the public, with the fastening or eyelets seals in the envelope ready for sealing.

He attempts to do this by having the manufacturer seal one end of the envelope securely by passing the fastening through the flap at that end of the envelope.

The flap at the other end of the envelope is left open for sealing, and to make it ready for sealing, the manufacturer is to place an eyelet in this open flap. But it is plain that unless this flap eyelet is secured in some way in the flap, it will drop out and be lost.

To obviate this difficulty, the manufacturer is to gum a strip of paper over the eyelet or fastening at the outer side of the flap, or if additional security is desired, over the inner side of the flap as well. In this way the envelope is made ready for sealing, and in this condition is to pass from manufacturer to the purchaser or user.

The user, however, in order to seal, has to put the letter in the envelope and then secure the open flap to the folds of the envelope by clinching its eyelet by a punch or equivalent instrument with which he must have provided himself. All that Ullman claims as new, is the gummed strip of paper holding the eyelet in the open flap of his peculiar envelope.

We contend that the above is a perfectly fair statement of the Ullman invention, and such statement clearly shows that this invention, if it can be dignified by that name, is very far afield from anything relating to tag envelopes.

Not only is there not any analogy to the Dunham invention, but not even the remotest suggestion of a tag envelope.

No stress is laid in the patent on the use of an eyelet seal or *hollow* rivet for fastening the flap. The manufacturer can use for fastening his flap, any suitable fastening. If from motives of economy or convenience, he desires to use a *solid* rivet instead of a *hollow* rivet, he is at perfect liberty to do so, and all the purposes of the Ullman invention will be subserved equally as well.

In regard to the seal for the other or open flap, the patentee carefully provides that its eyelet shall be closed by the gummed strip of paper, and such gummed strip is absolutely essential to keep the eyelet of the open flap securely in place.

It is thus clearly seen that the Ullman invention does not and cannot suggest a tag envelope, for the reason that it does not contemplate as a part of the invention, any provision for the attaching of strings or other tag fastenings to the envelope.

On the contrary, the only object or intent of this Ullman patent is to provide an envelope which with its contents in its ordinary passage *through the mails* cannot be tampered with without defacing or mutilating the envelope.

The Schultz and Tompkins Patents.

The Schultz tie envelope is not in any sense an anticipation of complainant's patented invention.

It does not contain the elements of complainant's device.

It is simply a mailing envelope for packages that are required to be sent through the mail without sealing.

The only object and practical use of the eyelet holes and string, are to confine the contents and allow of their being examined by the officials, by untying the string.

No provision is made for attaching it to a package.

The contents cannot be removed and examined without unfastening the tie.

It is not a practical tag envelope, and cannot be made so without a radical change involving invention.

The complainant produces a device made in accordance with the Schultz patent, and Mr. Connett, complainant's expert, explains the marked and essential differences which exist between the Schultz envelope, as set forth in his letters patent and illustrated in the Exhibit Schultz envelope produced in evidence, at pp. 66 and 67 of the Record.

The Tompkins patent simply shows a long flap and has no possible bearing on the issues of this case and needs no comment.

This patent was considered of so little importance that it is not referred to by the defendant's expert, and was therefore not commented on by complainant's expert in rebuttal.

It is, of course, easy for the defendant to assert that because one of the patents produced in evidence shows an eyelet, another patent, a tape, and still another, a long flap, that there is no invention in complainant's tag envelope.

But the fact that envelopes had been made with large flaps, legal envelopes and sample envelopes to be tied with a tape or fastened with eyelets, or paper fasteners, has no materiality in this case. No claim is made in the Dunham patent for the use of any of these elements separately.

It is the combined use of the corresponding eyeletholes, with their eyelets, the attaching string, tag pocket, flap and envelope so arranged as to effect a new and useful purpose, made plain by the specifications and claims, that is sought to be covered and protected by this patent as set forth in the several claims. This invention and device is not in any way anticipated by the previous use of the various elements separately and in different forms for other purposes.

With reference to the question of invention and anticipation, the language of the Supreme Court in *Topliff* vs. *Topliff* is in point.

"It was evidently not in the mind of the patentee "and the patent is inoperative for that purpose. "Their device evidently approached very near the "idea of an equalizer; but this idea did not "apparently dawn upon them, nor was there any- "thing in their patent which would have suggested "it to a mechanic of ordinary intelligence, unless he "were examining it for that purpose."

"It is not sufficient to constitute an anticipation "that the device relied upon, might, by modification, "be made to accomplish the function performed by "the patent in question, if it were not designed by "the maker, nor adapted, nor actually used, for the "performance of such functions."

Topliff vs. *Topliff*, 145 U. S., p. 161.

In addition to this, if any further evidence is needed on the point that the Dunham invention is not met by the evidence produced by the defendant as to non-invention, it is to be found in the testimony of the representatives of the International, United States, Adams, Wells Fargo, and American Express Companies, and the other witnesses before referred to, who testify as to the novelty of the Dunham tag envelope and the extent of its use and sale.

With regard to the bearing of this evidence of general use as to invention, we refer to the cases of Kremetz *vs.* Cottle Co., 148 U. S. Reports, p. 556.; Consolidated Valve Co., *vs.* Crosby Valve Co., 113 U. S., 157; Magowan *vs.* New York Belting Co., 141 U. S., 332; Barbed Wire Patent, 143 U. S. R., 275; Gandy *vs.* Main Belting Co., 143 U. S., 587; Topliff *vs.* Topliff, 145 U. S., 156. 163, 164.

The relevancy of such evidence is well illustrated in the case of Sessions *vs.* Romadka (145 U. S., 20), where the Court thus refers to the rule of law to be applied when general use is shown in cases where the invention might otherwise be in doubt.

"If there were any doubt of this, (invention) in "view of the fact that Taylor seems to have been "the first to invent a practical trunk fastener to "take the place of the old-fashioned strap and "buckle, and that improved upon, as it undoubted-"ly has been, it has completely taken the place of "the earlier devices, we should be inclined to re-"solve the doubt in favor of the patentee."

Sessions vs. *Romadka*, p. 44.

VII.

Dunham Letters Patent No. 331,118.

With regard to this patent, the Circuit Court holds:

1.—That its claims, in view of the Ullman patent and other prior structures, must receive a limited and not a broad construction.

2.—That if the claims receive such limited construction the defendant does not infringe.

Record, p. 184.

We claim that the Circuit Court *erred* in holding that the claims must receive so limited a construction that the defendant does not infringe.

We have already so thoroughly analyzed the Ullman patent, and shown, as we think, that it has no application to tag envelopes, that it is unnecessary to refer again at length to such patent.

We only refer further to the testimony of Connett, complainant's expert, at p. 69 of the Record, as to the inapplicability of the Ullman patent as a limitation of this Dunham patent.

The Circuit Court also refers indefinitely in connection with the Ullman patent, to "other prior structures" as limiting the Dunham claims.

The only other structures referred to in defendant's evidence, are the Pultz and Walkley device and the Schultz and Tompkins envelopes. The Pultz and Walkley device has been shown not to have been proved as an instance of prior use.

That in any event it has no bearing on the Dunham tag envelope is clearly shown by the testimony of Mr. Connett, p. 66 of Record, fol. 111, to which we refer the Court.

This testimony in regard to Schultz envelope and its essential dissimilarity to the Dunham tag envelope is given at page 67, fol. 112 of the Record.

As we have seen, the Tompkins envelope was considered so little to the purpose that it was not commented on by defendant's expert.

If, then, neither of these devices limits the broad construction of the Dunham patent, the implication is obvious, that the defendant's envelope infringes.

An inspection of the envelopes made and sold by defendant, will show that they infringe the claims of the Dunham patent, as fairly and reasonably construed.

Complainant's expert, after describing these infringing Exhibits "Dennison's Patent Tag Envelope" and "Bergen Specimen," the infringing Exhibits, folio 118, says:

"In my opinion, these exhibits show clearly the "construction covered by the claims of the Dun- "ham patents; they meet the conditions of the "late patent No. 331,118. in that each has a closing "flap having a reinforced hole which coincides "when the flap is turned down, with a reinforced "hole in the front ply of the body; this flap over- "lapping the free end of the back ply of the body, "and thus holding the pocket closed against the "accidental escape of the contents, but leaving said "back ply free, so that the pocket may be opened, "and its contents removed, inspected and replaced, "and the fastening replaced, without destroying or "materially defacing the tag envelope."

"The application of a little gum to the corners of "the flap to stick it down lightly to the back ply, "was contemplated in the Dunham patent No. "331,118, as stated in his specification, p. 2, lines "4 to 13 of the printed Patent Office copy."

"The eyelet appears to be unnecessary, as the "gum on the flap (X) would suffice to hold the flap "down temporarily, or until the string passed "through the holes. It is not required as a reinforce "in addition to the reinforcing washers, and it is so "short, and the clinch is so meagre or slight that "the eyelet does not prevent the flap from being "raised without difficulty. However, if this eyelet "was long enough to be clinched securely down, "and form a permanent attachment of the flap to "the front ply of the body above or beyond the "free end of the back ply of the body, the exhibit "would still be clearly infringements of the second "claim of the Dunham patent, No. 331,118 as the "fastening would still leave the back ply free, and "allow the pocket to be opened and closed."

"The infringing exhibits are capable of being "used in precisely the same manner as the envelope "described in the Dunham patent, No. 331,118, and "for the purposes set forth in that patent; that is "to say, the contents may be inserted at the open "end, and the flap *y* sealed down, the other end, "where the mouth of the envelope is situated, will "be then left in percisely the same condition as "that end of the Dunham envelope is left; and "the envelope may be employed either for mailing "purposes or for a flag envelope"

It was substantially held by the Circuit Court, and claimed by defendant's expert (fols. 245, 246, and 247), that the flap of the Dunham envelope is held so permanently down on the back ply of the envelope that the flap cannot be opened and the contents of the envelope removed without breaking loose the fastening made by the metallic eyelet.

That this is not so is shown by the complainant's expert in rebuttal, who takes two envelopes identical in structure with the infringing exhibits, and raises the flap, and removes and replaces the enclosure without breaking loose the fastening provided by the metallic eyelet and after replacing the enclosure rearranges the back ply under the flap as it was at first.

Record, p. 71, fols. 120 & 121.

It will be observed that the eyelet-holes in the infringing devices do not pass through the back ply of the envelope, but do impinge on it sufficiently to clip its upward edge.

See infringing exhibits; also Record, p. 71, fols. 120 & 121.

It will also be observed that defendant's expert notices this fact in his testimony.

Record, p. 148, fol. 245.

Where he says: "Securely fastens that end of the envelope, so that it cannot be opened, etc.;" and subsequently uses these words: "The eyelet passes in part of its circumference, through the two folds of the paper which make the seam."

He does not add, which is the fact, however, that this limiting to "part of its circumference," changes the nature of the device, and leaves the back ply free to be removed at pleasure.

Neither does he add—which is also the fact—that the back ply does not extend up far enough to prevent the removal of the contents.

Why this peculiar construction, unless it be for the purpose of making a colorable difference, whereby to evade the patent?

To recapitulate the assignment of errors, as claimed by the appellant.

The appellant claims that the Circuit Court erred in holding:

1.—That the claims of reissue, No. 10,488, are unwarrantably expanded.

2.—That the facts of the case of Conn *vs.* Wilson are analogous to those of the present suit.

3.—That the 1st and 2d claims of said reissue patent if broadly construed are invalid.

4.—That the defendants did not infringe said claims.

5.—That in view of the Ullman and other structures the Dunham Letters Patent, No. 311,118, must receive a limited and not a broad construction.

6.—That the defendant did not infringe said letters patent.

And further:

7.—That the Circuit Court erred in dismissing the Bill of Complaint.

We accordingly submit that the decree below should be reversed and the cause remanded, with directions to enter a decree for the Complainant, and to proceed therein in accordance with the usual course of equity.

ARTHUR S. BROWNE,
CHARLES G. COE,
Of Counsel for Appellant.

Supreme Court of the United States.

Office Supreme Court, U.
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MAR 15 1894
JAMES H. McKENNEY
CLERK

No. 294.

JOSEPH T. DUNHAM,

APPELLANT,

v.

THE DENNISON MANUFACTURING CO.,

APPELLEE.

BRIEF FOR APPELLEE.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

W. W. SWAN,
of Counsel.

BOSTON:
ALFRED MUDGE & SON, LAW PRINTERS,
No. 24 Franklin Street.
1894.

Supreme Court of the United States.

No. 294.

JOSEPH T. DUNHAM, *Appellant*,

v.

THE DENNISON MANUFACTURING COMPANY, *Appellee*.

DEFENDANT'S BRIEF.

THE PLEADINGS.

The bill is brought for the alleged infringement of reissued Letters Patent No. 10,488, dated June 10, 1884, granted to the appellant Joseph T. Dunham for "a new and improved combined tag and envelope", and Letters Patent No. 331,118, dated Nov. 25, 1885, granted said Dunham for certain improvements in envelopes.

The answer denies infringement of either patent, and further denies the patentability of any of the alleged inventions described and claimed. The answer also alleges that the said reissued patent No. 10,488 is not for the same invention as the original patent of which it is a reissue; it alleges laches and fraud in obtaining the reissue, and that the said original patent was surrendered to introduce new matter in the specification and to claim other and different inventions from those claimed in the original patent.

The answer also denies that the said Dunham was the original and first inventor of the alleged improvement patented in said patent No. 331,118, or that the alleged invention was new and useful, and alleges that if said Dunham was such inventor as alleged, the pre-

tended invention, described and claimed in said patent No. 331,118, was by him abandoned to the public long prior to his application for the said patent.

IN THE COURT BELOW IT WAS HELD as to the reissued patent No. 10,488, that the appellant "made no move until the defendant had produced its envelope which could be sold without infringing the original patent," and that "he now seeks by the reissue to include structures and improvements which were neither described nor claimed in the original," and that this he cannot do. As to the second patent, it was held that "the claims must be restricted to the form and description of the patent, and that thus construed they are not infringed." Rec., p. 180; 40 Fed. Rep., 667,670.

From this decision an appeal is now taken to this court.

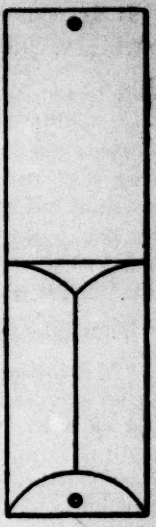
THE PATENTS IN SUIT.

1. THE REISSUED PATENT No. 10,488 is printed in the Record at page 87.

The patentee says: —

"My invention consists in a tag provided with means for attaching it to the merchandise, and with an envelope or pocket to receive a bill or invoice of the merchandise.

"In order that my invention may be the better understood, reference may be had to the accompanying drawings, forming part of this specification, wherein I have shown my combined tag and envelope in its preferred form."



The cut here shown represents the envelope shown in the drawings of the reissued patent without letters of reference. The structure claimed and the manner of using it are thus described in the body of the specification: —

"An envelope, A, preferably made of strong water-proof paper, is provided with an end flap of sufficient size to substantially cover the side of the envelope. An eyelet hole, C, is arranged in the end of the envelope opposite to that to which the flap B is attached, and the flap B is provided at its free end with an eyelet hole, D, which coincides with the eyelet hole C when the flap is folded over on the envelope. The full address of the consignee is written on the inner surface of flap B as shown in figure 1. . . . The combined tag and envelope is used in the following manner: The bill or statement is placed in the envelope A, and the flap B is folded over on the envelope A, and a cord hook or other device for holding the tag to the box, barrel, package, etc., is passed through the eyelets C, D, and is then secured to the package, etc., whereby it will hold the flap closed over the envelope; *or the envelope can be tacked to the barrel, box, etc., and the free end of the flap is passed under a metal, rubber, or oil-cloth strap tacked over that end of the envelope opposite to the one to which the flap is fastened, whereby the flap will be closed over the envelope, and in either case can easily be opened in case an employe of a railroad or express company wishes to read the address written on the under side of the flap.*"

The reissued patent has three claims as follows: —

"1. A combined tag and envelope, substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise, as set forth.

"2. A combined tag and envelope, substantially as described, the flap having an eyelet-hole which, when the said flap is folded down on the envelope, coincides with an eyelet-hole in the envelope, whereby the cord or hook for attaching the tag may be passed through both holes, substantially as set forth.

"3. In a combined tag and envelope, the combination, with an envelope, A, having a flap, B, at one end, of the eyelet D in the free end of the flap, and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as herein shown and described, and for the purpose set forth."

It is contended by the appellant that the first two claims are infringed.

2. THE SECOND PATENT, No. 331,118, is printed at page 89 of the Record.

The statement of the invention is as follows: —

"My invention relates to an envelope designed primarily for use as an envelope for mailing samples and other like matter, and for use as a tag for marking goods to be shipped. An envelope for mailing samples must, in order to be subject to postage rates as third class matter, be left unsealed; and it has been customary to provide envelopes of this character with a sealing flap at one end and a flap secured by a string or paper fastener at the other end; but in order to get at the contents of the envelope for examination it has been necessary to untie the string or remove the fastener both of which must be carefully replaced. My invention obviates these difficulties by rendering the removal of the fastenings unnecessary, by reason of the peculiar construction of the envelope."

The patentee says: —

"Fig. 1 is a back view of my improved envelope as I prefer to make it for use as a mailing envelope for samples."

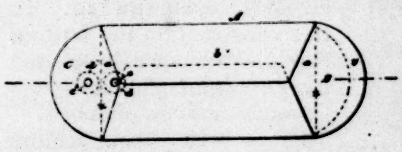
Also:

"Fig. 6 shows my improved envelope as I prefer to construct for use as a tag and envelope the bottom flap in this case being secured by a metallic eyelet."

He thus describes the structure: —

"In Fig. 1 the triangular portion of the front *a* is seen at each end of the back *b*.

"B is what I call the 'bottom flap', and C is what I call the 'top flap'. In closing the envelopes these flaps are folded on the dotted line x x as will be well understood. The bottom flap B is or may be provided with a coat of gum y to make it self sealing.



"The front a of the envelope has a hole c punched in it quite close to the end of the back b as seen at the left in Fig. 1, and this hole is reinforced by a washer d. The flap C has also a hole c^1 punched in it in a position to register with the hole c when the flap C is folded down as in Fig. 2, and this hole is reinforced by a washer d^1.

"The envelope may be furnished to the trade with the flap C turned down and secured by a paper fastener e, as in Fig. 3, or any other suitable fastener. The flap B is left unsealed and the user inserts the material to be mailed at the bottom and seals down flap B in order to close the filling aperture. The flap C and the washers d^1 d^1 overlap the back b and thus secure the end of the envelope from being accidently opened and the contents lost." . . .

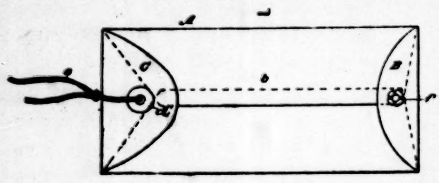
He also says: —

"Where the flap C is secured by a readily applied fastening the bottom flap B might be sealed down in the manufacture thus leaving the other end open for the insertion of the matter to be mailed, the flap C to be secured by the user after filling the envelope. The flap C might be conveniently secured by a string e^1 as indicated in Fig. 4, and where the envelope is used as a tag for marking goods to be shipped, this string might serve to attach the envelope tag to the goods."

The specification further says: —

"I may sometimes gum the flap C to the exposed surface of the inner surface a, but this I do not consider necessary, and I may also, where the envelope is to be used as a tag and is liable to rough usage in handling, gum the corners of the flap C lightly to the back b to prevent its being too easily bent back; but this sealing if used should be of such a character as to be readily broken by the insertion of the finger under flap C."

The patentee says further in his specification : —



"In Fig. 6 I show the envelope as I prefer to construct it for use as a tag. In this construction the bottom flap B is permanently secured by an eyelet *f* that passes through and is clinched. This is better than sealing with the ordinary gum as the flap will not be freed by dampness. The bill or invoice is to be inserted at the other end, and the flap C secured by a string or wire whereby the tag is attached to the goods."

The patent closes with the following disclaimer : —

"As I have before stated mailing envelopes have been used having one flap tied or fastened down in some similar way and the other flap sealed ; but in these the fastening device must be removed to get at the contents.

"In my former patent also I showed a combined tag and envelope, and this I make no claim to herein."

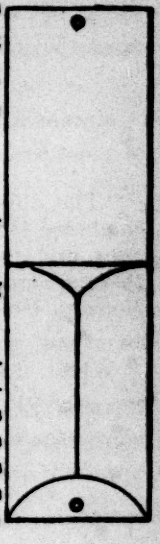
There are two claims as follows : —

"1. An envelope having a flap, C, provided with a reinforced hole, *c'*, and having a similar hole, *c*, in the front ply of its body, and the said holes constructed to register to coincide when the flap C is folded down, whereby the end of the back ply, *b*, of the envelope body, which extends entirely across the latter, is clamped and removably secured, substantially as shown and described.

"2. A mailing and tag envelope having a flap C, folded over and secured down to the inner face of the front ply of the body, and said flap being also constructed to take over the free end of the back ply of the body, as shown, whereby the mouth of the envelope covered by said flap C is secured against accidental opening, substantially as and for the purposes set forth."

INVALIDITY OF THE REISSUED PATENT 10,488, BY REASON OF EXPANSION OF CLAIMS AND LACHES.

A cut of the envelope shown at Fig. 1 of the original patent (No. 257,245, dated May 8, 1883) of which No. 10,488 is the reissue but without letters of reference, is shown at Fig. 4, on the second page of the cover of this brief, and is here reproduced, but without the lettering. (See Fig. 1, opposite p. 87 of Record.)



Of Fig. 1 the original specification states: —

"Fig. 1 is a longitudinal view of my improved combined tag and envelope showing it opened."

And the following description is given of the thing patented: —

"An envelope, A, preferably made of strong waterproof paper, is provided with an end flap, B, *of sufficient size to cover the entire envelope.* An eyelet, C, is secured to that end of the envelope opposite to the one to which the flap B is attached, and the flap B is provided on its free end with an eyelet D, which, when the flap B is folded over the envelope, rests upon the eyelet C."

There were two claims as follows: —

1. "A combined tag and envelope made substantially as herein shown and described, and consisting of an envelope having at one end a flap *of sufficient size to cover one side of the envelope*, as set forth.

2 "In a combined tag and envelope, the combination, with an envelope A having a flap B at one end, of the eyelet D in the free end of the flap and the eyelet C in that end of the envelope opposite the one to which the flap is attached, substantially as shown and described, and for the purpose set forth."

The long flap is not mentioned in terms in Claim 2, but, as we have just seen, the flap B is provided at its free end with an eyelet D, which, when B, "of sufficient size to cover the entire envelope," is folded *over the* envelope, rests upon eyelet C, and this construction necessitates a long flap.

Moreover, the statement of the invention in the application for the original patent *when filed* included the following passage: —

"The object of my invention is to provide a new and improved combined tag and envelope which is adapted for attachment to packages, and which is also adapted to receive the bills or the invoices, so that the consignees will receive the bill or the invoice with the goods." Rec., p. 106, fol. 174.

When the claims were finally settled upon, the Patent Office *required the applicant to modify his statement of invention to correspond with the clauses of claims as then presented.* And thereupon applicant amended in these words: —

"Erase the object and statement of invention and substitute: 'The object of the invention is to form an envelope **with an end flap covering its side**, as hereinafter described.'" Rec., p. 110, fol. 180.

The reissued patent, 10,488, has three claims. The third is the same as the second of the original and it is not pretended that it is infringed.

The other two are: —

1. "A combined tag and envelope, substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise as set forth.

2. "A combined tag and envelope, substantially as described, the

flap having an eyelet-hole which, when the said flap is folded down on the envelope, coincides with an eyelet-hole in the envelope, whereby the cord or hook for attaching the tag may be passed through both holes, substantially as set forth."

The defendant contends that not only are these claims on their face an illegal expansion of the claims of the original patent, but that the admissions of the appellant conclusively show the invalidity of the reissued patent under the rule laid down in Coon *v.* Wilson, 113 U. S. 277.

What led to the reissue? The original patent bears date May 8, 1883. In August, 1883, Dunham learned that the defendant was in the market with a tag envelope.

Some of the testimony on this point is as follows. Andrews, a travelling salesman for Dunham in a letter to Dunham dated Aug. 3, 1883, put in evidence by appellant's counsel, says: —

"Some see the point now, and I found some now using the common envelope with eyelets for the same purpose yours are used and designed for; and again what is there to prevent any one from adopting one like the enclosed, of size larger, to enclose bill and put the address on the outside when they don't care who see it, or they can double the envelope over?" (Rec., page 55, folio 93.)

And Dunham testified (page 56): —

"*Int.* 106. How long after the receipt of this letter was it that you first learned that Dennison was manufacturing a tag envelope?

"*Ans.* Very soon after the letter came to me.

"*Int.* 107. Had you any suspicion that this tag envelope and your agent had anything to do with Dennison & Co.'s putting their tag envelope on the market?

"*Ans.* I had.

"*Int.* 108. What caused that suspicion?

"*Ans.* From hearing from different parts of the country that Dennison had put a tag envelope on the market about that time."

Dunham also testifies that the **Taylor & Mayo exhibit**, an envelope precisely like that of his second patent, came into his hands in August, 1883. (Rec., page 52, folio 89; Rec., page 52, Int. 82.)

Connett, the patent solicitor in the matter of the reissue, testifies: —

"I considered the original patent inoperative within the meaning of the statute, for the reason that it did not fully protect him in the exclusive right to make, use and sell his invention, which is the purpose and function of a patent. The claim, while fairly covering the particular form of tag envelope illustrated in the patent, and which I understand to be the preferred form, could be evaded by a very slight change in the shape and size of the flap, and this change would not materially affect the value of the tag envelope. . . . **I saw no necessity for limiting him to making the flap large enough to cover the flap of the envelope.**" (Rec., page 61, folio 103.)

More than this, Dunham himself in support of his application for a reissue filed a sworn statement in which he says that **the original claims**

"**limit him to a combined tag and envelope, comprising an envelope having a flap at one end of sufficient size to cover one side of the envelope**, with the eyelet or holes, by means of which it is attached to the goods at the ends of the envelope opposite that at which the flap is attached and in the free end of the flap. That this language so restricts the scope of the said patent that **any one may readily construct a combined tag and envelope that will fulfil all the essential requirements, by so constructing the flap that it will not cover the side of the envelope** and having the holes for attachment at some place other than the end opposite that to which the flap is attached, and thus evade his patent and render it practically inoperative and worthless as a protection." (Exhibit File, etc., Patent No. 10,488, Rec., page 116, folio 190.)

Again Dunham, in an affidavit filed as one of the moving papers on the motion for a preliminary injunction in this case, said: —

"Deponent further says that soon after he put the article in the market he ascertained that defendant was manufacturing and selling a combined tag and envelope substantially like the one described and shown in complainant's Letters Patent.

"Deponent says that exhibit G hereto attached is one of such combined tag and envelope brought to the notice of deponent in the latter part of the summer or in fall of 1883, *and is the first of which he had knowledge.*

"Deponent further says that as the only difference between the article exhibit G and deponent's patented device is that defendant has shortened one end of the flaps and made the attaching eyelet at the other end to co-operate with the shortened flaps and accomplish the same purpose, and as the very form used by defendant *was one of the forms invented by deponent but not shown in his patent*, because he supposed and was informed by his solicitor that one covered the other, deponent considered it a direct infringement of his patent, and consulted counsel in relation to it, and was advised by his counsel, as the Letters Patent were new and did not cover all his invention clearly, to surrender his patent and obtain a reissue.

"That applicant did so surrender, etc." (Rec., pages 137, 138, folios 225, 226.)

In Coon *v.* Wilson, this Court said: —

"Although this reissue was applied for *a little over three months* after the original patent was granted, the case is one where it is sought merely to enlarge the claim of the original patent by repeating that claim and adding others; where no mistake or inadvertence is shown so far as the short or sectional bands are concerned; where the patentee waited until the defendants produced their continuous band collar, and then applied for such enlarged claims as to embrace the defendants' collar, which was not covered by the claim of the original patent; and where it is apparent from a comparison of the two patents that the reissue was made to enlarge the scope of the original. As the rule is expressed in the recent case of *Mahn* v. *Harwood*, a patent 'cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application

for the reissue is made within a reasonably short period after the original patent was granted.' **But a clear mistake inadvertently committed in the working of the claim is necessary, without reference to the length of time.** In the present case, there was no mistake in the wording of the claim of the original patent. **The description warranted no other claim.** It did not warrant any claim covering bands not short or sectional. The description had to be changed in the reissue to warrant the new claims in the reissue." 113 U. S. 268, 277.

It may be added that in the present case, the original description not warranting a claim to an envelope not provided with a long flap, the following passage applicable to an envelope with short flaps only, as well as to one provided with a long flap, was inserted in the new description: —

"By the means for attaching the tag to the merchandise, I refer to the holes C and D, through which the cord or hook is passed. These, as intimated, are re-inforced by eyelets of some suitable material. **The cord or hook employed for securing the tag to the merchandise also serves, as shown, to close or secure the envelope and prevent its contents from escaping in transit.**"

Comparing Coon *v.* Wilson with the present case, the learned judge in the court below well said: —

"By substituting the nomenclature pertaining to envelopes for that relating to collars, the opinion in Coon v. Wilson is as applicable to this controversy as if written for the purposes of this action only."

We have seen that the original patent contained the following passages: —

"The full address of the consignee is written on the inner face of the flap B as shown at Fig. 1."

And,

"Furthermore the address is concealed, and dealers cannot ascertain the addresses of their competitors. At the same time the express and railroad companies can easily ascertain the addresses by raising the flap B."

It is true that these passages remained in the specification of the reissue, but reading the reissue as a whole, it is clear that the long flap B has been discarded as an element of the invention, and that the new claims of which infringement is alleged (they are to be found on page 8 of this brief) have been expanded to cover an envelope, no matter what the size or shape of its flap may be.

We submit, therefore, that under many decisions of this Court such expansion is illegal, and that the reissued patent is invalid.

See Miller *v.* Brass Co., 104 U. S. 350.

PROCEEDINGS IN THE PATENT OFFICE ON THE APPLICATION FOR THE REISSUE.

The appellant in the affidavit already mentioned alleged that, prior to his invention, to the best of his knowledge and belief,

"it was the universal practice to mark packages on the packages themselves, or on a simple card or tag, such as were made and sold by the defendant and affixed thereto, and to send the bill or invoice by mail in an ordinary sealed and stamped envelope." (Exhibit Dunham's Affidavit, Rec., page 136, folio 222.)

From this it might be inferred that the appellant now contends that the claims of the reissue are to be construed as covering broadly any tag provided with a pocket capable of being closed.

But the patentee must be restricted by his admissions in the Patent Office. He is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant. A certified copy of the file wrapper and contents in the matter of the application for a reissue has been put in evidence, and a comparison therewith of the reissued patent, as granted, conclusively shows that a tag envelope was not new and was admitted not to be new at the date of the patentee's alleged invention, and that he is not entitled to this broad construction of his claim.

In the affidavit accompanying his application for the reissue Dunham swore as follows: —

"Deponent further says that he believes he was the first to construct a marking tag with means for attaching it to merchandise and provided with a receptacle capable of being closed, and adapted to receive a bill or invoice of the goods to which the tag is attached, and that he is entitled to claim this broadly enough to cover such a device." (Exhibit File, etc., Patent 10,488, Rec., page 116, folio 190.)

And the application for the reissue contained the following claim :—

"1. A tag for marking merchandise provided with an envelope or pocket substantially as set forth." (Rec., page 115.)

This claim was rejected, the examiner saying in his letter: —

"It has long been common to employ an ordinary envelope for a tag to enclose a shipping bill. Also to receive the address of the consignee. Such common use renders the first claim unwarranted." (Rec., page 119.)

The appellant then asked for a reconsideration, saying: —

"He believed, and now thinks, that he is the first to have provided a marking tag with a pocket to receive a bill or letter." (Rec., page 120.)

But the claim was again refused, "for reasons stated in former letter," the examiner adding: —

"The employment of an envelope for the purpose stated is a matter of personal knowledge to the examiner, and a matter within the experience of almost every shipper of goods in the country." (Rec., page 121.)

Whereupon the appellant abandoned the claim. (Record, page 121.)

The patentee's solicitor of patents, Connett, testifying as to the withdrawal of the claim, says: —

"To the best of my recollection, the claim was refused by the examiner on the ground that it was too broad to be patentable in view of some use of envelopes as tags within his own knowledge, and after a conference respecting it with the patentee, Mr. Dunham, the examiner's decision was not contested, and it was stricken out."

The following cases are applicable: —

MAHN *v.* HARWOOD, 112 U. S. 354, 361. — "The public is notified and informed by the most solemn act on the part of the patentee, that his claim to the invention is for such and such an element or combination and for nothing more. Of course, what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention."

SARGENT *v.* HALL SAFE & LOCK CO., 114 U. S. 63, 86. — "In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into

an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers."

SHEPARD *v.* CARRIGAN, 116 U. S. 593. — "Without this element, the patent would not have been issued. The Patent Office decided, and it is clear that without it the invention had been anticipated. Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent."

SUTTER *v.* ROBINSON, 119 U. S. 530, 541. "A comparison of the patent as granted with the application, very conclusively establishes the limits within which the patentee's claims must be confined. He is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant."

CRAWFORD *v.* HEYSINGER, 123 U. S. 589, 606. "The patentee having imposed words of limitation upon himself in his claims, especially when so required by the Patent Office in taking out his reissue, is bound by such limitations in subsequent suits on the reissued patent. Such have been the uniform decisions of this Court in like cases."

ROEMER *v.* PEDDIE, 132 U. S. 313, 317. "This Court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it."

And after citing a long list of cases in the support of the rule, the Court added: —

"It is contended by the defendants, that, in view of the prior state of the art, the patent is invalid. We do not consider it necessary to examine that question, because, for the reasons before assigned, we are of opinion that the decree (dismissing the suit) must be affirmed."

ROYER *v.* COUPE, 146 U. S. 524, 532. In this very recent case, the Court, after stating that the patentee had acquiesced in rejections of two claims by the Patent Office and had modified his claims accordingly, said:

"It is well settled, by numerous cases in this court, that under such circumstances a patentee cannot successfully contend that his

patent shall be construed as if it still contained the claims which were so rejected and withdrawn. *Roemer* v. *Peddie*, 132 U. S. 313, 317, and cases there cited. The principle thus laid down is that where a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed if such limitations and restrictions were not contained in it."

The defendant submits that under these decisions the claims of the reissued patent, 10,488, in suit must be construed as for an envelope with a long flap and only for an envelope with a long flap.

STATE OF THE ART.

With this **acquiescence and admission** on the part of the complainant, that ordinary envelopes had been used as tag envelopes prior to his alleged invention it would seem **unnecessary to introduce testimony** to prove such use.

The defendant, however, has introduced testimony to prove the prior use of tag envelopes as such, and eyeletted envelopes for various purposes, that must be taken as fully anticipating the appellant's claims, or at least as so limiting them that there is no infringement.

The state of the art, it may be observed, is of no importance, except, perhaps, with respect to the alleged infringement of the second patent in suit, No. 331,118.

PATENTS INTRODUCED TO SHOW THE STATE OF THE ART.

The defendant has put in evidence three patents as bearing upon the state of the art, viz.: No. 81,962, dated Sept. 8, 1868, to Sigmund Ullman for improvement in envelopes (Rec., page 175); No. 219,879, dated Sept. 23, 1879, to Alexander H. Schultz for improvement in sample envelopes (Rec., page 177); and No. 227,077, dated April 27, 1880, to Kilbourne Tompkins for improvement in envelopes (Rec., page 179.)

THE ULLMAN [1868] PATENT.

A copy of the specification and drawings of the patent to Sigmund Ullman, No. 81,962, dated Sept. 8, 1868, for improvement in envelopes, will be found at page 175 of the record.

The invention of the Ullman patent, it is said in the specification,

"relates to a new and improved application of an eyelet seal or fastening to the envelope, whereby the former are permanently attached to the latter, so that they may be sold with them, and purchasers enabled to seal the envelopes with the greatest facility." (Ullman specification, Rec., page 175.)

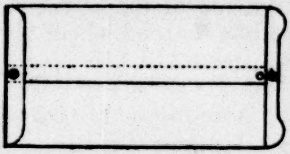
The Ullman envelope* described and shown has a tubular body with two short end flaps, one of which is permanently fastened down to the body by gum and a clinched eyelet passing through flap and body, thus permanently closing one end of the envelope. The other end is gummed and has coinciding holes through the body and flap, with an unclinched eyelet passed through the hole in the flap and held therein by a piece of paper pasted on the outside of the envelope over the flange of the eyelet.

The Ullman specification says: —

"In putting up the envelopes for sale the eyelet of the flap *c* is riveted and said flap gummed down. The other flap *c'* is left

*See also Fig. 1, p. 2 of cover, where all the envelopes of importance in the case are shown.

open and its eyelet *d* secured in it by gumming a strip of paper or other suitable material, *e*, over said eyelet, at the outer side of the flap, and over the inner side also, if desired (see more particularly Fig. 5). By this means the eyelet is secured to the envelope, and is put up and sold with them, *eyelet holes f' being made through the end of the envelope to receive the eyelet*, so that all the purchaser or user is required to do in order to seal the envelope, is to moisten the inner side of flap *c'*, turn it over and pass the eyelet through the holes *f'*, press the flap against the body of the envelope, so that it will be gummed thereto, and then rivet the eyelet, which may be done by means of a small punch or other suitable device."



Mr. Renwick, in his description of the Ullman envelope, says (Rec., page 146, folio 243) : —

"The envelope patented to Ullman is an envelope in which the flaps at each end thereof are secured by an eyelet which passes through the flap and both sides of the envelope. This envelope can be used as a tag envelope by passing a string through one of the eyelets, and can receive an invoice, but the invoice cannot be got out of the envelope after both eyelets are fastened, unless one eyelet is unfastened, or the envelope is cut open.

"In addition to the eyelets the flaps are also gummed so that they may be sealed down in the ordinary way."

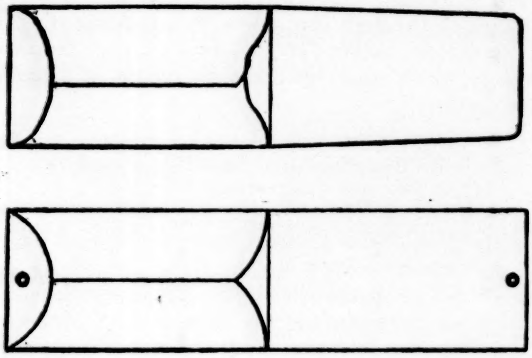
THE KILBOURNE TOMPKINS [1880] PATENT.

The Tompkins patent, No. 227,077, dated April 27, 1880 (Rec., page 179), is for an envelope precisely like the envelope of the reissued patent No. 10,488 without eyelet holes. The body is tubular in shape, with two end flaps, one long and the other short. The specification says : —

"The invention consists in making the end flap A long enough to reach, when folded, **nearly or quite to the bottom or opposite end of the envelope, and as near to the full width of the envelope in the other direction as it can be made**, and folded inside under the flaps C and D, which are folded over the flap A and pasted (the flaps C and D) one to the other, so as to allow the flap A to be withdrawn from the

envelope without destroying the envelope, so that when mailable articles are placed within the envelope, they are securely kept and protected, the flap being fastened on the outside of the envelope with gum or wax or other sealing material, while the end where the flap A is folded in remains unsealed." (Rec., page 179.)

We give a cut of the Tompkins envelope. Also below it a cut of the reissue envelope.



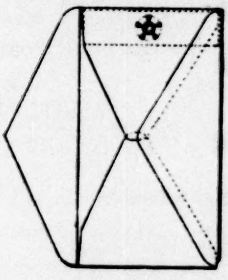
THE SCHULTZ [1878] PATENT.

The Schultz envelope is a tubular envelope with two end flaps, one of which is tied down to the body by a string passing through a hole in the flap and two holes in the back seam of the envelope, while the other is gummed and left open to be sealed after receiving the enclosure. (Rec., page 177.)

It should be noticed that the Schultz envelope, the Pultz & Walkley envelope, the Ullman envelope, the Kilbourne Tompkins envelope, and the defendant's envelope all have a gummed flap, which is left open ready for sealing after the enclosure is inserted in the envelope at the end or side to which such gummed flap is attached. And we shall find that this is true of the envelope of the complainant's second patent in suit, No. 331,118, when it is intended to be used as an envelope for mailing samples. This is not the case, however, with the envelope of the complainant's reissued patent, No. 10,488.

The Pultz & Walkley Tag Envelope.

It is established by the evidence that the plaintiff was not only not the first to make and use a tag envelope, but that he was not the first to make such an article for sale, and was not the first to use the name in the trade. The envelope here referred to is the Pultz & Walkley Tag Envelope represented in the case by several exhibits.



The Pultz & Walkley tag envelope is the envelope in most common use with a re-enforced hole at one end. The re-enforcement consists of a star-shaped piece of tin with a hole in the centre, the points of the star being bent and clinched through the envelope, which is further strengthened at the re-enforced hole by a separate narrow strip of tag stock inserted between the back and front of the envelope. The open flap is at one of the long sides of the envelope, and is substantially triangular in shape. It has gum along the two free sides which meet substantially at the centre of the envelope. (A cut is given here; and see envelope No. 2, p. 2, of cover.)

"*Cross-Int.* 138. How were the eyelets put into the envelopes, — by hand or by machinery?

"*Ans.* That slip of tag stock was cut the right width and slipped in, the hole was punched through the envelope with a small power press and the eyelet set by a foot press."

Tucker's deposition, Rec., p. 104.

This Pultz & Walkley tag envelope was first manufactured as early as 1875, and has been upon the market ever since that year. The evidence relating to it is found in Defendant's Record in the depositions of Geo. E. Tucker, p. 91; Lucius V. Walkley, p. 159; and H. K. W. Hall, p. 167.

The Pultz & Walkley Co. was organized in 1870, and is located in Plantsville, Conn. Their business consists in the "manufacture

of paper machine bags, flour sacks, hand bags, tags, tag envelopes job printing, etc."

Tucker's deposition, Rec., Int. 5, p. 92.

The business was the same at the organization of the company, with the exception of the manufacture of tag envelopes. They began to manufacture tag envelopes as early as 1875.

Tucker, p. 97, Cross-Ints. 38, 44.

Tucker superintended the job printing, and this he has done from the organization of the company till the present day.

Tucker's deposition, Rec., p. 96, Cross-Ints. 26, 27.

These articles at the time had the name of tag envelopes. This is fully proved by a circular which Tucker produces as printed by himself prior to the last Sunday in October, 1876. He knows that he himself printed this circular, and he fixes the date from several kinds of type used in printing it which were destroyed in a fire which the place on the night of that Sunday and which have never been replaced.

The circular is as follows: —

"TAG ENVELOPES.

"We desire to call the attention of the manufacturers and merchants and all who have occasion in their business to send express packages to their customers to our

"NEW INVOICE TAG ENVELOPES.

"In introducing this novel and useful article, we feel confident that it meets a want long felt by shippers, and will prove a great saving of both time and money.

"It often happens that a package is sent to a customer by express and invoice by mail, the package reaches its destination before the invoice and is a source of great inconvenience to the customer; the Invoice Tag Envelope remedies this, as package with invoice reach them at the same time. Packages are sent to city customers with invoice inside, which causes a delay in shipping department waiting for invoice; by using the tag envelope (which costs about the same as a tag) the package is done up and invoice and tag ready to put on package at once, it saves marking the package, takes the place of a tag, and is perfectly safe.

"In a thousand uses that this can be put to it is in every case a penny saved, and doing away with a great many annoyances, in fact it answers all purposes of a common tag, and the double purpose of a tag and envelope combined.

"*Sent free to any address on receipt of price. Give plain printing directions.*

"No. 20 M. $3.00 per 1000.

"No. 25 M. $3.50 per 1000.

"No. 30 M. $4.00 per 1000.

"Printing $1.00 per 1000 extra.

"Stringing $0.50 per 1000 extra.

"Address all orders to sole manufacturers.

"THR PULTZ & WALKLEY CO.,
Plantsville, Conn."

Tucker's testimony as to the date of the circular is as follows (Rec., p. 96):—

"*Cross-Int.* 21. What enables you to say that you printed this circular prior to Nov. 1, 1876?

"*Ans.* The factory was burned up on the last Sunday night in October, 1876, and there are several fonts of type on this circular which have never been replaced in the new shop, at least three.

"*Cross-Int.* 22. Will you point out and mark on this circular and price list the three kinds of type burned up, as you say, and not replaced?

"*Ans.* The first line 'Tag Envelopes' for one. On the fifth line 'New Invoice Tag Envelopes.' Also the five lines making up the price list.

. . . . . .

"*Cross-Int.* 96. How long did you continue to be the only person who set up type in that establishment?

"*Ans.* They haven't employed any other man to set type since the company was organized."

Tucker produced a tag envelope which he swore was made prior to Nov. 1, 1876.

His testimony fixing the date is as follows (Rec., p. 92):—

"*Int.* 8. Will you state, if you can, when this *identical* envelope, produced by you in the answer to the last interrogatory, was made?

"*Ans.* It was made previous to Nov. 1, 1876.

"*Int.* 9. How do you fix this date?

"*Ans.* I fix it by the type and printing, the type for the line 'Invoice Tag Envelope' was issued previous to that time, and because

the factory was burned the last Sunday night in October, 1876, and we never used that font of type since in the shop on a tag envelope; we have never had the font in the shop, we never replaced it since the fire.

"*Int.* 10. Who did the printing upon the exhibit?

"*Ans.* I did."

[The envelope was one designed by Pultz & Walkley to be used in their own business, and printed upon it their own advertisement. Rec., p. 98, Cross-Int. 49.]

"*Int.* 11. Will you read the printing upon the exhibit?

"*Ans.* Upon the front side under a space for the address are the words 'From the Pultz & Walkley Co., Manufacturers of the Patent Clasp Eyelet Shipping Tag and Invoice Tag Envelopes, Plantsville, Conn.,' and on the back, 'Sample of No. 25 M. price $3.40 per 1,000.

"'No. 20 M. size smaller $3.00 per 1,000.

"'No. 30 M. size larger $4.00 per 1,000.

"'Printing $1.00 per M. extra.

"'Stringing 50 cents per M. extra.

"'Sent free to any address on receipt of price.

"'This novel and useful invention answers the double purpose of the common tag and envelope, so that the invoices may be sent with express and other packages, saving time and money. Send plain printing directions with orders.'"

Mr. Lucius V. Walkley, manager of the Pultz & Walkley Company, was also called as a witness. He knew nothing about the identical exhibit produced by Tucker and sworn to as made before the fire of October, 1876; but he said that his firm had been engaged in the manufacture of tag envelopes "some ten or twelve years." (Rec., p. 159, Int. 2.)

He produced an envelope such as his company manufactured during this time, and it was marked "Defendant's Exhibit P. & W. Tag Envelope No. 2," and was thus referred to in the cross examination (p. 128) and elsewhere; but the magistrate neglected to note upon the record that the exhibit was so marked.

We quote from his testimony (Rec., p. 159): —

"*Int.* 3. Will you produce a tag envelope of your manufacture to be marked as an exhibit in this case, and will you state how long your company have made and sold tag envelopes substantially like the exhibit?

"*Ans.* I produce a tag envelope made at our factory, and to the best of my recollection, we made and sold on the market as early as 1875, substantially the same thing, the only difference, perhaps, being the envelope itself. We bought those of different manufacturers at different times, and then re-enforced them by pulling a piece of cardboard in at one end, and inserted our patent eyelet, substantially the same as in the exhibit.

"*Int.* 4. You say 'to the best of your recollection.' How far back can you say with certainty that you manufactured and sold tag envelopes like the exhibit?

"*Ans.* 1875; I might qualify that, and say that I looked over the books recently, and find that there were sales of these goods made in 1875. I could not say to-day from memory."

"*Cross-Int.* 51. (Rec., p. 164.) How many tag envelopes did you sell to H. K. W. Hall?

"*Ans.* I think the first sale was one thousand.

"*Cross-Int.* 52. Did those envelopes have the same printing on which defendant's Exhibit Pultz & Walkley Exhibit has?

"*Ans.* I don't think they were printed at all.

"*Cross-Int.* 53. What induces you to think so? Have you a distinct recollection of the fact; or, if not, what other reason have you for so thinking?

"*Ans.* I have no recollection as to whether those were printed or plain; we furnished them to the trade and customers both ways.

"[*Complainant's counsel objects to all of the answer after the word 'plain,' the same as to answer* 45, *and reminds the witness that he has not given his reasons for thinking the envelopes sold to Hall were plain.*

"*Cross-Int.* 54. [*Question repeated.*]

"*Ans.* I have no particular reason except my knowledge of the man; his business habits would lead me to think that he would not use them printed, being of an economical turn of mind."

The witness Hall corroborates this testimony (Rec., p. 167): —

"*Int.* 3. Where did you obtain the tag envelope you have referred to in your last answer?

"*Ans.* I obtained them from Pultz & Walkley, Plantsville, Conn.

. . . . . .

"*Int.* 7. Where were you doing business when you began to purchase tag envelopes of Pultz & Walkley as you have testified?

"*Ans.* I think at 29 Hawley Street."

. . . . . .

The evidence as to the date of Hall's earliest purchases is too long to quote; but a careful reading of his testimony, including the cross examination, cannot but lead to the belief that Hall purchased tag envelopes of Pultz & Walkley before he removed from Hawley Street, and that he did move from Hawley Street prior to 1880. The latter fact is shown by the city directories for a series of years.

Hall's deposition, Rec., pages 167–172.

We quote from the Record, page 171: —

"*Cross-Int.* 40. When did you first see Exhibit Hall Tag Envelope, introduced by you in your testimony?

"*Ans.* I can't say whether I ever saw that one before. I have been familiar with them ever since I first saw them; whether I ever saw that identical one before, I can't say.

"*Cross-Int.* 41. By 'before,' do you mean before this was handed to you by defendant's counsel at the time it was introduced?

"*Ans.* I do, before this morning.

"*Cross-Int.* 42. Can you say whether this is in all respects like the first ones you purchased of Pultz & Walkley?

"*Ans.* I should think it was, with the exception that I generally used them of a larger size.

"*Cross-Int.* 43. Were those which you say you so purchased, plain, or did you have your address printed on them?

"*Ans.* I think we used them plain, but were in the habit of writing the word 'invoice' in large letters at the top so that customers would detach and take their invoice from it."

It will be observed that both Walkley and Hall testify that Hall purchased his envelopes "plain."

If the witnesses Walkley and Hall fail to establish the date of the first sales to Hall, they nevertheless fully prove that for a series of years the Pultz & Walkley Co. did manufacture and sell tag envelopes; and this is a sufficient corroboration of Tucker's testimony that the Pultz & Walkley Co. made and sold tag envelopes prior to 1880, and that he printed the identical Exhibit Pultz & Walkley Tag envelope prior to the October fire of 1876.

Mr. Renwick speaking of the Pultz & Walkley tag envelope, says (Rec., p. 146, fol. 242):—

"The Connecticut envelope, defendant's Exhibit Pultz & Walkley Tag Envelope, is furnished with holes passing through the envelope and an eyelet so that it can be used as a tag, and in that respect is like the envelope of the reissue. Further, in this envelope the bill could be put in the envelope and the flap turned down inside, as is the common usage in sending circulars, so as to hold the bill in, and then there would be no letter postage upon them."

The complainant called many witnesses to testify that they had never heard of the Pultz & Walkley tag envelope. Some were expressmen and forwarders of freight; others were fish dealers who in their trade require a tag envelope made of very strong paper. Nearly all these witnesses testified that in their opinion the Pultz & Walkley tag envelope and the Schultz tie envelope could not be practically used as tag envelopes, because one flap in them is secured by gum.

We quote from the testimony of the first half dozen witnesses.

Thomas W. Brackett (Rec., p. 22) speaking of the Pultz & Walkley exhibit, says:—

"There is nothing to hold the flap down after it became moistened.

"*Int.* 17. In using tag envelopes on packages which are in barrels or boxes containing ice for the preservation of the contents thereof, what effect would the ice have on the envelope attached to the outside of the package?

"*Ans.* The envelope would become wet and useless for either purpose as a tag or envelope."

Of a somewhat similar envelope, "The Schultz tie envelope," he says (p. 24, Cross-Int. 20), "One side of the body is merely held by paste and mucilage, and if it became wet or damp would fall apart."

R. H. Dunbarton (p. 25, Int. 16): "Will you state your reasons why they would not be proper marks for forwarding goods?

"*Ans.* From their general construction, being secured by gum, moisture or wet weather would cause them to come apart and thus lose their contents."

Robert A. McKinney (p. 27, Int. 12): "I should think the ends and sides were insecurely fastened together and would come apart when wet."

Sylvester Castle (p. 30, Int. 11): "The Pultz & Walkley tag enveolpe is of very poor paper for one thing, and the flap is liable to come open at any time and lose the invoice, and **I have occurrences every day of the gum becoming loose and the invoice falling out.**"

Thomas Dooley (p. 28, Int. 15): "Would or would not the fact of these envelopes being secured only by gum render them liable to become unfastened in damp weather, or when attached to damp packages, particularly packages containing ice, and render them liable or likely to become opened by the softening of the gum and thus allowing the enclosed invoice to escape and be lost?

"*Ans.* Yes, sir, it would."

William H. Weeks (p. 32, Int. 9): "These tags being gummed together would come apart and lose the invoice."

The complainant **Dunham** says (p. 53, Int. 23): "There is no strength to the paper when wet, and consequently when placed in a package of any kind the gum would loosen and the contents come out."

But this objection to the gummed flap applies with equal force to the defendant's tag envelope.

Indeed the witness **Castle**, quoted above (Rec., p. 31), testified that he had this very trouble with the defendant's envelopes *every day*.

Direct Examination resumed.

"*Int.* 19. Will you look at the exhibit now shown you, marked 'Compt.'s Exhibit Dennison's Patent Tag Envelope,' and state whether that is such an envelope as you refer to in answer to Int. 11, in which you say, 'I have occurrences every day of the gum becoming loose and the invoice falling out'?

"*Ans.* Yes, sir."

But this testimony can have no weight against the positive testimony of the witnesses Walkley and Tucker that the Pultz & Walkley Company have made and sold **for many years** and are **now** making and selling tag envelopes like the Pultz & Walkley exhibits, nor against the positive testimony of Hall that he used these envelopes in his paper business for many years. It may be admitted that a stronger envelope would be required by a fish dealer than by a shipper of paper.

Plaintiff's counsel gave notice that at the hearing he would move to strike out the testimony of the witness Walkley on the ground that the defendant declined to bring to New York, where the witness was examined, from Plantsville, Conn., certain books to which the witness had referred to refresh his memory as to certain dates.

Counsel for defendant was unwilling to be at the expense of time and money necessary to produce the books, exact dates being unimportant, since the testimony of Tucker producing the old Pultz and Walkley tag envelope and the Pultz and Walkley circular, supplemented by Hall's testimony was sufficient to show that the plaintiff was not the first to make and offer for sale a tag envelope as such.

Moreover, we refer to the Pultz and Walkley tag envelope merely to show that the name tag envelope did not originate with the plaintiff. The structure itself adds little or nothing to the state of the art as set forth in the statement of the examiner already given, in which the patentee acquiesced, viz: —

It has long been common to employ an ordinary envelope for a tag to enclose a shipping bill. (Rec., p. 119).

And:

"The employment of an envelope for the purposes stated is a matter of personal knowledge to the examiner, and a matter within the experience of almost every shipper of goods in the country." (Rec. p. 121).

DEFENDANT'S CONSTRUCTION OF THE CLAIMS.

We submit that under the state of the art as well as in conformity with the proceedings in the Patent Office the plaintiff's reissued patent 10,488 if valid must be construed to be for an envelope with a long flap, and only for an envelope with a long flap.

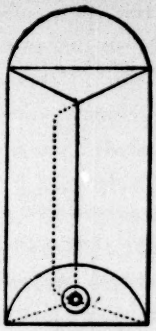
In like manner we submit that the claims of the plaintiff's second patent No. 311,188, if valid, must be construed in view of the state of the art, to be for an envelope, in which the flap at the "stringed" end merely overlaps the back ply without being fastened permanently thereto, so that it can be lifted when desired and the contents of the envelope examined at that end without tearing the envelope or removing or breaking the fastenings.

THE DEFENDANT'S ENVELOPE.

The defendant's envelope is represented in the case by complainant's Exhibit Dennison's Patent Tag Envelope, (Rec., p. 16, folio 31), and complainant's Exhibit Bergen Specimen Dennison Tag Envelope No. 2 (Rec., p. 19, folio 37.)

The defendant's envelope differs from the well known type of envelopes that has the open or unclosed flap at one end, only in having an eyelet in the opposite end.

The construction of the defendant's envelope shows that it is not intended that the closed end opposite the open or unclosed flap shall



be opened at any time for any purpose (and it cannot be opened) without destroying the envelope. The open flap is furnished with gum in the same manner as the "seal" flap of the millions of envelopes in universal use, and the gum may be moistened and the flap stuck to the body of the envelope, when the envelope has received its "enclosure" or the flap may be tucked into the interior of the envelope if the envelope is to remain "unsealed." There is a single eyelet at the permanently closed end which passes through the flap at that end, a portion of the back plies and the front of the envelope, and through this eyelet is passed the string for attaching the envelope to the goods. The mouth of the envelope is at the other end.

Evidently it is not intended that the defendant's envelope shall be opened and its contents removed at the end thus securely fastened. The bill or invoice is inserted at the opposite end, which is the mouth of the envelope; the flap at that end, or the mouth, is then fastened down by moistening the gum with which it is provided, or the flap may be tucked in between the back and front; in other words the defendant takes an ordinary envelope with the opening or mouth at one end, and at the other end, which is never intended to be opened, he puts an eyelet re-inforced by washers through the front ply, a portion of the back ply and the flap of the envelope. The sole *object* of the eyelet is to provide a suitable hole into which the cord or hook which fastens the envelope to the merchandise may be introduced. The *effect* of the eyelet is to prevent the back ply from being left free at this end.

The washers may be regarded as simply a trademark. They are the familiar washers of the Dennison tag.

The defendant's envelope differs from the Ullman envelope only in

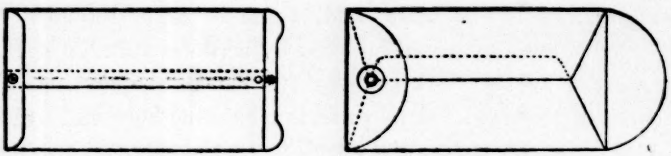
not being provided with an unrivetted second eyelet at the open end. The defendant and Ullman both have a clinched eyelet in the permanently closed end of their respective envelopes, but while Ullman provides the double security of both gum and an unclinched eyelet for fastening the normally open flap when the envelope shall have received its "enclosure," the defendant's envelope has only gum for that flap.

The alleged infringing exhibits as testified to by Mr. Renwick, are, **"a very ordinary kind of envelope with an eyelet driven through one end of it, so as to strengthen the joints at that end and serve as a means for attaching a string, like the structure shown in the Ullman patent."**

Renwick's deposition (Rec., pages 148, 149, folio 246)

There is no getting away from this: the defendant's envelopes are ordinary envelopes with end flaps, one of which is gummed down to the body, and provided with an eyelet that passes not only through it, but also through both the back and front of the envelope proper, thus closing and doubly fastening that end of the envelope, while the other flap is gummed upon its edge and left open that it may be sealed up if desired after an "enclosure" has been placed within the envelopes; or this free gummed end may be tucked up within the body of the envelope in cases where it it desirable to avoid sealing.

It is evident that by putting a string through the eyeletted hole shown at the left hand of the envelope shown at Fig. 2 in the drawing of the Ullman patent that envelope could be used for a tag envelope precisely as the defendant's envelopes are used.



In the cut the Ullman envelope is shown at the left; the defendant's at the right.

The complainant when taking rebutting testimony introduced, against defendant's objection, an envelope marked "Exhibit Taylor and Mayo" which is precisely like the envelope of complainant's second patent. He claimed that the exhibit was manufactured by the defendant, but acknowledged that it came into his possession in the fall of 1883. The only bearing that Exhibit Taylor and Mayo can have upon the case is to show that the complainant attempted by his second patent to cover a tag envelope that he found selling in the market in opposition to his envelope with a long flap. At all events, he cannot, under his second patent, hold the defendant for anything done prior even to the application for the patent.

The Court below found, as a matter of fact, that the envelope of the defendant was an ordinary envelope with the opening at one end, and having at the other end, which is never intended to be opened, an eyelet re-inforced by washers through the front ply, a portion of the back ply, and the flap of the envelope. It also held that the eyelet was an aid to the gum in fastening the flap down permanently upon the back ply of the envelope.

The Court said (Rec., page 184):—

"In the defendant's envelope one eyelet is used, which aids the gum in fastening the flap down permanently upon the back ply of the envelope. A large number of exhibits have been introduced showing the defendant's envelope. These have been changed and

mutilated by the witnesses in illustrating opposing theories. But both sides, apparently, agree that the envelopes made by the defendant since the date of this patent are constructed with the eyeleted flap securely fastened. The complainant's brief contains this statement: —

"'After defendant put its tag envelope on the market, it changed the construction several times, until it finally adopted the form introduced in evidence as the infringing specimen. See complainant's Exhibit Taylor and Mayo, which was received in 1883, and also has the eyelet holes, with washers, only; also complainant's Exhibit John S. Smith, which was received in 1884, and has the washers re-inforced with a short metallic eyelet, with the eyeleted end tightly gummed down. Also, Exhibit Alonzo B. Smith, received in 1886, with printed advertisement on front, which had the eyeleted end tightly gummed, with washers re-inforced by short metallic eyelets.'

"Evidently, it is not intended that the defendant's envelope shal be opened and the contents removed at the end thus securely fastened. The bill or invoice is inserted at the opposite end; the flap at that end is then fastened down, in the well-known manner, by moistening the gum with which it is provided, or the flap may be tucked in between the plies. In other words, the defendant takes an ordinary envelope with the opening at one end, and at the other end, which is never intended to be opened, he puts the eyelet re-inforced by washers through the front ply, a portion of the back ply, and the flap of the envelope. The sole object of the eyelet is to provide a suitable hole into which the cord or hook, which fastens the envelope to the merchandise, may be introduced. The effect of the eyelet and washers is to prevent the back ply from being left free at this end."

Alfeged Infringement of Reissue No. 10,488.

But in view of the Ullman patent alone, disregarding the acquiescences and admissions of Dunham in the Patent Office, if there is any patentable invention described in the reissued patent, such patentable invention is applicable only to an envelope having a long flap.

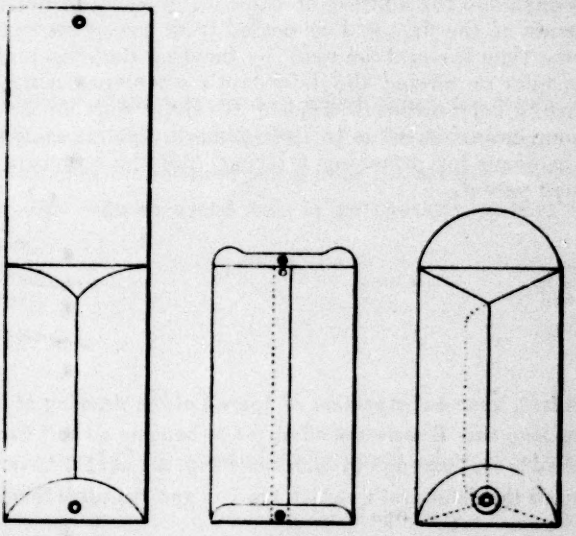
In defendant's envelope both end flaps are short. And any construction of the patent that would include the defendant's structure must also include the Ullman patent.

The claims as to which infringement is alleged are: —

1. A combined tag and envelope, substantially as described, wherein the flap which closes the mouth of the envelope is fastened down by the cord or other device which secures the tag to the merchandise, as set forth.

2. A combined tag and envelope, substantially as described, the flap having an eyelet hole, which when the said flap is folded down on the envelope, coincides with an eyelet hole in the envelope whereby the cord or hook for attaching the tag may be passed through both holes, substantially as set forth.

The following cut shows the envelope of the reissued patent, the Ullman envelope and the defendant's envelope, in the order named, from left to right.



In regard to the alleged infringement of reissued patent, No. 10,488, Mr. Renwick says: — Rec., pages 148.

"I have frequently examined the defendant's two envelopes referred to in the question. They are ordinary envelopes with an

eyelet rivet passed through one end thereof. This eyelet passes through not only the flap, but through both the back and front of the envelope proper, and securely fastens that end of the envelope, so that it cannot be opened to take out any of the contents of the envelope, or examine them. By examining the envelope, this fact will be perceived, and it results from the way in which the paper is cut, so that the side of the body which has the seam in it reaches a long distance under the flap, and nearly to the end of the envelope. . . .

"The defendant's envelopes as a whole, moreover, are substantially like at both ends to the Ullman envelope, because that end of the envelope into which the letter or invoice is put is gummed like an ordinary envelope. It is true that the Ullman envelope has at this end the further security of an eyelet, but this is only an additional means of closing, which Ullman says was well known prior to the date of his invention.

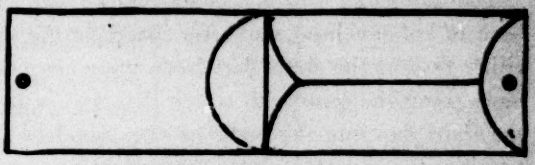
"It is obvious that the defendant's envelope has not the long flap of the plaintiff's envelope, nor has it an eyelet in the opposite end of the envelope to that where the flap is secured, and that in the defendant's envelope, when fastened to merchandise, the invoice cannot be examined, except by unsealing it, and further, that in the defendant's envelope the address of the consignee could not be printed on the inside of the flap, and concealed from casual inspection, while at the same time it could be read by bending the flap and envelope into a cylinder or circle; the defendant's envelope being, as I have said before, a very ordinary kind of envelope with an eyelet driven through one end of it, so as to strengthen the joints at that end and serve as a means for attaching a string like the structure shown in the Ullman patent.

It is evident, upon an inspection of figure I of the drawing of the reissue, that if the long flap B were cut off so as to become a short flap, and gum were applied to the free edge of such short flap, we should have the Ullman envelope and the defendant's, which are one and the same thing.

Again, the following cut shows at a glance the difference between the appellant's envelope of the reissued patent and the defendant's envelope.

The structure as a whole is the appellant's envelope.

If the long flap at the left is shortened by a cut on the curved line here shown, there remains the defendant's envelope.



In both envelopes the short flap at the right is pasted or gummed down upon the back or seamed side of the envelope and a single eyelet is then passed through this end and clinched.

In the defendant's envelope the flap which closes the mouth is not fastened by the device which secures the tag to the merchandise as required by the first claim of the reissued patent; nor is there any eyelet hole in the flap to coincide with an eyelet hole in the envelope as required by the second claim.

We refer again to the restrictions imposed upon the patent in the Patent Office.

When the appellant uses his envelope with the long flap he writes the address of the consignee on the inner face of the long flap, and,

after placing an invoice or communication of like nature in the body of the envelope, folds the long flap upon the body of the envelope, so as to make the eyelet hole at the end of that flap coincide with the eyelet hole in the body of the envelope, thus concealing the address. He then secures the envelope to the goods by a string or hook which he passes through the **two eyeletted holes.**

The defendant writes the address in the ordinary manner on the back of his envelope, and after inserting the invoice in the envelope, either fastens the short flap down upon the body of the envelope by moistening the gum with which that flap is provided, or by tucking the short flap into the body of the envelope. The string or hook passing through the **single eyletted hole** at the opposite end of the envelope, by which the envelope is attached to the goods, performs no office in respect to the closing of the envelope.

If then the patentee is restricted as we contend by the limitations imposed upon his patent in the Patent Office, and he is not at liberty now to insist upon a construction of his patent that will include what he was expressly required to abandon and disavow as a condition of the grant, the defendant does not infringe, for the long flap that is the essential feature of the reissued patent is wanting in the defendant's structure.

But independently of such restriction the patentee is bound by the limitations of his claims.

THOMPSON *v.* BOISSELIER, 114 U. S. 1. "The limitation imposed by the patentee must be presumed to have been made with good reason."

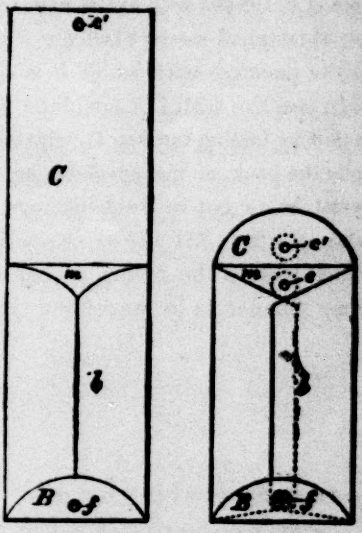
MCCLAIN *v.* ORTMAYER, 141 U. S. 419, 423. "While the patentee may have been unfortunate in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, we are not at liberty, without running counter to the entire current of authority in this court, to construe such claims to include more than their language fairly imports."

MCCLAIN *v.* ORTMAYER, 141 U. S. 419, 424. "The rights of the plaintiff depend upon the claim in his patent, according to its proper construction, and not upon what he may erroneously suppose it covers."

ALLEGED INFRINGEMENT OF APPELLANT'S SECOND PATENT, NO. 331,118.

COMPLAINANT'S PATENT NO. 331,118.

The second patent in suit, No. 31,118, must be construed not only in view of the state of the art as already set forth, but also in view of the prior original and reissued patents Nos. 277,245 and 10,488.



The envelope of patent No. 331,118 differs from the envelope of the reissue only in having the long flap of the reissue envelope cut down to a short flap and having two separately re-inforced holes made, one in the resulting short flap, and the other in the front face of the envelope above the free end of the back.

This is shown in the accompanying cuts representing the two envelopes.*

In both envelopes the body, or tube *b*, is formed by folding and pasting together the two side flaps in the usual manner. Each envelope has one short end flap, B, permanently fastened down upon the flaps, closing one end. This short flap B in the reissue envelope necessarily contains a hole *f* which passes also through the body of the envelope. The short flap B in No. 331,118 does not necessarily contain a hole, but one, *f*, is shown in the cut, since the patentee says that when he uses the envelope of patent No. 331,118 for a tag he prefers to secure the bottom flap by an eyelet that passes through and is clinched. This he says "is better than sealing with ordinary gum, as the flap will not be freed by dampness." The correspond-

* The lettering in the cuts follows that of the drawing of patent No. 331,118.

ing hole *f* in the reissue envelope is eyeletted. In both envelopes when the preferred * form is used, the mouth of the envelope is at *m*; and in both this mouth always remains unsealed whether the envelope be used as a tag envelope or as a mailing envelope.

The mouth *m* of the reissue envelope **is closed but not sealed by folding the long flap C over upon the back of the envelope so that eyelet hole c^1 coincides with eyelet hole *f*.** The string or other fastener passing through these two holes c^1 *f* is used for securing the tag envelope to the package with which it is sent.

In the No. 331,118 envelope the mouth *m* **is closed without being sealed by folding the flap C, which has been cut down to a short flap, over upon the back of the envelope, so that the eyelet hole c^1 coincides with eyelet hole** *c* cut in the front face of the envelope at its mouth. And when the No. 331,118 envelope is used as a tag envelope the string which ties up the mouth is passed through these holes c^1 c^2 in the same manner as in the reissue the string passes through the holes c^1 *f*.

In the specification of patent No. 331,118, it is said: —

"The envelope may be furnished to the trade with the flap C turned down and secured by a paper fastener *e* as in Fig. 3† or any other suitable fastening.‡ The flap B is left unsealed and the user inserts the material to be mailed at the bottom, and seals down flap B§ in order to close the filling aperture.

"The flap C and the washer *d d* overlap the end of the back *b*, and thus secure this end of the envelope from being accidentally opened and the contents lost; but the examining official at the post-office may with very little trouble open the envelope at the end by bending back the flap C and the washer thereon far enough to enable him

* When the envelope of patent No. 331,118 is used as a mailing or sample envelope the bottom flap B is left open and the user inserts the material to be mailed at the bottom end and then seals it up.

† The paper fastener is shown passing through holes c^1 *c*.

‡ A string, when the envelope is used also as a tag.

§ A clinched eyelet is used to fasten flap B when the patented article is used as a tag envelope.

to draw out the end of back *b* (as in Fig. 3) and thus gain access to the interior. After examination, the parts may be returned to their usual position.

"Fig. 5 shows metal eyelets as substitutes for the washers *d d*. When these are used, I usually make the flap C larger so as to lap over farther on the envelope back *b*, as these eyelets do not provide such an extent of clamping surface as the washers." . . .

"The flap C might be conveniently secured by a string *e'* as indicated in Fig. 4; and where the envelope is to be used as a tag for marking goods to be shipped, this string may serve to attach the envelope tag to the goods."

But all this applies equally well to the reissue envelope. Not only in both envelopes is the flap which closes the mouth of the envelope fastened down by the cord or other device which secures the tag to the merchandise, but in both the mouth of the envelope while remaining unsealed is secured from being accidentally opened and the contents lost, by the overlapping of the closing flap.

But even if it shall be held that there is a patentable difference between the No. 331,118 envelope and the reissue envelope, the defendant does not infringe the claims of patent No. 331,118.

Both claims are limited, as has been already pointed out, to an envelope in which the upper edge of the seamed back is free.

The words of the claims are: —

"1. An envelope having a flap C, provided with a re-enforced hole *c'*, and having a similar hole *c*, in the front ply of its body, and the said holes constructed to register or coincide when the flap C is folded down, whereby the end of the back ply *b*, of the envelope body, which extends entirely across the latter, is clamped and removably secured, substantially as shown and described.

"2. A mailing and tag envelope having a flap C, folded over on and secured down to the inner face of the front ply of the body, and said flap being also constructed to take over the free end of the back ply of the body, as shown, whereby the mouth of the envelope cov-

ered by said flap C is secured against accidental opening, substantially as and for the purposes set forth."

Of these claims, Mr. Connett, the appellant's expert, says (Rec., p. 64, fol. 107): —

"The first claim is limited to the re-enforced coinciding holes in the flap and front fly respectively, but it is not limited to any means of fastening the flap down. The flap may be fastened down, as the specification states, by a string paper fastener or the like which would permit the flap to stand somewhat loose or free, and thus enable the free end of the back ply to be the more readily drawn out from beneath the flap when it is desired to inspect the contents of the envelope.

"The second claim is not limited to the coinciding re-enforced holes as a means for securing down the flap; it is within the scope of this claim to use other means for securing this flap down to the inner face of the front ply of the body: but the claim is limited to the flap being secured down to the front ply.

"The leading idea or principle of the invention is the holding down of the back ply of the envelope by the overlapping of the flap thereon, and the omission of any permanent or secure attachment of the flap to said back ply."

Again, Mr. Connett testified as follows, Rec., p. 741: —

"*Cross-Int.* 46. In answer to interrogatory 26, you say, referring to the invention set forth in the first claim of patent 331,118: 'the said back ply being thus removably secured so that the envelope may be opened designedly and its contents replaced without a necessity of removing the fastenings.' Is this true of the envelope set forth in the second claim of said patent?

"*Ans.* Yes, this is the characteristic feature of the envelope of the patent.

. . . . . .

"*Cross-Int.* 48. Do you consider that the phrases, 'removably secured' and 'secured against accidental opening,' in the two claims of patent 331,118, mean the same thing?

"*Ans.* Taken in connection with the description of the envelope given in the specification, I do think they mean the same thing, or express the same idea, with respect to the purpose or object of the invention."

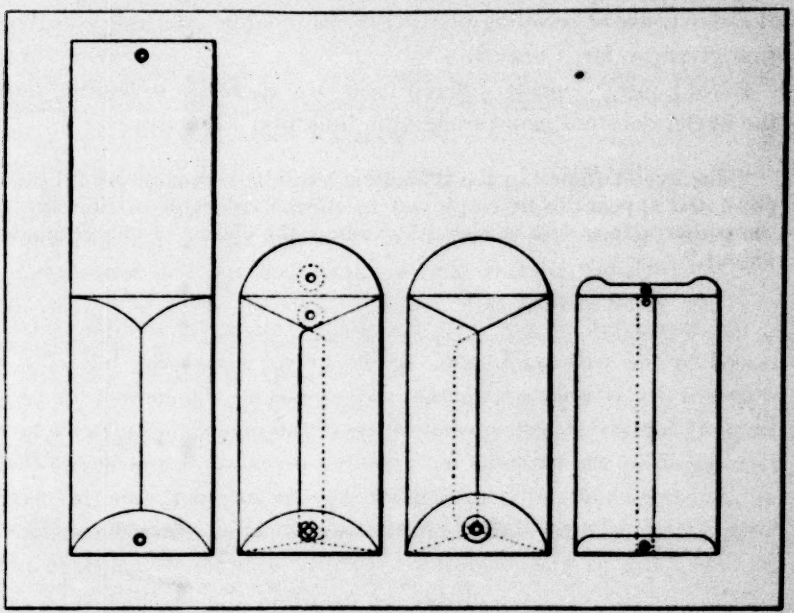
Now we claim that the defendant does not infringe, because, in defendant's envelope, as Mr. Renwick, our expert says,

"but one eyelet is used as an Ullman, and this eyelet goes through the flap, through a portion of the back ply and through the front ply and clinched, and the back ply of the defendant's is not movably secured,

so that the contents of the envelope may be examined. The defendant's envelope is like Ullman's, and unlike that of Dunham's second patent." (Rec., p. 150, fol. 250.)

Below we give cuts of the reissue envelope, the Dunham second patent envelope, the defendant's envelope, and the Ullman envelope, in the order mentioned.

When Mr. Renwick testified, the defendant had not the advantage of knowing the construction put upon the patent by the complainant,



and he gave to the patent a somewhat different construction than the complainant now contends for. Mr. Renwick (Rec., p. 109, folio 326, 7) said: —

"The object of the invention of the Dunham second patent is to secure a flap removably, so that the contents of the envelope may be inspected without breaking the fastenings or tearing the envelope. The defendant's envelope, on the contrary, secures the flap permanently and irremovably, so that its contents cannot be got at until the fastening is broken or the envelope torn."

Mr. Renwick had in mind a flap secured to the envelope by a string tied with a long loop, so that the flap could be opened on the string and the back ply thus set free; and he testified that the defendant did not infringe because he used for a fastener for the flap a single clinched eyelet.

But since he testified that he found that this single clinched eyelet went through a portion of the back ply (p. 36, *supra*) as well as through the front ply and flap, **and that it secures the flap permanently and irremovably so that the contents cannot be got at until the fastening is broken or the envelope torn,** it did not seem to be necessary to be at the expense of recalling him to ask his opinion upon the construction given by Mr. Connett.

Indeed, Mr. Connett differed from Mr. Renwick in finding that the eyelet does not pass through the back ply. He says: —

"The eyelet shown in the infringing exhibits serves no useful purpose, and appears to be employed to affect a colorable distinction in the construction, with a view of evading the claims of the Dunham patent."

An inspection of not only the alleged infringing exhibits introduced by the patentee in making his *prima facie* case, but of the dozen or so introduced by him in support of the motion for preliminary injunction, and several others of the defendant's manufacture introduced by the patentee for various purposes, clearly shows that all the defendant's envelopes in the case for any purposes that have been purchased since the date of the second patent, have the stringed or eyelet flap well fastened down upon the back ply by mucilage and by the [single] eyelet, and that the mouth of the envelope is at the other end.

The cuts of the defendant's envelope given in this brief are believed to be exact representations of the alleged infringing exhibits introduced by the appellant.

The appellant and his expert now swear, for the purposes of this case, that in their opinion the defendant's envelope is not sealed at the end at which the string is inserted. But as a matter of business the appellant wrote a letter to a firm using the defendant's envelope, and asserted that by such use the parties were **violating the**

postal laws. The letter in full, omitting advertising printing matter, is as follows: —

NEW YORK, Feb. 11, 1886.

MESSRS. S. R. & J. C. MOTT.

Gentlemen:

We have in our possession an infringement on our Combination Tag Envelope, which was used by you to Hardy & Hall, Brooklyn. We don't imagine you would infringe knowingly. And we also state that you have violated the U. S. Postal Laws, when you sealed the tag with your bill in the same you made it a letter. We send you a circular and sample of our tag, and call your attention to last claim on circular and which has been thrown all over the country by hundred of thousands. We now wish you to stop infringing, and this is the notice.

We should be pleased to have your statement if you knowingly used the tags, and if you received sample we sent you before.

Respectfully,

JOSEPH T. DUNHAM & CO.

See p. 132[a]: *We do not find this letter in the present record as printed;* but see pp. 39, 40 of record, where a fac-simile of the defendant's envelope referred to in the Mott & Mott letter was put in evidence. It is the same thing as the alleged infringing exhibits in evidence for this hearing.

We might safely rest our case upon the last few answers of the complainant's expert: —

[Record, p. 65.]

"*Cross-Int.* 65. What change would be necessary in the envelope at Fig. 1, in the patent 277,245, to give it a short flap in place of a long flap, and still keep it within the scope of the original invention?

"*Ans.* The flap B might be cut off, and the coinciding eyelet holes to receive a string or other fastening device placed at the opposite end of the tag envelope. I do not consider it material, in making this change, whether the flap B is materially abbreviated, but in order to have a proper space in the pocket for the invoice, the coinciding holes should be at one or the other end of the envelope, unless the envelope was quite large. This is an advantage, when the envelope is to be used as a tag in placing the holes that receive the attaching device near one end.

"*Cross-Int.* 66. I mean, could you alter one of Mr. Dunham's envelopes like those shown at Fig. 1, of the patent, 277,245, to an

envelope having a short flap, instead of a long flap, without departing from the original invention? I mean, of course, without substantially altering the capacity of the envelope for holding the invoice. If you could, please state how you do it.

"*Ans.* I do not think there would be any difficulty in doing that. I would first cut off the flap to the proper length, then fold it down over the mouth of the envelope, then punch a hole through the flap and the body of the envelope, a little way from the end of the latter. This would provide the necessary coinciding holes. I would then re-enforce the holes in the flap and the front ply of the envelope body. This construction would, in my opinion, be within the scope of Mr. Dunham's original invention, as covered generically by the second claim of his reissue No. 10,488.

"*Cross-Int.* 67. After making this change, then, you would reverse the ends to which you attach the string, to secure the tag envelope to the package, would you not?

"*Ans.* Of course; the string would necessarily be at the end where the coinciding holes are placed, and these would be at the other end of the tag envelope.

"*Cross-Int.* 68. After making the changes described in your answer to Cross-Int. 66, how would the tag envelope differ from the tag envelopes described and claimed in the latter patent, 331,118?

"*Ans.* That would depend on conditions not included in my answer. The envelope *specifically* claimed in the patent No. 331,-118, has of necessity a free ended back ply, the string or fastening device not passing through a hole in said back ply. The claim to this device in the latter patent is *specific* and subsidiary to the *generic* claim, two, of the reissue. In the supposed construction that I have described, the attaching string might or might not pass through the back ply of the envelope body. If this ply extended up under the flap, beyond the point where the coinciding holes are placed, then there would be a hole in the free end of the back ply. **The claims of the later patent are limited to this end of the back ply being left free.**

"*Cross-Int.* 69. If the envelope of Fig. 1, of the original patent, 277,245, were altered by cutting off most of the long flap and placing gum upon the short flap thereby remaining, the eyelet marked 'C' in the patent being still used for the attachment string, would there, in your opinion, be any departure from the original invention of patent 277,245?

"*Ans.* In my opinion, it is essential to the invention of the patent No. 277,245, that there shall be a free flap to be held down by the attaching string, and as I understand the eyelet C of the drawing, it is employed as a rivet for permanently securing the flap down on the envelope; therefore, **such construction would be a departure from the invention.** The eyelet C serves a double purpose, as represented in the drawing and described in the patent, namely, as a rivet to permanently secure the plies together, and is a re-enforce for the

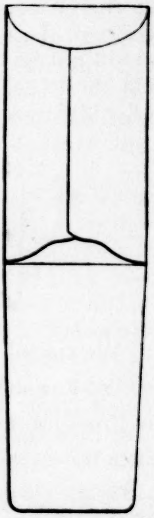
holes in the piles and flap. If the eyelet C was not so firmly clinched as to prevent the flap from being readily raised, in that case I think the construction would be within the scope of the patent, as I do not consider it important to the patent whether the other flap is secured by gum or by a rivet.

"*Cross-Int.* 70. If the envelope of Fig. 1 of the original patent, 277,245, were altered as suggested in my last question, would it, in your opinion, come within the scope of either claim of the patent, 331,118?

"*Ans.* To determine that I would have to assume certain conditions that are not very clear in said Fig. 1. If the flap in which eyelet C is placed were not otherwise secured down on the back ply, so that it could not be readily detached, or if the eyelet C passed through the end of the back ply, either or both, so that the envelope could not be opened at that end, in the manner described in the patent 331,118, then it would not come within the scope of the claim of said patent."

We submit that if the long flap in the above cut be shortened on the curved line shown in that cut, there will result the construction suggested in Cross-Int. 69, admitted by Mr. Connett in his answer to be a departure from the invention; and we further submit that the resulting construction is the defendant's envelope.

As to the infringement of patent 331,118, we repeat that the state of the art, as against that patent, is enlarged by the existence of the reissued patent. Tag envelopes were not only an old device, as had been asserted by the examiner and admitted by Dunham, but as the reissued envelope was old it must be admitted that, at the date of the second patent, a tag envelope permanently closed at one end and furnished at that end with a single eyelet hole, through which a string for securing the tag envelope to merchandise could pass, and having an open flap at the other end was old.

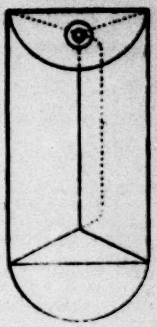


As against patent 331,118, it was old to use the envelope of the reissued patent permanently closed at the stringed end and open at the other, even when the long flap was used in the manner described and claimed in the reissued patent. Will it be said that it was not equally old to use the reissued envelope as a tag envelope, with the long flap tucked between the back and front, in the manner in which the long flap of the Tompkins' envelope, here shown, was designed to be tucked?

Now it certainly would not bring the reissued envelope within the invention of the 331,118 patent to shorten the long flap in the manner indicated in the cut on the preceding page.

Indeed, the appellant having once admitted that it was old to use common envelopes for tags to enclose a shipping bill, it is hard to see that there could be any invention in using the Tompkins' envelope as a tag, whether or not the long flap were shortened.

The appellant in 331,118 at best has improved upon No. 10,488 by shortening the flap of 10,488 and transferring the mouth of the envelope to the stringed end which he protects by a peculiar construction, still involving the use of two eyelet holes. The defendant also departing from No. 10,488 merely shortens the long flap and discards one of the eyelet holes, keeping the mouth at the end opposite the stringed end, and closing the flap at said mouth in any ordinary way, wholly regardless of the manner in which the tag envelope is attached to the merchandise.



We confidently submit that the second patent No. 331,118 is not infringed.

ABANDONMENT No. 331,118.

If the complainant made the invention claimed in patent No. 331,-118, dated Nov. 24, 1885, application filed Jan. 26, 1885, he abandoned it.

There can be no doubt but that if the patent had been granted to the defendant instead of to the complainant, it would not be invalidated by anything done by the complainant prior to the date of application. Under such circumstances all that Dunham did would be held to be an abandoned experiment.

This is a court of equity. In this suit it has jurisdiction, not by virtue of the citizenship of the parties, but under the Patent Act; and under the Patent Act it has jurisdiction to grant injunctions only according to the course and principles of courts of equity. Rev. Stats., Sect. 4921. This was held by the Supreme Court in Root *v.* Lake Shore & M. S. R. Co., 105 U. S. 189.

If then the complainant made this invention prior to the spring of 1883, took out a patent for a kindred invention in May, 1883, saw the alleged infringement go into public use in the summer of 1883, and did not apply for a patent covering it until January, 1885, he slept too long on his rights.

He who is silent when he should speak must be silent when he would speak, if he cannot do so without violation of law and injustice to others. *Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S. 92.

Dunham's own story is (see his affidavit, Rec., p. 135) that he made the invention of the second patent before taking out his first patent; he says (fol. 222): —

"Deponent, previous to 1880, conceived the idea of an envelope tag to contain the invoice, and after turning it over in his mind for a year or two commenced experimenting on the subject, continuing his experiments until he decided on what he considered the most desirable form in which to construct a combined tag and envelope that would meet the want felt by shippers. Many of these experimental devices have been preserved, and the exhibits hereto annexed, marked respectively Exhibits E, F^1, F^2, F^3, F^4, F^5, F^6, F^7 and F^9 are specimens of such preserved *experimental devices*, and were *all* designed and *constructed by deponent previous to his application for a patent on Jan.* 15, 1883."

He goes on to say that immediately after procuring his patent for his tag envelope in the most desirable form, May 8, 1883, he put the article on the market, and *soon after ascertained that the defendant was making and selling tag envelopes which he considered an infringement of his patent, but that he was advised by his counsel, as the patent was new and did not cover all his invention clearly, that is, did not cover defendant's envelope, to apply for a reissue* (p. 137, bottom of the page).

He applied for a reissue and got it.

"But on account of the narrowness of the specification and drawings, such reissue could not be made to include all of deponent's invention"; that is, could not be made to include defendant's tag envelope: "whereupon, by advice of counsel he made a new application [filed Jan. 26, 1885], and on the 24th of November, 1885, Letters Patent No. 331,118, covering the improvement in mailing and shipping envelopes shown in *experimental Exhibits* F^1, F^2, F^6 and F^7, and in Exhibit F^9, *made under said last-mentioned Letters Patent.*"

Dunham also testifies that Exhibit Taylor and Mayo, an envelope made by defendant precisely like the one patented in patent 331,118 (the envelope *now* manufactured by defendant and complained of in the bill of complaint is sufficiently different to take it out of infringement), came into his hands in August, 1883. And it appears (see defendant's circular, Rec., p. 54, put in evidence by appellant) that in the early part of 1885 Dunham served a notice upon defendant that it was infringing his reissued patent that bore date June 10, 1884. But he gave no notice of his pretence to further rights than those set forth in said reissue. He said nothing about having applied for a further patent or about any intention of applying for a further patent to cover something that he had discarded in 1883.

We quote from Dunham's testimony regarding the Exhibit Taylor & Mayo (Rec., pp. 52, 53):—

"82. Will you look at the tag envelope I now show you, and state when you first saw that? *A.* I think it was in August, 1883. . . .

"84. From whom did you receive it? *A.* I think from Taylor & Mayo's book-keeper, as I was there about every week, sometimes twice a week of that year.

. . . . . .

"90. Will you state any difference that exists between the three envelope exhibits, 'Taylor & Mayo', 'John S. Smith' and 'Alonzo B. Smith' in their construction?

"*A.* There is a very perceptible difference in every case.

"The Exhibit Taylor and Mayo is sealed at the bottom, and the top left open with nothing but ordinary paper washers and eyelet holes coinciding, one washer on the flap and one washer on the back body of the envelope.

"The Exhibit John S. Smith is made with the bottom flap open and the top flap sealed down tight, with paper washers on the flap and back envelope.

"Exhibit Alonzo B. Smith is made in the same manner as Exhibit John S. Smith, with an additional metal eyelet passed through the paper washers and seemingly fastened down."

This testimony corresponds to the statement in the plaintiffs' brief at the hearing below quoted in the opinion rendered by the Court as follows :—

"After defendant put its tag envelope on the market *it changed the construction several times*, until *it* finally adopted the form introduced in evidence as the infringing specimen. See complainant's 'Exhibit Taylor and Mayo,' *which was received in* 1883, and also has the eyelet holes with washers only; also complainants' 'Exhibit John S. Smith' *which was received in* 1884, and has the washers reinforced with a short metallic eyelet, with the eyeletted end tightly gummed down; also 'Exhibit Alonzo B. Smith' *received in* 1886, with printed advertisement on front, which had the eyeletted end tightly gummed, with washers reinforced by short metallic eyelets."

We repeat that the first form of envelope manufactured by the defendant, which came into Dunham's hands in 1883, was the precise form that Dunham subsequently patented in his second patent.

It is true that before Dunham obtained his patent the defendant had adopted another form of manufacture "*which had the eyeletted end tightly gummed*," and which the court below has held does not infringe the second patent, but in the meantime the public had got possession of the invention of the second patent through sources independent of Dunham.

Not only we do not infringe but the patent is invalid.

Now the reissue cases in this court tell a patentee that if he requires protection for other inventions his remedy is a new application; but again and again the Supreme Court asserts that the new application is subject to the intervening rights of others.

"The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others after its issue. The Legislature . . . was not willing to give him the right to patch up his patent by the addition of other inventions *which, though they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived.* For such inventions he is required to make a new application subject to such rights as the public and other inventors may have acquired in the mean time." *Powder Co.* v. *Powder Works*, 98 U. S. 126, 137.

So in *James* v. *Campbell*, the Supreme Court said: —

"If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent." 104 U. S. 356.

But further on in the same case the Court said: —

"Having obtained a patent for his specific device and combination, if he afterwards wished to claim the general combination and had not already abandoned it by taking a narrower patent, he was bound to make a new application for that purpose. Patentees avoid doing this when they can, and seek to embrace additional matter in an issue **in order to supersede and get possession of the rights which the public, by lapse of time or other cause, have acquired in the mean time.**" 104 U. S. 356.

In *Railway Company* v. *Sayles* the Supreme Court said: —

"We have given particular attention to the original application. . . .

"The law does not permit such enlargements of an original specification which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of reissues of patents previously granted. **Courts should regard with jealousy and disfavor any attempt** to enlarge the scope of an application once filed, or of a patent once granted, **the effect of which would be to enable the patentee** to appropriate other inventions made prior to the alteration, or **to appropriate that which has in the mean time gone into public use.**"

The statute gives an inventor two years within which to apply for his patent against public use by himself, *or by others, with or without his consent.*

Manning v. *Cape Ann Isinglass and Glue Co.*, 108 U. S. 462.

Andrews v. *Hovey*, 123 U. S. 267.

But, —

"An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time even within the two years named in the law. The effect of the law is that no such consequence will *necessarily* follow from the invention being in public use or on sale, with the inventor's consent and allowance, at any time within two years before his application; but that, if the invention is in public use or on sale prior to that time, it will be conclusive evidence of abandonment, and the patent will be void." *Elizabeth* v. *Nicholson Pavement Co.*, 97 U. S. 126, 134.

The patent in Elizabeth *v.* Nicholson Pavement Co. was issued under the Act of 1839; but the Court in Andrews *v.* Hovey said: —

"The language of Sect. 24 of the Act of 1870, now Sect. 4886 of the Revised Statutes, is to the same effect, and carries out the policy inaugurated by the Act of 1839. It allows a patent to be granted only for an invention which was not in public use or on sale for more than two years prior to the application for the patent, *subject to the defence of abandonment within such two years.*" 123 U. S. 267.

Abandonment and two years' prior use are made separate defences.

See again,

Consolidated Fruit Jar Co. *v.* Wright, 94 U. S. 92.

Moreover, this court of equity will look with suspicion upon this story of the patentee. He stands alone. No witness, intelligent or ignorant, disinterested or interested, appears to substantiate his story, although he tells the court that a solicitor of patents had the requisite knowledge.

In *Walker Glass Co.* v. *Souweine*, 24 Fed. Rep. 603, the court below, before which the present case was heard, speaking by Wallace, J., said: —

"The invention . . . is shown by the proofs to have been perfected by the patentee in the spring of 1875, although the application for the patent was not filed until October, 1876. No reason is shown for the delay that intervened between the time when a patent might have been applied for and the time when the application was made. In the absence of any explanatory facts, evidence offered to carry back the date of the invention to be a period considerably anterior to the application for a patent in order to save the patent from being defeated for want of novelty, should be critically examined."

Here the appellant not only seeks to save his patent from being defeated for want of novelty on account of prior use by the defendant, as testified to and admitted by the appellant himself, but he seeks to enjoin the defendant from continuing such use, and he calls no witness to his support.

Upon the appellant's own story it is clear that he would not have applied for patent 331,118 if he had not, prior to his application, found in public use the article he sought to cover by the patent.

But more than this; upon his own story he was compelled to set up a date of invention prior to his application. This brings the burden of proof upon himself.

In the absence of other evidence, the date of the patent is to be taken as the date of invention, and the burden of proof is upon the defendant to show, *beyond any fair doubt*, prior knowledge and use. When such evidence has been produced (or admitted), the burden is shifted upon the plaintiff to show still earlier invention. *Webster Loom Co.* v. *Higgins*, 15 Blatch. 447.

Where patentee sets up a date of invention prior to that of filing his application, it throws on him the burden of proving not only that he made his invention at the period claimed, but that he reduced it to practice as an operative machine. *Jones* v. *Sewall*, 3 Cliff. 563.

It is respectfully submitted that there was no error in the judgment of the Court below dismissing the bill, and that the judgment should be affirmed.

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Of Counsel for Defendant.